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## THE CONSTITUTIONALIZATION OF TECHNOLOGY LAW

By Mark A. Lemley<sup>†</sup>

Technology lawyers, and especially intellectual property lawyers, have discovered the Constitution. They are filing suits to invalidate statutes and interposing constitutional defenses to intellectual property claims at an unprecedented rate. Scholars are focusing more attention on the complex interaction between intellectual property, Internet regulation and the Constitution than ever before. The goal of this symposium is to investigate two of those constitutional claims in much greater detail. In this introduction, I will endeavor to explain why the issue arises at all.

First, I should distinguish between the two branches of this symposium, one dealing with intellectual property law<sup>1</sup> and the other dealing with Internet regulation.<sup>2</sup> The two bodies of law tend to have different interactions with the Constitution. Litigation about the constitutionality of Internet regulation tends to center on the First Amendment, and to involve the application of well known (if not always clear) principles of law to new factual situations. Thus, facial constitutional challenges have been mounted to the Communications Decency Act of 1996<sup>3</sup> and the Child Online Protection Act,<sup>4</sup> both of which regulated indecent speech over the

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[Editor's Note] The Editors of the *Berkeley Technology Law Journal* express their appreciation to Professor Lemley for acting as the Guest Editor for this Symposium.

1. See Yochai Benkler, *Constitutional Bounds of Database Protection: The Role of Judicial Review in the Creation and Definition of Private Rights in Information*, 15 BERKELEY TECH. L.J. 535 (2000); Marci A. Hamilton, *A Response to Professor Benkler*, 15 BERKELEY TECH. L.J. 605 (2000).

2. See Lee Tien, *Publishing Software as a Speech Act*, 15 BERKELEY TECH. L.J. 629 (2000); Robert C. Post, *Encryption Source Code and the First Amendment*, 15 BERKELEY TECH. L.J. 713 (2000).

3. Pub. L. No. 104-104, § 502, 110 Stat. 56, 133 (codified at 47 U.S.C. § 223 (1996)) (prohibiting any person from knowingly transmitting obscene or indecent messages or displaying patently offensive communication on the Internet to children under eighteen years of age).

4. Pub. L. No. 105-277, tit. XVI, 112 Stat. 2681, 2736-41 (1998) (to be codified at 47 U.S.C. § 231) (forbidding according minors access to web sites containing indecent material).

Internet.<sup>5</sup> The First Amendment has also been interposed as a defense in various criminal prosecutions that sought to punish speech-related activity on the Internet.<sup>6</sup> In all these cases, the nature of the speech and the restriction of it were clear, even if the outcome was not. The papers for this symposium focus on two cases that extend First Amendment arguments to cover new territory: the regulation of computer source code itself.<sup>7</sup> Those arguments are important not only for the fate of encryption regulation, but also because they will help to determine the role the First Amendment plays in regulating other rules about software, notably intellectual property rules.<sup>8</sup>

Intellectual property has long coexisted uneasily with the First Amendment.<sup>9</sup> Recent expansions of intellectual property law have put

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5. See, e.g., *Reno v. ACLU*, 521 U.S. 844 (1997) (Communications Decency Act); *ACLU v. Reno*, 31 F. Supp. 2d 473 (E.D. Pa. 1999) (Child Online Protection Act).

6. See, e.g., *United States v. Alkhabaz*, 104 F.3d 1492 (6th Cir. 1997); Robert Kurman Kelner, *United States v. Jake Baker: Revisiting Threats and the First Amendment*, 84 VA. L. REV. 287 (1998).

7. See *Bernstein v. United States Dep't of Justice*, 176 F.3d 1132 (9th Cir.), *reh'g en banc granted and opinion withdrawn*, 192 F.3d 1308 (9th Cir. 1999); *Junger v. Daley*, No. 98-4045, 2000 WL 343566 (6th Cir. April 4, 2000). A district court has come to the opposite conclusion. See *Karn v. Department of State*, 925 F. Supp. 1 (D.D.C. 1996), *remanded for reconsideration*, 107 F.3d 923 (D.C. Cir. 1997) (unpublished disposition).

8. For an early effort to explore some of those implications, see Dan L. Burk, *Patenting Speech* (2000) (unpublished manuscript, on file with author). Cf. Mark A. Lemley & Eugene Volokh, *Freedom of Speech and Injunctions in Intellectual Property Cases*, 48 DUKE L.J. 147, 236-37 (1998) (raising briefly the speech issues Burk discusses at length).

9. See *Harper & Row Publishers v. Nation Enters.*, 471 U.S. 539 (1985). Many commentators have discussed this tension, generally arguing that intellectual property law needs to take more account of the First Amendment than it historically has done. See, e.g., Floyd Abrams, *First Amendment and Copyright*, 35 J. COPR. SOC'Y 1 (1987); Robert C. Denicola, *Copyright and Free Speech: Constitutional Limitations on the Protection of Expression*, 67 CALIF. L. REV. 283 (1979); Charles C. Goetsch, *Parody as Free Speech—The Replacement of the Fair Use Doctrine by First Amendment Protection*, 3 W. NEW ENG. L. REV. 39 (1980); Paul Goldstein, *Copyright and the First Amendment*, 70 COLUM. L. REV. 983 (1970); Lemley & Volokh, *supra* note 8, at 147; Melville B. Nimmer, *Does Copyright Abridge the First Amendment Guarantees of Free Speech and Press?*, 17 UCLA L. REV. 1180 (1970); Hon. James L. Oakes, *Copyrights and Copyre-medies: Unfair Use and Injunctions*, 18 HOFSTRA L. REV. 983 (1990); L. Ray Patterson, *Free Speech, Copyright, and Fair Use*, 40 VAND. L. REV. 1 (1987); David E. Shipley, *Conflicts Between Copyright and the First Amendment After Harper & Row, Publishers v. Nation Enterprises*, 1986 BYU L. REV. 983 (1986); Alfred C. Yen, *A First Amendment Perspective on the Idea/Expression Dichotomy and Copyright in a Work's "Total Concept and Feel"*, 38 EMORY L.J. 393 (1989); Geri J. Yonover, *The Precarious Balance: Moral Rights, Parody, and Fair Use*, 14 CARDOZO ARTS & ENT. L.J. 79 (1996); Mel Marquis, Comment, *Fair Use of the First Amendment: Parody and Its Protections*, 8 SETON HALL CONST. L.J. 123 (1997); cf. Neil Weinstock Netanel, *Copyright and a De-*

more strain on the uneasy truce between the two bodies of law. Some of the cases and arguments that arise in the intellectual property context are First Amendment reactions to this expansion of intellectual property rights.<sup>10</sup> Constitutional analysis of intellectual property is complicated, however, by the fact that Article I specifically contemplates the creation of certain limited intellectual property rights.<sup>11</sup> While the Intellectual Property Clause is a grant of power, it is also a limitation.<sup>12</sup> Thus, the constitutionalization of intellectual property law has also taken the form of arguments over whether Congress has exceeded its power under the clause.<sup>13</sup> The Benkler and Hamilton articles in this symposium nicely meld these two distinct constitutional debates in the specific context of the legality of database protection.<sup>14</sup>

Why now? What is new about the Internet and what has changed about intellectual property to bring these constitutional concerns to the fore? The answer in both cases is that the new constitutional claims are a reaction to new efforts by the government to intervene in the marketplace to favor a particular outcome. The background for this intervention in both Internet regulation and intellectual property is the dramatic growth in importance of the new information economy.<sup>15</sup> With recognition has come increased

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*mocratic Civil Society*, 106 YALE L.J. 283, 296-97 (1996) (offering speech-related justifications for limited copyright protection); Diane Leenheer Zimmerman, *Information as Speech, Information as Goods: Some Thoughts on Marketplaces and the Bill of Rights*, 33 WM. & MARY L. REV. 665, 666 (1992) (suggesting that, if anything, commentators understate the problems caused by the conflict between copyright law and the First Amendment).

10. Thus, Benkler responds to database protection and the Digital Millennium Copyright Act. See Benkler, *supra* note 1; Yochai Benkler, *Free as the Air to Common Use: First Amendment Constraints on Enclosure of the Public Domain*, 74 N.Y.U. L. REV. 354 (1999). Lemley and Volokh respond to the growing scope of copyright protection. See Lemley & Volokh, *supra* note 8, at 147. The courts have also faced First Amendment claims arising from the expanded protection of the Digital Millennium Copyright Act. See *Universal City Studios v. Reimerdes*, 82 F. Supp. 2d 211 (S.D.N.Y. 2000).

11. U.S. CONST. art. I, § 8, cl. 8.

12. See, e.g., *Feist Pubs. v. Rural Telephone Servs.*, 499 U.S. 340 (1991); *Graham v. John Deere Co.*, 383 U.S. 1, 5 (1966) ("The clause is both a grant of power and a limitation.").

13. See, e.g., *Eldred v. Reno*, 74 F. Supp. 2d 1 (D.D.C. 1999); Paul J. Heald & Suzanna Sherry, *Implied Constitutional Limits on Congressional Power: Construing the Commerce Power in Light of the Intellectual Property Clause*, 2000 U. ILL. L. REV. (forthcoming).

14. See Benkler, *supra* note 1; Hamilton, *supra* note 1.

15. See, e.g., U.S. DEP'T OF COMMERCE, SECRETARIAT OF ELEC. COMMERCE, *THE EMERGING DIGITAL ECONOMY* 1 (1998).

attention by both Congress and powerful interest groups, and therefore some of the problems predicted by public choice theory.<sup>16</sup> This is particularly true in the intellectual property setting, where the issues are both complex and hotly contested. Because these are hard issues, and because there are strong interest groups pushing particular agendas, it is far too easy for Congress to fall into a pattern of responding to private demands, rather than thinking proactively about what should be done.<sup>17</sup> To a disturbing extent, Congress in recent years seems to have abdicated its role in setting intellectual property policy to the private interests who appear before it. Congressional hearings on patent reform, the Digital Millennium Copyright Act, and database protection have all exhibited some of these characteristics.

Congressional regulation of intellectual property or of the Internet is not driven solely by considerations of public choice theory. Many members of Congress have an altruistic desire simply to participate in this incredible new phenomenon. As one commentator familiar with the process put it, "everyone wants to get involved with the Internet. Unfortunately, if you're in Congress, the only way to get involved is to pass legislation."<sup>18</sup> And so legislation is passed. By and large, this legislation is regulatory, because legislation generally is.<sup>19</sup> Even those in Congress who want government to keep its hands off the Net ironically end up passing new laws

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16. For background on public choice theory, see, e.g., MAXWELL L. STEARNS, *PUBLIC CHOICE AND PUBLIC LAW: READINGS AND COMMENTARY* (1997); J. BUCHANAN & GORDON TULLOCK, *THE CALCULUS OF CONSENT* (1962); Daniel A. Farber & Philip P. Frickey, *The Jurisprudence of Public Choice*, 65 *TEX. L. REV.* 873 (1987); William N. Eskridge, *Politics Without Romance: Implications of Public Choice Theory for Statutory Interpretation*, 74 *VA. L. REV.* 275 (1988).

17. This is not a new problem, and it has been explored in greater detail elsewhere. See, e.g., Jessica D. Litman, *Copyright Legislation and Technological Change*, 68 *OR. L. REV.* 275 (1989); Jessica D. Litman, *Copyright, Compromise, and Legislative History*, 72 *CORNELL L. REV.* 857 (1987). The issues (and certainly the laws) are becoming increasingly complex, however, and the interest groups have more at stake. Thus, the pressures identified in this paragraph are increasing over time.

In prior years, Rep. Robert Kastenmeier was a strong positive force in ensuring that intellectual property legislation was vetted for quality. His proposed list of criteria for considering a new intellectual property bill, see Robert W. Kastenmeier & Michael J. Remington, *The Semiconductor Chip Protection Act of 1984: A Swamp or Firm Ground?*, 70 *MINN. L. REV.* 417 (1985), deserves renewed attention today.

18. Interview with anonymous source in Washington, D.C. (March 31, 2000).

19. Legislation is far from the only regulator of the Net, of course. See generally LAWRENCE LESSIG, *CODE AND OTHER LAWS OF CYBERSPACE* (1999).

to accomplish that goal.<sup>20</sup> Thus, the pressures to “do something” in these areas come from several quarters at once.

The result is an intellectual property law that increasingly looks like what it is—the product of detailed compromises between private interest groups. Most (but not all) of these interest groups are intellectual property owners, and so most (but not all) recent changes in the law have been in the direction of greater protection for intellectual property owners.<sup>21</sup> Where a well-organized group has opposed expanded protection, the result has generally been not to defeat the bill altogether, but rather to expand protection in general while providing specific carve-outs for the group that complained.<sup>22</sup>

If you are a loser in this process because you aren't well-organized or well-funded—say, because you are a member of the public—you will naturally look for an end-run around what Congress has done. The Constitution is the perfect avoidance mechanism, because it allows you to resort to the judgment of the courts, and courts are more resistant to the sorts of public choice concerns described above.<sup>23</sup> If you can persuade a court that what Congress has done is unconstitutional, all the campaign contributions in the world are unlikely to help your opponents.

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20. A prime example is the Internet Tax Freedom Act, Pub. L. No. 105-277, 112 Stat. 2681 (1998), which imposed a moratorium on taxation of e-commerce.

21. See, e.g., Anticybersquatting Consumer Protection Act, Pub. L. No. 106-113, 113 Stat. 1501 (1999) (codified at 15 U.S.C. § 1125(d)) (giving new trademark rights in domain names); Digital Millennium Copyright Act, Pub. L. No. 105-304, 112 Stat. 2860 (1998) (new rights codified at 17 U.S.C. §§ 1201-1205) (banning circumvention of technological access control measures); Sonny Bono Copyright Term Extension Act, Pub. L. No. 105-298, §102(b), 112 Stat. 2827, 2827 (1998) (codified at 17 U.S.C. § 302) (extending the duration of existing copyrights by 20 years); No Electronic Theft Act, Pub. L. No. 105-147, 111 Stat. 2678 (1997) (new rights codified at 17 U.S.C. § 506) (expanding criminal penalties for copyright infringement); Economic Espionage Act of 1996, Pub. L. No. 104-294, 110 Stat. 3488 (codified at 18 U.S.C. §§ 1831-1839) (criminalizing trade secret misappropriation); Federal Trademark Dilution Act of 1995, Pub. L. No. 104-98, 109 Stat. 985 (codified at 15 U.S.C. § 1125(c)) (creating a trademark cause of action which does not require consumer confusion).

22. See, e.g., Fairness in Music Licensing Act, Pub. L. 105-298, § 202, 112 Stat. 2830-31 (1998) (codified in principal part at 17 U.S.C. § 110(5)(B) and at §§ 101, 504, 513); Digital Millennium Copyright Act, Pub. L. No. 105-304, § 202(a), 12 Stat. 2860, (codified as amended at 17 U.S.C. § 512); and 17 U.S.C. §§ 108, 110, 111, 119.

23. See, e.g., Erwin Chemerinsky, *The Supreme Court, 1988 Term—Foreword: The Vanishing Constitution*, 103 HARV. L. REV. 43, 78-81 (1989); Jerry L. Mashaw, *Constitutional Deregulation: Notes Toward a Public Law*, 54 TULANE L. REV. 849, 874-75 (1980); Cass Sunstein, *Interest Groups in American Public Law*, 38 STAN. L. REV. 29 (1985). But see Einer R. Elhauge, *Does Interest Group Theory Justify More Intrusive Judicial Review?*, 101 YALE L.J. 31 (1991) (criticizing this conclusion).

Lest this analysis be misinterpreted, let me make one thing perfectly clear: I do not mean to suggest that the particular constitutional arguments in question should be subject to more skepticism because they are a reaction to the rent-seeking process I have just described. There can be no question that Congress and the Clinton Administration have dramatically expanded the scope of intellectual property protection, or that they have attempted to regulate speech on the Internet that they could not regulate in other contexts. Further, one of the clear implications of public choice theory is that Congress will pay less attention than it probably should to constitutional constraints on its behavior. I believe the Constitution should be read to impose limits on the growth of regulation in both contexts, though the precise scope of those limits is not yet clear. The fact that Congress is doing more in both areas will necessarily increase the danger of conflict with the Constitution. So long as Congress expands its regulatory efforts over technology, the constitutionalization of technology law will continue.

**CONSTITUTIONAL BOUNDS OF DATABASE  
PROTECTION: THE ROLE OF JUDICIAL REVIEW  
IN THE CREATION AND DEFINITION OF  
PRIVATE RIGHTS IN INFORMATION**

*By Yochai Benkler<sup>†</sup>*

**ABSTRACT**

The article analyzes the constitutional bounds within which Congress is empowered to regulate the production and exchange of information by creating private rights. As a test case for answering this question, it analyzes the differences between two radically different bills for protecting database providers, reported in late September of 1999 by two committees of the House of Representatives. One bill, House Bill 354, is unconstitutional. The other, House Bill 1858, probably is constitutional. The article suggests that the Intellectual Property Clause and the First Amendment create two layers of judicial review over acts of Congress that recognize exclusive private rights in information. It suggests that judges have an important role to play as a counterweight to political processes in which the value of the public domain to future generations and to users is systematically underrepresented.

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## I. INTRODUCTION

Imagine Congress enacted a law that stated:

(1) Whoever publishes a news report, weather report, historical or scientific article, or other statement of fact, shall have an exclusive right to the use of the facts incorporated in that report and not previously publicly reported elsewhere.

(2) For a period of fifteen years following initial publication, no person may publish or distribute in interstate commerce facts subject to the exclusive right defined in paragraph (1) without the permission of the owner of the facts.

So Matt Drudge gets to say who may, and who may not, report on the Lewinsky affair. CNN and Time get to say who reports about the existence—or non-existence—of Operation Tailwind.

What prevents Congress from enacting such a law? Is it only prudence and the good judgment of its members? Are there constitutional constraints on congressional creation of exclusive private rights in information? If so, what are they?

The answer is that there are two cumulative constitutional constraints that prevent enclosure of the public domain so extensive as to be detrimental to our information environment. First, the Intellectual Property Clause imposes a set of threshold constraints on when it is that Congress may say that one person, and no other, may control this information, this knowl-

edge, this piece of our common culture.<sup>1</sup> Second, the First Amendment adds another layer of judicial oversight, to assure that even legislation that meets the threshold conditions, or is exempt from them because it can properly be passed under another power, does not impose too heavy a burden on our capacity to access information and communicate to others as autonomous individuals and as constituents of a democratic society.<sup>2</sup>

The question of constitutional constraints on Congress's power to enclose the public domain is of immediate practical import. The past few years have seen an upsurge in enclosure legislation, as those who stand to gain from stronger property rights drive their fences deeper into the heart of our information environment, staking out ever-larger holdings.<sup>3</sup> Of most immediate concern here are the database protection bills that have been introduced in Congress over the past few years. The stark differences between the iterations of this effort currently before the House of Representatives—House Bill 354, reported from the Committee on the Judiciary by Representative Coble, creating a property right in raw information in

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1. See Malla Pollack, *The Right to Know?: Delimiting Database Protection at the Juncture of the Commerce Clause, the Intellectual Property Clause and the First Amendment*, 17 CARDOZO ARTS & ENT. L.J. 47, 50-54 (1999); Malla Pollack, *Unconstitutional Incontestability?: The Intersection of the Intellectual Property and Commerce Clauses of the Constitution: Beyond a Critique of Shakespeare Co. v. Silstar Corp.*, 18 SEATTLE U. L. REV. 259, 260 (1995); Theodore H. Davis, Jr., *Copying in the Shadow of the Constitution: The Rational Limits of Trade Dress Protection*, 80 MINN. L. REV. 595, 596 (1996); David L. Lange, *The Intellectual Property Clause in Contemporary Trademark Law: An Appreciation of Two Recent Essays and Some Thoughts About Why We Ought to Care*, 59 LAW & CONTEMP. PROBS. 213, 232 (1996); Julie Cohen, *Copyright and the Jurisprudence of Self-Help*, 13 BERKELEY TECH. L.J. 1089, 1130-35 (1998).

2. For older commentaries raising this concern, see generally Melville B. Nimmer, *Does Copyright Abridge the First Amendment Guaranties of Free Speech and the Press?* 17 UCLA L. REV. 1180, 1181-86 (1970); Paul Goldstein, *Copyright and the First Amendment*, 70 COLUM. L. REV. 983, 984 (1970); Robert C. Denicola, *Copyright and Free Speech: Constitutional Limitations on the Protection of Expression*, 67 CAL. L. REV. 283, 284 (1979). In the 1990s, these concerns were again raised. See generally Diane Leenheer Zimmerman, *Information as Speech, Information as Goods: Some Thoughts on Marketplaces and the Bill of Rights*, 33 WM. & MARY L. REV. 665 (1992); L. Ray Patterson & Stanley F. Birch, Jr., *Copyright and Free Speech Rights*, 4 J. INTEL. PROP. L. 1 (1997); Mark A. Lemley & Eugene Volokh, *Freedom of Speech and Injunctions in Intellectual Property Cases*, 48 DUKE L.J. 147 (1998). I have provided my own treatment of these issues in Yochai Benkler, *Free As the Air to Common Use, First Amendment Constraints on Enclosure of the Public Domain*, 74 N.Y.U. L. REV. 354 (1999).

3. See, e.g., Sonny Bono Copyright Term Extension Act, Pub. L. 105-298, 112 Stat. 2827 (1998); Digital Millennium Copyright Act, Pub. L. 105-304, 112 Stat. 2860 (1998); see also James Boyle, *Sold Out*, N.Y. TIMES, Mar. 31, 1996, § 4, at 15; Pamela Samuelson, *The Copyright Grab*, WIRED, Jan. 1996, at 134-35.

all but name, and House Bill 1858, reported from the Committee on Commerce by Representative Bliley, that assiduously avoids creating a property right—bring to the fore both a specific and a general constitutional question. The specific question is, what are the constitutional bounds on Congress's power to delineate property rights in facts and in compilations of facts. This article will seek to answer this question by analyzing these dueling bills. The more general question is, what are the constitutional parameters that constrain the power of Congress to regulate the production and exchange of information and knowledge through the creation of exclusive private rights. I will answer this more general question first, to frame my analysis of the database bills.

Three constitutional reference points set the parameters of the answers to both the specific and the general questions. These are the Intellectual Property Clause,<sup>4</sup> the First Amendment speech clause, and Congress's near-plenary power under twentieth century interpretations of the Commerce Clause. There are three basic points to understand about these parameters.

First, the Intellectual Property Clause, at least since the *Trade-Mark Cases* in 1879,<sup>5</sup> has been understood to be not only an empowering clause, but also one that limits to what extent and in what manner Congress can secure exclusive rights in information. Second, the reasons for the limitation in that clause reflect a substantive concern that Congress should not create exclusive rights in information and knowledge unless these rights fall within the constraints imposed by the Intellectual Property Clause. While congressional powers usually need not be mutually exclusive, this is not the case when Congress is engaged in creating private rights to control the production and exchange of information in society. Rather, Congress cannot use a power other than the Intellectual Property Clause—most importantly, its power to regulate interstate commerce—to enact ex-

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4. U.S. CONST. art. 1, § 8, cl. 8. The anachronistic name ("intellectual property" was not a term known to the Framers) more accurately describes the scope of the clause than the more technical term sometimes used "the patents and copyrights clause," and is more useful for contemporary purposes than the more historically and descriptively accurate "exclusive rights of authors and inventors clause." See Edward C. Walterscheid, *Inherent or Created Rights: Early Views on the Intellectual Property Clause*, 19 *HAMLIN L. REV.* 81, 81 (1995). The term has been used for at least 15 years to denote this power. See, e.g., Robert W. Kastenmeier & Michael J. Remington, *The Semiconductor Chip Protection Act of 1984: A Swamp or Firm Ground?*, 70 *MINN. L. REV.* 417, 441 (1985) ("The argument that a particular interest group will make more money and therefore be more creative does not satisfy ... the constitutional requirements of the intellectual property clause.").

5. *Trade-Mark Cases*, 100 U.S. 82 (1879).

clusive rights inconsistent with the substantive constraints imposed by that clause. Third, the Intellectual Property Clause and the First Amendment interact to contain Congress's powers to regulate the flow of information in our information environment. Cumulatively, they seek to assure that no one will capture the legislative process to privatize that most precious of all public domains—our knowledge of the world that surrounds us. That public domain is germane to our ability to decide for ourselves and talk to each other about how we ought to live our lives as individuals and as members of a community.

Part II explains the constraints that the Intellectual Property Clause and the First Amendment impose on legislation that creates exclusive private rights in information. Part III explains why one would want a robust system of judicial review of such legislation, in terms of the centrality of free information flows to democracy and autonomy, and in terms of the political economy of legislative creation of exclusive rights in information. Part IV analyzes the pending database bills in terms of the Intellectual Property Clause, and finds House Bill 354, but not House Bill 1858, unconstitutional. A careful analysis of the provisions of House Bill 354 suggests that it is functionally an intellectual property right in data. Under the Supreme Court's interpretation of the Intellectual Property Clause, Congress lacks the power to enact such a right. Part V analyzes the two bills in terms of the First Amendment, and again finds the former bill deficient and the latter bill more defensible. There is no serious evidence that a right of the type created in House Bill 354 is necessary to further a significant public purpose. Furthermore, there is reason to believe that it would burden valuable speech too much for too speculative a gain in database production.

## II. THE LAW: TWO CONSTITUTIONAL CONSTRAINTS ON PRIVATE RIGHTS IN INFORMATION

### A. Constraints in the Intellectual Property Clause

In 1879, the Supreme Court was posed with the following question: can Congress enact a trademark protection statute? In 1870<sup>6</sup> and 1876<sup>7</sup> Congress had passed statutes providing for registration and enforcement of trademarks. The *Trade-Mark Cases* involved three prosecutions under the latter statute, and the Court considered whether Congress had the power to enact these laws. Relying on the statutory language, the Court first deter-

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6. Act of July 8, 1870 ch. 230 §§ 77-84, 16 Stat. 198 (entitled "An Act to Revise, Consolidate, and Amend the Statutes Relating to Patents and Copyrights").

7. Act of Aug. 14, 1876, 19 Stat. 141.

mined that Congress had purported to act under the Intellectual Property Clause, not the Commerce Clause of Article I.<sup>8</sup> Then the Court held that Congress could not, consistent with Article I, Section 8, clause 8 protect trademarks because trademarks lacked the originality that is the *sine qua non* of protection under that clause.<sup>9</sup> It expressly reserved the question of the appropriateness of regulating trademarks under the Commerce Clause, which indeed later became the source of authority for the Lanham Act.<sup>10</sup>

It is important to focus on what the Court did and did not do in the *Trade-Mark Cases*. The Court did hold that the Intellectual Property Clause is not an open-ended grant of power to Congress to create exclusive rights in information, but a specifically limited grant available only to protect original contributions to the wealth of human knowledge. This limitation on the appropriate subject matter for property rights in information is constitutionally embedded, and is germane to the power of Congress to act in this field. But the Court did not, at least in these cases, state that the limitations in the Intellectual Property Clause applied to all congressional attempts to recognize exclusive rights in information.

From a contemporary perspective, the *Trade-Mark Cases* establish the important principle that the Intellectual Property Clause constrains congressional power, and that it is the proper role of judges to step in and tell Congress when its zeal to enact property rights exceeds its power to do so under the Constitution. The cases also establish the principle that originality is a threshold requirement before information can become the object of exclusive rights under the Intellectual Property Clause.

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8. See 100 U.S. at 93.

9. The Court explained:

The ordinary trade-mark has no necessary relation to invention or discovery. The trade-mark recognized by the common law is generally the growth of a considerable period of use, rather than a sudden invention. . . . The writings which are to be protected [under this clause] are the fruits of intellectual labor, embodied in the form of books . . . . While such [trade-mark protection] legislation may be a judicious aid to the common law on the subject of trade-marks, and may be within the competency of legislatures whose general powers embrace that class of subjects, we are unable to see any such power in the constitutional provision concerning authors and inventors, and their writings and discoveries.

*Id.* at 94.

10. Act of July 5, 1946, ch. 540, 60 Stat. 427 (1946) (codified as amended at 15 U.S.C. §§ 1051-1127 (1994)).

These basic principles have since been upheld systematically by unanimous or near-unanimous Supreme Court opinions.<sup>11</sup> Two clusters of opinions—in the 1960s, and later in the late 1980s and early 1990s—developed and more clearly articulated the substantive constraints imposed by the Intellectual Property Clause on Congress's power to legislate exclusive rights in information. These cases offer a robust defense of the importance of the public domain to the "Progress of Science and the Useful Arts," and evidence an equally robust commitment by the Court to treat the Intellectual Property Clause as a structural constraint on Congress's power to enclose the public domain.

### 1. *The Substantive Constraints Imposed by the Intellectual Property Clause*

The first cluster of opinions involves direct statements by the Court—speaking unanimously—about the constraints imposed by the constitutional provision itself. In 1966 the Court interpreted the nonobviousness requirement for patentability in *Graham v. John Deere Co.*<sup>12</sup> The Court explained that the clause "is both a grant of power and a limitation."<sup>13</sup> In clear language, which it has reaffirmed since,<sup>14</sup> the Court stated that "Congress in the exercise of the patent power may not overreach the restraints imposed by the stated constitutional purpose."<sup>15</sup> Specifically, the Court held that the Intellectual Property Clause requires that Congress (a) act only when extending an exclusive right promotes "[i]nnovation, advancement, and . . . add[s] to the sum of useful knowledge"<sup>16</sup> and (b) not recognize exclusive rights "whose effects are to remove existent knowledge from the public domain, or to restrict free access to materials already available."<sup>17</sup> The Court reasoned that this unusual express limitation on the power granted in the same clause is a reflection of its framers' aversion to a system of government grants of monopolies in trade—a strategy used by the Crown to reward its favorites.<sup>18</sup>

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11. See *Feist Publications, Inc. v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340, 346-47 (1991); *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 146 (1989); *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 230-31 (1964); *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234, 237-38 (1964).

12. 383 U.S. 1 (1966). See also discussion *infra* Part II.A.1.

13. *Id.* at 5.

14. See, e.g., *Bonito Boats*, 489 U.S. at 146.

15. 383 U.S. at 5-6.

16. *Id.* at 6.

17. *Id.*

18. See *id.* at 5. Cf. *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 229-30 (1964) (comparing patent grants under American and English systems). On the aversion

Explaining why patents fall within the conceptual ambit of disfavored “monopolies” rather than the presumably beneficial category of “property,” the Court referred to the writings of Thomas Jefferson, who as Secretary of State was one of the first to implement the patent system under the Patent Act of 1790.<sup>19</sup> Jefferson was initially skeptical about the advisability of empowering Congress to provide for patents at all,<sup>20</sup> but he later accepted their utility within bounds.<sup>21</sup> His skepticism is most clearly reflected in a letter to Isaac McPherson, quoted at length by the Court in *Graham*.<sup>22</sup> Here Jefferson presented not a generalized abhorrence for monopoly, but a very specific sophistication about information as a good.

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to monopolies, and how it resonated in the thinking of the drafters of the Constitution about patents, see Edward C. Walterscheid, *To Promote the Progress of Science and the Useful Arts: The Background and Origin of the Intellectual Property Clause of the United States Constitution*, 2 J. INTEL. PROP. L. 1, 37-38 (1994).

19. The Court’s description of Jefferson’s role in the development of patent law has been criticized on historical grounds. See generally Edward C. Walterscheid, *The Use and Abuse of History: The Supreme Court’s Interpretation of Thomas Jefferson’s Influence on the Patent Law*, 39 IDEA 195 (1999).

20. See 383 U.S. at 7-8 (citing letter to Madison dated July 1788 arguing that “the benefit even of limited monopolies is too doubtful to be opposed to that of their general suppression”).

21. See *id.* at 8 (citing letters to Madison and Oliver Evans).

22. The Court quoted Jefferson as follows:

Stable ownership is the gift of social law, and is given late in the progress of society. It would be curious then, if an idea, the fugitive fermentation of an individual brain, could, of natural right, be claimed in exclusive and stable property. If nature has made any one thing less susceptible than all others of exclusive property, it is the action of the thinking power called an idea, which an individual may exclusively possess as long as he keeps it to himself; but the moment it is divulged, it forces itself into the possession of every one, and the receiver cannot dispossess himself of it. Its peculiar character, too, is that no one possesses the less, because every other possesses the whole of it. He who receives an idea from me, receives instruction himself without lessening mine; as he who lights his taper at mine, receives light without darkening me. That ideas should freely spread from one to another over the globe, for the moral and mutual instruction of man, and improvement of his condition, seems to have been peculiarly and benevolently designed by nature, when she made them, like fire, expansible over all space, without lessening their density in any point, and like the air in which we breathe, move, and have our physical being, incapable of confinement or exclusive appropriation. Inventions then cannot, in nature, be a subject of property. Society may give an exclusive right to the profits arising from them, as an encouragement to men to pursue ideas which may produce utility, but this may or may not be done, according

Poetic though his language may be, Jefferson's reasoning is entirely comprehensible and irresistible to the economically literate late twentieth century commentator. Information is a public good. It is nonexcludable and nonrival.<sup>23</sup> Its nonexcludability makes it unsusceptible to appropriation, except by grant of exclusive right coupled with the threat of state enforcement; consequently, this characteristic is the potential justification for recognizing and enforcing such rights. But because information is also purely nonrival, the social cost of its use by many people, once it is produced, is zero. It is therefore desirable that information be at least partially nonexcludable, because that attribute permits free access to information by those who value it at its social cost—the value of their attention to it—but not enough to pay a positive price above that social cost. Unlike land, or cows, then, information does not lend itself to the simple assumption of the presumptive beneficial effect of treating it as the subject of property. The free exchange of information, rather than its enclosure, is the presumed beneficial state, and enclosures of information are thus like sometimes-necessary “monopolies,” rather than normally-beneficial “property.”

The upshot of the Court's interpretation of the Intellectual Property Clause in *Graham* is that the clause expressly constrains the power of Congress to create exclusive rights in information. This limitation is based on substantive reservations that those who drafted the Constitution had towards granting anyone exclusive rights to use and benefit from information and knowledge. That the limitation reflects a substantive concern and

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to the will and convenience of the society, without claim or complaint from anybody.

*Id.* at 8 n.2.

23. Every economic good can be defined by the degree to which it is excludable, and the degree to which it is rivalrous. A good is excludable to the extent that its producer can appropriate its benefits by excluding those who benefit from it unless they pay a price. A good is rivalrous to the extent that its use by one person prevents (rivals) its use by another person. The former is a function of the available technology for exclusion, and the institutional (legal) framework that permits or facilitates such technically feasible exclusion. The latter is purely “technological.” It is an attribute of the good itself—it either can, or cannot, as a practical matter, be used by many people without degradation or rivalry. A pure private good is one that is excludable and rivalrous. A pure public good is one that is nonexcludable and nonrivalrous. When a good is public in the sense of being nonexcludable, it is so because no firm can capture its social value. It must therefore be provided publicly, if at all. By definition, a nonrivalrous good is one that can be used by one person without preventing or degrading its use by any other person. Any additional person who uses the good imposes no social cost. Its optimal demand price is therefore zero. At that price, however, it would not be produced by private interests, and must be provided publicly. At a higher price, which would induce private production, it will be under-consumed, and hence under-produced.

not a formality is important. It suggests that it should apply to laws purportedly passed under powers granted to Congress outside of the clause itself. Otherwise, simple legislative drafting contrary to the constraints imposed by the Intellectual Property Clause, enacted under a different power, could too easily undermine the substantive commitments animating the constraint. Furthermore, the constraint is not primarily the textually obvious "for limited times" requirement. Rather, it is the requirement that exclusive rights in information actually can promote the Progress of science and the useful arts; there must be at least a plausible claim that a given right can actually increase information production.<sup>24</sup> The clause also requires that Congress recognize exclusive rights only in exchange for *adding* to the wealth of public knowledge, and that it not grant rights that have the effect of *removing* information already available in the public domain.<sup>25</sup>

A quarter of a century later, the Court again revisited the constitutional constraints imposed on Congress by the Intellectual Property Clause, this time in the context of copyright. In *Feist*, a unanimous Court<sup>26</sup> held that Congress cannot, consistent with the Intellectual Property Clause, constitutionally recognize exclusive private rights in raw facts. "Originality," stated the Court, "is a constitutionally-mandated prerequisite for copyright

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24. Perhaps the most intellectually indefensible recent extension of exclusive rights in these terms is the Sonny Bono Copyright Term Extension Act, Pub. L. No. 105-298, 112 Stat. 2827 (1998). The law extends the term of copyright by twenty years, retroactively as well as prospectively. For example, the term for works owned by corporations was extended from 75 to 95 years. To suggest that such a law can create incentives to creators of copyrightable materials requires a belief that there will be some work, somewhere, that will not be produced unless it is secured a royalty stream in years 76 to 95. One would do well to be skeptical of any artist or executive who claims that the decision whether or not to produce a given information product will be affected, however marginally, by expectations regarding the revenue stream in years 76 to 95. To suggest that retroactive application of such an extension would create an incentive requires belief in an even more preposterous claim that authors would decide to produce something that would not recoup their costs within the copyright period secured to them at the time they make the decision to produce, but they will nonetheless produce it if they expect that future extensions of copyright term will be retroactively applied to their works. Without regard to any of these concerns, a federal district court for the District of Columbia upheld the term extension act against, among other claims, the claim that it offends the "limited times" constraint of the Intellectual Property Clause. See *Eldred v. Reno*, 74 F. Supp. 2d 1, 6-7 (D.C. Cir. 1999).

25. See 383 U.S. at 5-6, 8-9.

26. See *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 351 (1991). Justice Blackmun concurred in the judgment, but without writing his reservations from joining the opinion.

protection.”<sup>27</sup> Relying on the *Trade-Mark Cases*, the Court made amply clear that facts could not constitutionally be made the subject of copyright protection.<sup>28</sup> The Court relied on the concept that facts preexist their statement by a human agent; being the first to articulate a set of facts does not make that person the facts’ originator.<sup>29</sup> And only originators, or in the terms of *Graham*, only those who add to human knowledge, may receive an exclusive right in what they added.<sup>30</sup> This, in turn, is understood by the Court to create a constitutionally mandated framework not only to assure authors rights in their original expressions, but also to “encourage[] others to build freely upon the ideas and information conveyed by the work.”<sup>31</sup> As with *Graham*, the concern is substantive, not formal. It is a concern, treated as going to the very heart of the constitutional constraint, that Congress not enclose existing information and facts by granting exclusive rights. Three years later, in another unanimous opinion, *Campbell v. Acuff-Rose Music, Inc.*, the Court reiterated its position in *Feist*, and implied that not only originality, but some form of “fair use” constraint on the scope of intellectual property is implicit in the constitutional constraint itself.<sup>32</sup>

Although *Feist* is couched in terms of “copyright,” it would be implausible to claim that the Court could have based its decision so heavily on the constitutionally protected status of public access to facts and information, but expected that the exact same exclusive rights that it invalidated could be enacted simply by inserting in the preamble words to the effect that the Commerce Clause, not the Intellectual Property Clause, is the source of power upon which Congress relies. The Intellectual Property Clause speaks of “exclusive rights,” not of the technical terms—well known to its drafters—of “patents” or “copyrights.” It grants and restricts Congress’s power to grant such exclusive rights. And the Court has repeatedly, and unanimously, stated that this constraint requires originality as a precondition to the availability of an exclusive right, and that it prevents Congress from creating exclusive rights in information that is already in the public domain—like facts, whether stated or not. Limitations are rare in Article I, Section 8 grants of congressional power—bankruptcy

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27. *Id.* at 351.

28. *See id.* at 362.

29. *See id.* at 347-48.

30. *See id.* at 345-46.

31. *Id.* at 349-50.

32. *See* 510 U.S. 569, 575 (1994); *see also* *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 359 (1991) (“facts contained in existing works may be freely copied”); *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 547 (1985) (copyright owner’s rights exclude facts and ideas, and fair use).

laws must be nationally uniform,<sup>33</sup> an army can only be funded for two years.<sup>34</sup> As others, like Jane Ginsburg,<sup>35</sup> Malla Pollack,<sup>36</sup> Theodore Davis,<sup>37</sup> and William Patry,<sup>38</sup> have exhaustively explained, Congress may no more enact an exclusive right in information that conflicts with the limitations imposed by the Intellectual Property Clause than it may fund an army for three or four years using the general spending power, or aid the employees of a single railroad by enacting special provisions for the distribution of the assets of their employer.<sup>39</sup> To paraphrase Chief Justice Rehnquist on Congress's attempt to circumvent the uniformity requirement of the Bankruptcy Clause, "to hold otherwise would allow Congress to repeal the [originality] requirement from Art. I, § 8, cl. [8], of the Constitution."<sup>40</sup>

*United States v. Moghadam*<sup>41</sup> is the only case directly to address an Intellectual Property Clause challenge to congressional legislation sought to be justified under the Commerce Clause. In *Moghadam*, the United States Court of Appeals for the Eleventh Circuit upheld the anti-bootlegging statute, which prohibits unauthorized recordings of live musical performances.<sup>42</sup> The defendant challenged the constitutionality of the statute by arguing that Congress may only give authors and inventors rights to their "writings,"<sup>43</sup> and since a live music performance is not fixed in a tangible medium, it is not "a writing."<sup>44</sup> The court held that whether or not legislation under the Intellectual Property Clause could only apply to works fixed in a tangible medium, the anti-bootlegging statute was valid under the

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33. See U.S. CONST. art. I, § 8, cl. 4. In *Railway Labor Executives' Ass'n v. Gibbons*, 455 U.S. 457, 468-69 (1982), the Court struck down an attempt by Congress to circumvent this limitation.

34. See U.S. CONST. art. I, § 8, cl. 12.

35. See Jane Ginsburg, *No "Sweat"? Copyright and Other Protection of Works of Information After Feist v. Rural Telephone*, 92 COLUM. L. REV. 338, 369-74 (1992).

36. See Pollack, *supra* note 1.

37. See Davis, *supra* note 1.

38. See William Patry, *The Enumerated Powers Doctrine and Intellectual Property: An Imminent Constitutional Collision*, 67 GEO. WASH. L. REV. 359, 367-68 (1999).

39. *But see* Ginsburg, *supra* note 35, at 374-85 (arguing that Congressional findings regarding the scope of terms within the Intellectual Property Clause should receive extreme judicial deference).

40. See *Railway Labor Executives' Ass'n v. Gibbons*, 455 U.S. 457, 473 (1982) ("To hold otherwise would allow Congress to repeal the uniformity requirement from Art. I, § 8, cl. 4, of the Constitution.").

41. 175 F.3d 1269 (11th Cir. 1999).

42. See 175 F.3d at 1282 (upholding 18 U.S.C. § 2319A).

43. U.S. CONST. art. 1, § 8, cl. 8.

44. See 175 F.3d at 1274.

Commerce Clause.<sup>45</sup> At first glance, the case seems to fly in the face of the analysis in the preceding paragraph. On closer inspection, however, it does not.

The court in *Moghadam* clearly accepted the general relationship between the Intellectual Property Clause and the Commerce Clause, interpreting *Railway Labor Executives* to mean that there are “circumstances . . . in which the Commerce Clause cannot be used by Congress to eradicate a limitation placed upon Congress in another grant of power.”<sup>46</sup> The court’s holding suggests that it interposed a quite reasonable gloss on this relationship—that only important or central constraints created by the Intellectual Property Clause, and not merely technical constraints, displace Congress’s power under other clauses of Article I, Section 8 of the Constitution. The anti-bootlegging statute deviated, according to the court, merely from the *fixation* requirement implied by the word “writings” in the Intellectual Property Clause, and that requirement is not so central to the Intellectual Property Clause as to negate a commerce clause-based law that gives copyright-like rights in live performances.<sup>47</sup> Significantly, the court partly justified its holding by stating that an exclusive right to record live musical performances does cohere with the requirement of originality,<sup>48</sup> which was presumably more important in the court’s eyes. It also expressly stated that its holding “is limited to the fixation requirement, and should not be taken as authority that the other various limitations in the Copyright Clause can be avoided by reference to the Commerce Clause.”<sup>49</sup>

Whether the case was correctly decided<sup>50</sup> is less important than that the court recognized Congress’s power to create intellectual property-like

45. *See id.*

46. *See id.* at 1280.

47. *See id.* at 1281.

48. *See id.* at 1280.

49. *Id.* at 1281 n.14.

50. It is not entirely clear that the court was correct in its view that the fixation requirement is a technical constraint, rather than one that is central to the scheme of securing incentives and assuring access that is the design principle of the Intellectual Property Clause. Copyright has generally relied on the fixed medium as a rough balancing point between incentives and access. Rights to the fixed medium secure the incentives, and the porous boundaries of the medium permit some free access to the information, which is the economically efficient price at which information should be available once it is produced. The fixation requirement can therefore be seen as a historically contingent, but nonetheless central, constraint of the Intellectual Property Clause to assure that the law does not eliminate important points at which information can spill over into the public domain. If the fixation requirement is in fact so understood, then under the *Moghadam* court’s own understanding of the relationship between the Intellectual Property Clause and the Commerce Clause, the anti-bootlegging statute would be unconstitutional. More-

rights under the Commerce Clause only if they do not negate the substantive constraints imposed by the Intellectual Property Clause on the enactment of such rights. *Feist* excludes the possibility that an exclusive right to information in a database could be treated as conflicting with the Intellectual Property Clause in merely a technical sense. *Graham*, *Feist*, and *Acuff-Rose* similarly foreclose an interpretation that would permit exclusive rights that more generally circumvent the originality requirement or enclose materials in the public domain to be passed under the Commerce Clause.

2. *Congress's Power to Create a Different Kind of Right Under the Commerce Clause*

What power does Congress nonetheless have to regulate information markets after the possibility of using exclusive rights is removed? We know from the *Trade-Mark Cases* that the commerce power permits Congress to regulate certain uses of information beyond the scope of the Intellectual Property Clause—the Lanham Act is a case in point. What are the boundaries of this power, and how does it relate to the constraints imposed by the Intellectual Property Clause? These questions are answered, albeit indirectly, in a second cluster of opinions concerning the constitutional bounds imposed by the Intellectual Property Clause on state laws that are inconsistent with federal intellectual property laws. These opinions are one step removed from the question of direct constraints the Intellectual Property Clause places on Congress, because they involve the respective powers of the states and the federal Constitution. Nonetheless, in the course of working out to what extent the states are bound by the constraints imposed by the Intellectual Property Clause, the Court further articulated and strengthened the basic propositions set out from the *Trade-Mark Cases* to *Graham* and *Feist*. Namely, the Intellectual Property Clause imposes a constraint on what exclusive rights in information Congress can legislate.

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over, economically, a performance, unlike the music when fixed in most tangible media, is perfectly excludable—the artist can keep anyone out of the auditorium or the stadium unless they pay. The incentive to perform therefore can be completely captured by contract—tickets at the gate. This excludability also permits the artists to roll into the ticket price lost sales of music on fixed media caused by displacement by bootlegs. So the economic justification of the bootlegging statute is questionable. The statute provides an obvious boon to record labels, which get a much higher portion of the revenue on fixed media sales, but the displacement effect on artists, who receive a high percentage of the revenue on performances but a low one on sales of fixed media, is minimal. The anti-bootlegging statute therefore seems to challenge the Intellectual Property Clause's clear solicitude for authors, not publishers, as the objects of its protection. Performing a full analysis of the importance of the fixation requirement is, however, beyond the scope of this article and, as stated in the text, unnecessary to evaluate the database legislation.

And the Court also outlined the types of information exchange regulations that would be justified under the Commerce Clause without running afoul of the substantive constraints created by the Intellectual Property Clause.

In 1964 the Court considered whether state unfair competition law could be used to create a general, property-like entitlement for unpatented or unpatentable designs. In *Sears, Roebuck & Co. v. Stiffel Co.*<sup>51</sup> and *Compco Corp. v. Day-Brite Lighting, Inc.*,<sup>52</sup> the Court interpreted the holdings below to have been “based wholly on the fact that selling an article which is an exact copy of another unpatented article is likely to produce and did in this case produce confusion as to the source of the article.”<sup>53</sup> Because the Court saw these cases as equating confusion with copying, it interpreted them as creating, de facto, an alternative property-like right against *copying* of unpatented designs, rather than a contextually applied prohibition on causing market confusion. Such a right, in turn, “would interfere with the federal policy, found in Art. I, § 8, cl. 8, of the Constitution and in the implementing federal statutes of allowing free access to copy whatever the federal patent and copyright laws leave in the public domain.”<sup>54</sup> The Court specifically limited its holding, stating that it did not exclude the possibility of state regulation of unfair trade practices, like preventing palming off by regulating labeling.<sup>55</sup> But these laws could not be used in such a manner as effectively to negate the basic constitutional mandate that a design that is “in the public domain . . . can be copied in every detail by whoever pleases.”<sup>56</sup> The emphasis on this limitation of the constitutional constraint on unfair competition law—that states retain the power to regulate “specifically oriented predatory business practices”—was the basis of Justice Harlan’s concurrence.<sup>57</sup>

The *Sears* and *Compco* cases came under pressure for, and eventually were abandoned with respect to, their preemptive effect on states. In *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*,<sup>58</sup> the Court expressly abandoned the proposition that the Intellectual Property Clause directly prevented the states from “adopt[ing] rules for the promotion of intellectual

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51. 376 U.S. 225 (1964).

52. 376 U.S. 234 (1964).

53. *Id.* at 237.

54. *Id.*

55. *See id.* at 238.

56. *Id.*

57. *Id.* at 239.

58. 489 U.S. 141 (1989).

creation within their own jurisdictions.”<sup>59</sup> But in that same case the Court reiterated and revitalized the core holding of *Sears and Compco*, namely that states could not provide rights that offered patent-like protection, but undermined “the ultimate goal of public disclosure and use which is the centerpiece of federal patent policy.”<sup>60</sup> In *Bonito Boats* the Court considered a Florida statute, purportedly concerned with unfair competition, that prohibited use of the most efficient method of copying the design of a boat hull—using an existing boat to create a mold, and then using the mold to create boats that copy the original hull design.<sup>61</sup> The statute protected hull designs whether they were patentable or not.<sup>62</sup> In this case, the manufacturer had not applied for a patent prior to marketing the boat and the hull design could therefore no longer be patented.<sup>63</sup> The Court suggested that nothing prevented a state from passing a real unfair competition law, one concerned with “the protection of consumers, not the protection of producers as an incentive to product innovation.”<sup>64</sup> The Florida statute was not that type of law. Rather,

[i]n contrast to the operation of unfair competition law, the Florida statute is aimed directly at preventing the exploitation of the design and utilitarian conceptions embodied in the product itself. . . . To accomplish this goal, the Florida statute endows the original boat hull manufacturer with rights against the world, similar in scope and operation to the rights accorded a federal patentee.<sup>65</sup>

Given the functional similarity between the protection offered by the Florida statute to unpatented, and unpatentable designs and patent protection, the Court held that the statute was preempted.<sup>66</sup>

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59. *Id.* at 165 (citing *Aronson v. Quick Point Pencil Co.*, 440 U.S. 257, 262 (1979); *Goldstein v. California*, 412 U.S. 546, 552-61 (1973); and *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 478-79 (1974)).

60. *Bonito Boats*, 489 U.S. at 157.

61. *See id.* at 144-45.

62. *See id.* at 158-59.

63. *See id.* at 144-45, 159.

64. *Id.* at 157 (“[T]he plaintiff has the right not to lose his customers through false representations that those are his wares which in fact are not, but he may not monopolize any design or pattern, however trifling. The defendant, on the other hand, may copy plaintiff’s goods slavishly down to the minutest detail: but he may not represent himself as the plaintiff in their sale.” (quoting Judge Learned Hand in *Crescent Tool Co. v. Kilborn & Bishop Co.*, 247 F. 299, 301 (2d Cir. 1917))).

65. *Bonito Boats*, 489 U.S. at 158.

66. Some have suggested that *Bonito Boats* could be read as a retreat from the long-standing position that the Intellectual Property Clause imposes real limitations on Con-

In conjunction, the *Graham-Feist* and *Sears-Compco-Bonito Boats* lines of cases suggest that the Intellectual Property Clause imposes a threshold constraint on congressional legislation that regulates information production and exchange. Congress may not create rights that are functionally the type of exclusive right that it is empowered to create under the Intellectual Property Clause, except in compliance with that clause's limitations. Under the clause, Congress may create such rights if and when they are likely to encourage information production more than they inhibit it, if it makes them available only to those who make original contributions to the wealth of our collective knowledge, and if the exclusive right enacted does not remove, or burden free access to, information already in the public domain. While Congress may regulate information markets under the Commerce Clause as well, it may do so only to the extent that it does not thereby circumvent the limitations placed by the Intellectual Property Clause on its power to create exclusive rights. As Ginsburg ex-

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gress's power. See Pollack, *supra* note 1, at 64-66. The argument relies on the Court's heavy focus on the congressional definition of the contours of patent policy, coupled with its express abandonment of a notion of direct preemptive effect of the Intellectual Property Clause on state legislation, and its conclusion that "[i]t is for Congress to determine if the present system of design and utility patents is ineffectual in promoting the useful arts in the context of industrial design." *Bonito Boats*, 489 U.S. at 168. This would, however, be a misreading of *Bonito Boats*. The case involved the question of direct preemption, reviewing a state court decision that found state law to be preempted by the federal statute, not directly by the Intellectual Property Clause of the Constitution. See *id.* at 141. The Court began with an express reiteration, described in the text, of its long-standing position on the express limitations imposed by the Clause, and then went on to describe the history of congressional patent legislation as implementing the policies embedded in the constitutional constraints. See *id.* The Court's holding was that Congress had the role, in the first instance, to determine how best to fulfill the purpose of the Intellectual Property Clause, and if Congress, acting within its constitutional mandate, left an area of possible private rights in information free for state experimentation, then courts should not take it upon themselves to review each piece of state law for direct preemption by the Intellectual Property Clause. See *id.* at 168. This scheme leaves the Intellectual Property Clause as the final arbiter of the propriety of private rights in information, but it operates at the level of challenging congressional law. Valid congressional law, in turn, provides the framework against which state law must be measured. This leaves the question open as to whether courts can act in direct application of the clause in response to systematic overreaching by states and in the absence of congressional legislation, or whether a challenge must be fashioned to the reigning federal intellectual property law that leaves an area improperly unpreempted. But that was not the question in *Bonito Boats*. There, the Court only held that it was Congress's responsibility, in the first instance, to determine what state laws must be preempted so as not to interfere with the policies embedded in the Intellectual Property Clause. See *id.* at 165. The Court also reiterated that Congress's decisions themselves were in fact subject to judicially-enforceable interpretation of the requirements of that clause. See *id.* at 162-63.

plained in her criticism of *Feist*, this limitation requires that regulations enacted under the commerce power be different *in kind*, not only in subject matter and degree, from the exclusive property-like rights that are the subject of the Intellectual Property Clause.<sup>67</sup> This difference in kind, which is nowhere more clearly articulated than in the Court's explanation in *Bonito Boats* of the differences between acceptable consumer protection-like regulation and unacceptable quasi-property rights.<sup>68</sup> But when the substantive content and function of the right created by Congress crosses over the line of property-like protection (as some might argue it does in the case of the Federal Trademark Dilution Act of 1995),<sup>69</sup> Congress's actions stand on constitutional quicksand.

Even though a right in information can be constitutionally passed under the Intellectual Property Clause or the Commerce Clause, it may nonetheless involve a restriction on speech that renders it suspect under the First Amendment. This restriction arises because the enforcement of rights in information and cultural products always involves the state in refraining one person or another from using information or communicating in a manner that that person wishes to and could, but for the intervention of a law enforcement officer. The more context-sensitive judicial review that follows from this simple observation is discussed in the following section.

## **B. Of Black Beauty and Blackacre: The First Amendment and Property in Information**

In 1970, Melville Nimmer wrote about the difference between recognizing exclusive rights in the proverbial Blackacre and recognizing similar rights in a novel like *Black Beauty*. The difference, he wrote, lay in the First Amendment.<sup>70</sup> A good number of other commentators have since written about the inherent conflict between exclusive rights in information and the promise that "Congress shall make no law abridging the freedom of speech."<sup>71</sup>

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67. See Ginsburg, *supra* note 35, at 374-84.

68. *Bonito Boats*, 489 U.S. at 157-59.

69. See Robert C. Denicola, *Freedom to Copy*, 108 YALE L.J. 1661, 1665-67 (1999).

70. See Nimmer, *supra* note 2, at 1193 ("If I may own Blackacre in perpetuity, why not also *Black Beauty*? The answer lies in the first amendment. There is no countervailing speech interest which must be balanced against perpetual ownership of tangible real and personal property. There is such a speech interest with respect to literary property, or copyright.").

71. See generally sources cited *supra* note 2; Julie E. Cohen, *A Right to Read Anonymously: A Closer Look at "Copyright Management" in Cyberspace*, 28 CONN. L. REV. 981, 1020-21 (1996).

The basic conflict is analytically simple. A property right in an information good is created only if Congress prohibits most people from using certain information in certain ways. For example, in order for former President Ford to have a property right in the contents of his memoirs, the law must, at the end of the day, empower the sheriff to come to the door of *The Nation* magazine and confiscate its copies, or collect a fine, for writing an article that includes in it too many words that are copied from the Ford memoirs.<sup>72</sup> Whenever the law permits the sheriff to walk into people's offices and confiscate their publications, or levy against their belongings because of something they said or how they said it, the First Amendment is deeply implicated.<sup>73</sup>

*The Nation's* quotation from the Ford memoirs was presented to the Supreme Court in *Harper & Row*. In that case, the Court held that in the context of copyright, the conflict between property rights and the First Amendment was false, because "the Framers intended copyright itself to be the engine of free expression. By establishing a marketable right to the use of one's expression, copyright supplies the economic incentive to create and disseminate ideas."<sup>74</sup> I have elsewhere expressed the view that this statement should not be viewed as excluding First Amendment review of the actual contours of copyright law. The Court only resolved the conflict by reference to internal copyright doctrines that are increasingly under pressure—like fair use or the idea/fact-expression dichotomy implicated by the database laws.<sup>75</sup> Here, I only briefly restate that argument.

First, standard economic understandings of the incentives created by intellectual property suggest that some degree of copyright protection will increase incentives of information producers over time. However, if producers have too complete a set of rights in their information products overall production over time will decline, because the increased costs that future producers must pay to present producers for using their products as inputs will exceed the value of expected returns to present producers. Therefore, *Harper & Row* should at the very least be read to mean that a *properly-tailored* copyright scheme is an engine of free expression, leaving room for at least some First Amendment review of the contours of

72. See *Harper & Row, Publishers, Inc., v. Nation Enters.*, 471 U.S. 539 (1985).

73. For a more complete statement of this issue, see Benkler, *supra* note 2, at 386-94.

74. 471 U.S. at 558.

75. See generally Benkler, *supra* note 2, at 394-412; Yochai Benkler, *A Political Economy of the Public Domain: Markets in Information Goods vs. The Marketplace of Ideas*, in *EXPANDING THE BOUNDS OF INTELLECTUAL PROPERTY: INNOVATION POLICY FOR THE KNOWLEDGE SOCIETY* (R. Dreyfuss et al. eds., forthcoming 2000).

copyright law, such as whether it includes a sufficiently robust fair use provision.<sup>76</sup>

Moreover, I have elsewhere explained why intellectual property rights prefer large-scale, commercial producers that integrate information production with management of owned information inputs over professional and amateur noncommercial producers, and to a lesser extent over small-scale commercial authors and inventors who do not own an inventory of information goods.<sup>77</sup> This is so because the preferred organizations gain from increases in rights in a way that organizations that do not sell access to their products do not, and because they can better absorb the downstream input-cost-increase effects of intellectual property by reutilizing their own inventory.<sup>78</sup> If this is in fact the case, then copyright is “the engine of free expression” for some, but not others. It is the engine for Disney, but a drag on the Electronic Freedom Foundation or on the Free Republic Forum, for instance.<sup>79</sup> Since copyright provides incentives only to certain kinds of producers who have a limited set of reasons to put pen to paper, but imposes costs on many other types of writers, it is only in a very circumscribed form that it can in fact be “the engine of free expression;” it must leave enough room for political and cultural creation that is not driven by direct sales.<sup>80</sup>

But one need not revisit and revise, or even clarify *Harper & Row* to see that the First Amendment imposes distinctive constraints on the regulation of information production and exchange, both when the regulation falls within the Intellectual Property Clause, and most certainly when it falls outside of it.

[C]opyright’s idea/expression dichotomy [strikes] a definitional balance between the First Amendment and the Copyright Act by

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76. See Benkler, *supra* note 2, at 395-96.

77. Yochai Benkler, Intellectual Property and the Organization of Information Production 31-35 (1999), available at <http://www.law.nyu.edu/benkler/Ipec.PDF> (PDF file).

78. It is standard that intellectual property rights have the dynamic effect of increasing input costs for all future information producers. My point is that producers who own large inventories can reutilize owned inventory as inputs, and thereby reduce the cost increases that an expansion of intellectual property rights is usually thought to create. All others suffer the full impact of the increase in rights. See *generally id.* at 29-39.

79. The Free Republic forum is a web-based political discussion forum, whose participants cut and paste stories from newspapers they read online, and use these stories to start discussion threads about the story. The site operator was sued by the *Washington Post* and the *Los Angeles Times* in 1998. For a more complete description, see Benkler, *supra* note 2.

80. See *id.* at 394-412.

permitting free communication of facts while still protecting an author's expression. . . . No author may copyright his ideas or the facts he narrates. . . . As this Court long ago observed: "[The] news element—the information respecting current events contained in the literary production—is not the creation of the writer, but is a report of matters that ordinarily are *publici juris*; it is the history of the day."<sup>81</sup>

It is this *fact* about copyright law that causes the Court to refuse to recognize *The Nation's* claim in *Harper & Row*. The Court's refusal comes "[i]n view of the First Amendment protections already embodied in the Copyright Act's distinction between copyrightable expression and uncopyrightable facts and ideas, and the latitude for scholarship and comment traditionally afforded by fair use. . . ."<sup>82</sup> Copyright scholars<sup>83</sup> have often and forcefully reiterated that copyright can live in harmony with the First Amendment if copyright law provides enough breathing space in the public domain for writers and speakers to rely on the work of their predecessors, in particular for their ideas, the facts they report, and for transformative uses at the very heart of the fair use doctrine.<sup>84</sup>

The analysis that applies to the Copyright Act is suggestive of the relationship between the First Amendment and the Intellectual Property Clause. The constraints on laws imposed by the Intellectual Property Clause—the originality requirement, the exclusion of materials already in the public domain, and the express time limitation—are inherent constraints on the tension between property rights in information enacted within the confines of that clause, and the values of free speech. It is not, however, *impossible* that laws will meet the threshold constraints of the Intellectual Property Clause, but will *in context* fail the more context-sensitive First Amendment review that must be applied to all content-

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81. *Harper & Row, Publishers, Inc., v. Nation Enters.*, 471 U.S. 539, 556 (1985) (alteration in original) (citations omitted).

82. *Id.* at 560.

83. See Jessica Litman, *Copyright Owners' Rights and Users' Privileges on the Internet: Reforming Information Law in Copyright's Image*, 22 DAYTON L. REV. 587, 619 (1997) ("[T]he harmony between the First Amendment and copyright doesn't inhere in their essential nature; rather, it derives from accommodations and restrictions we have built into copyright to enhance its role as an engine of free expression."); see also Lemley & Volokh, *supra* note 2, at 210-16 (developing a remedy scheme for copyright that better comports with the First Amendment); Lange, *supra* note 1, at 240; David Lange, *At Play in the Fields of the Word: Copyright and the Construction of Authorship in the Post-Literate Millennium*, 55 LAW & CONTEMP. PROBS. 139, 140-44 (1992) (copyright grew out of government censorship efforts). "[W]hat comes naturally to copyright . . . is the deliberate, if selective, suppression and advancement of speech." *Id.* at 142.

84. See *Campbell v. Acuff-Rose*, 510 U.S. 569, 579 (1994).

neutral<sup>85</sup> direct regulations of speech. Any rule that says to one person: “you cannot say *xyz* without the permission of *a*, and if you say *xyz* without such permission the sheriff will come knocking at your door” must, at the very least, be shown actually to serve a very important state interest, and must not burden more speech than necessary.<sup>86</sup> This is so even if Congress is acting out of the best of intentions to improve the flow of information in society, as has been seen in at least some media regulation cases. One might easily imagine a court finding that applying an extension of the term of copyright by twenty years to new works does not run afoul of the “limited times” constraint in the Intellectual Property Clause,<sup>87</sup> but nonetheless imposes a very real restraint on too much valuable speech in return for “too speculative a gain.”<sup>88</sup>

This care, due in evaluating regulations of information production and exchange enacted under the Intellectual Property Clause, is doubly necessary when considering such regulations that cannot be enacted constitutionally within the bounds imposed by that clause. In the absence of the constraints that require originality, solicitude to the public domain, consis-

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85. Lemley & Volokh argue that copyright laws are content-based, because it is impossible to tell which speech is permissible and which is not without reference to the specific content of a message. See Lemley & Volokh, *supra* note 2, at 186. For example, saying “Romeo, oh Romeo,” is not prohibited, but singing “when you’re a Jet you’re a Jet” is. And the reason is the content of the statement. While attractive, I am unsure whether this view construes too literally the Court’s rationale for exercising the next-to-highest scrutiny for content-based regulation, as compared to content-neutral laws on the one hand, and viewpoint-based on the other. As the Court has repeatedly stated, whether a law is content-based or content-neutral goes to the purpose of the legislature—was the law justified in terms irrespective of the content of the speech? See *Rosenberger v. Rector and Visitors of the Univ. of Virginia*, 515 U.S. 819, 828-29 (1995); *Madsen v. Women’s Health Center, Inc.*, 512 U.S. 753, 763 (1994); *Ward v. Rock Against Racism*, 491 U.S. 781, 791 (1989). In the case of copyright, and intellectual property more generally, it seems that the law is more like media regulation than like any other law—a law that specifically regulates the production and exchange of information, and thus is always suspect, but nonetheless a law whose purpose is the promotion of speech generally, not of one particular speech determined by content. Here I will continue, as I have done before, to assume that general information-control rules are content-neutral, not content-based. Needless to say, if the Lemley & Volokh position is adopted, the laws I criticize here are on even shakier grounds than I have already suggested.

86. See, e.g., *Turner Broad. Sys., Inc. v. FCC*, 520 U.S. 180, 189 (1997); *Denver Area Educ. Telecomms. Consortium, Inc. v. FCC*, 518 U.S. 727, 741 (1996); *Turner Broad. Sys., Inc. v. FCC*, 512 U.S. 622, 662 (1994).

87. A claim raised in the plaintiff’s papers in *Eldred v. Reno*, 74 F. Supp. 2d 1, 6-7 (D.C. Cir. 1999). See Plaintiff’s Response to the Government’s Motion for Judgment on the Pleadings and Cross-Motion for Summary Judgment, 25-29, available at ([http://cyber.law.harvard.edu/eldredvreno/sj\\_memo.pdf](http://cyber.law.harvard.edu/eldredvreno/sj_memo.pdf)).

88. See 518 U.S. at 760.

tent availability of information and ideas for use by the public, and time limitation, the First Amendment becomes a more important backstop against regulation that restricts information flow too much for too speculative a gain.

### C. Conclusion: Two Constitutional Constraints

The upshot of the analysis is that a law that assigns to some people rights to prevent others from accessing certain information, or communicating in certain ways, must comply with two constitutional constraints.

First, if the nature of the right is an exclusive right intended to create market incentives for its owners, or protect those owners' investments, by permitting them to exclude others from making valuable uses of the information, then Congress may act only within the confines of the Intellectual Property Clause. It may only give such rights in original works. It cannot create such rights as would enclose or burden access to information or knowledge already available to the public, and it cannot give exclusive rights to control ideas or facts. Furthermore, Congress may only enact rights under other clauses of Article I, Section 8, in particular the Commerce Clause, if these rights are different in kind from the rights that it is empowered, within constitutional bounds, to create under the Intellectual Property Clause. Creating a general right, good against the world, in "the news of the day," for example, is beyond the power of Congress.

Second, private rights to control the use of information, whether created within the confines of the Intellectual Property Clause or properly created outside of that framework, are regulations on speech. As such, they are subject to independent and cumulative review under the First Amendment. Because of the clause's solicitude towards the freedom of the public to use the same information in which it grants limited exclusive rights, this review will usually—though not always—result in permitting regulations that pass muster under a robust application of the clause. However, when Congress creates a right outside the bounds of the Intellectual Property Clause, free of the limitations inherent in that clause, First Amendment review must become a more robust constraint. Before applying these constraints to the pending database protection bills, however, one must first consider what might justify such an elaborate two-tier constitutional limitation on legislation of private rights in information.

### III. THE REASON: WHY ADOPT ROBUST JUDICIAL REVIEW OF PRIVATE RIGHTS IN INFORMATION?

Why would anyone want to erect such cumbersome constitutional hurdles to enacting private rights in information products? The answers fall into two broad categories. First, free information flows are central to freedom—both in the sense of personal autonomy, and in the sense of political or democratic self-governance. Policies that block off various flows of information, or maldistribute access to and control over our information environment, affect all of our abilities—both as individuals and as members of communities—to be self-governing. Constitutionally based judicial review is most valuable to prevent the implementation of policies that exert these kinds of costs on individual autonomy and the proper functioning of democratic processes.

Second, the production of information, knowledge, and culture, is a conversation over time and space among creative human beings, one whose impediment will fundamentally challenge our welfare as a society and a culture. This centrality is expressed in the constitutional concern with “Progress,” and requires robust institutional constraints to prevent present generations from appropriating too much of this grand conversation at the expense of participants from future generations.

Grafted over this somewhat romantic concept of “Progress” is the hard-nosed realization that the politics of private rights in information involve a systematic imbalance between the *private* stakes for those who benefit from them and for those who suffer their costs. The social gains of private rights are perceivable as private gains by their beneficiaries. These beneficiaries therefore fully represent in the political process the value of the benefit. But the social losses caused by such rights are diffused among all potential users of the information and therefore no one knows the full scope of these costs. In particular, these losses are borne by future generations that cannot be represented in present political processes, and thus, the costs of expanded property rights in information are systematically under-represented. The result is that legislatures suffer from structural rosy vision when they consider creating private rights in information, and judges must step in to re-evaluate laws passed using this skewed perspective when the costs become apparent enough to a party to a suit.

#### A. The Centrality of Free Information Flows to Democracy and Autonomy

Why should laws regulating information and communications markets be subject to more extensive judicial review than laws regulating grain or securities markets? After all, one might say, it is one thing to have very

close scrutiny of government when it attempts to censor individual expression or public discourse, but what has that got to do with review of normal market-creating and market-regulating functions that the state has always filled?<sup>89</sup>

The answer that has co-evolved with First Amendment law in the twentieth century<sup>90</sup> has been that markets in information affect democracy and autonomy in ways that suggest an important role for courts, whereas other markets affect welfare in ways that do not similarly call for close judicial scrutiny, at least not under the federal Constitution. One can look anywhere from Madison<sup>91</sup> to Brandeis<sup>92</sup> for inspiration and will meet a similar set of conceptual commitments. For a community to be democratically self-governing its members must have access to information, this information must not be too tightly controlled by one group or another, and constituents must be able to express their views as well as receive information.<sup>93</sup> These commitments are most urgently engaged when the government purposefully tries to regulate debate in order to assure that the message it prefers will prevail in the public arena. But the extremity of the concern in those situations need not obscure the fact that the same set of commitments is engaged when the government regulates information exchange among members of society for reasons that are understood by lawmakers to be information flow neutral, or even to support the free flow

89. It does not matter much to this article whether one is more or less attached to the notion that since the New Deal there has been more regulatory activity, and we have moved from a pure market economy to a mixed economy, or whether one understands property law and contract law, replacing, say, guilds and royal monopolies, as similarly involving government regulation of production and exchange.

90. See generally David M. Rabban, *Free Speech in Progressive Social Thought*, 74 TEX. L. REV. 951 (1996); 2 ZECHARIAH CHAFEE, *GOVERNMENT AND MASS COMMUNICATIONS* 471-719 (1947) (in particular pages 678-719).

91. This is by reference to Madison's oft quoted statement that "[a] popular Government, without popular information, or the means of acquiring it, is but a Prologue to a Farce or a Tragedy; or, perhaps both. Knowledge will forever govern ignorance: And a people who mean to be their own Governors, must arm themselves with the power which knowledge gives." 9 WRITINGS OF JAMES MADISON 103 (G. Hunt ed., 1910).

92. See, e.g., *Whitney v. California*, 274 U.S. 357, 374-78 (1927) (Brandeis, J., concurring).

93. For a superb and comprehensive consideration of the relationship between varying conceptions of democratic self-governance and the information policy preferences they generate, see generally C. Edwin Baker, *The Media the Citizen Needs*, 147 U. PA. L. REV. 317 (1998). The literature developing various versions and perceptions includes CHAFEE, *supra* note 90; Owen Fiss, *Why the State?*, 100 HARV. L. REV. 781 (1987); CASS SUNSTEIN, *DEMOCRACY AND THE PROBLEM OF FREE SPEECH* (1993); and Jack Balkin, *Frontiers of Legal Thought II The New First Amendment: Some Realism About Pluralism: Legal Realist Approaches to the First Amendment*, 1990 DUKE L.J. 375.

of information.<sup>94</sup> If a law “gets it wrong” in the area of information flow regulation, it has negative effects on democracy that in the United States we have chosen to treat as particularly amenable to judicial oversight.<sup>95</sup>

I have elsewhere retold stories that illustrate this effect of seemingly neutral intellectual property rules on democratic discourse—for example, how the scientologists used copyright to quash a critic,<sup>96</sup> or how the *Washington Post* and the *Los Angeles Times* sought to prevent readers from sharing copies of articles online in order to stimulate political discourse.<sup>97</sup> Another little appreciated example of this effect, particularly pertinent to the object of our analysis here—exclusive rights in facts, history, the news of the day—is the Supreme Court’s decision in *International News Service v. Associated Press*.<sup>98</sup> The case seemed to revolve around a question of whether the Associated Press (“AP”) had a limited property-like right in the news its correspondents collected, at least vis-à-vis its competitor wire service of the time, the International New Service (“INS”). As the facts were presented in the case, INS reporters would take the facts published on the East Coast by AP-associated papers, and wire them to the West Coast, where its affiliated papers published simultaneously with, or even ahead of, AP affiliated papers.<sup>99</sup> Over the objections of Justices Holmes and Brandeis, the Court declared that the AP did in fact have a quasi-property right in the information<sup>100</sup>—a holding whose remnants still occupy the very bills that are the subject of analysis in this article.<sup>101</sup>

My point here is not, however, to revisit the wisdom or necessity of the “hot news” exception to the general wisdom that facts are not properly the subject of intellectual property. My point, rather, is to illustrate how an intellectual property rule can influence democratic discourse. The dispute

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94. See generally Benkler, *supra* note 2, at 364-81.

95. The claim about the special role of courts in protecting speech as opposed to other rights is historically and culturally contingent. As many other nations and some states in the United States show, there is nothing incoherent about a state recognizing social and economic rights as similarly appropriate for judicial review. On the development of positive rights under state constitution see Helen Hershkoff, *Positive Rights and State Constitutions: The Limits of Federal Rationality Review*, 112 HARV. L. REV. 1131, 1154 (1999).

96. See *Religious Tech. Ctr. v. Netcom On-Line Communications Servs., Inc.*, 923 F. Supp. 1231, 1238-40 (1995). For a description, see Benkler, *supra* note 2, at 356.

97. See *supra* note 79 (describing Free Republic case).

98. 248 U.S. 215 (1918).

99. See *id.* at 231.

100. See *id.* at 240.

101. See, e.g., H.R. 1858, 106th Cong. § 201 (1999).

revolved around news reports from World War I.<sup>102</sup> AP served Pulitzer papers, and its bylaws allowed Pulitzer to exclude Hearst papers from receiving the AP wires.<sup>103</sup> The INS was formed as a news service to serve those newspapers excluded from AP—namely, the Hearst papers. During the war, the European Allies excluded INS correspondents from receiving news or using transatlantic cables because the Hearst papers generally espoused an anti-English or anti-Allied position. The effect of the Court's market-regulatory decision to exclude INS papers from using AP's hot news was to burden newspapers that espoused a certain position in a hotly contested political issue in the United States. There is no evidence to suggest that the decision was based on a substantive preference for one set of political views or another rather than on the considerations of fairness and efficiency upon which the Court relied. But the point of this story is not to suggest that the Court improperly tweaked intellectual property law to support its members' views. The point is that, like many other courts when they don their "intellectual property" hats, the Court was blind to the effects of its decision about property rights on democratic discourse. Recognizing a property right in the news of the day made it possible for those who espoused one view of a central political question of the time to control public reporting and debate of that question. It is a particularly clear instance of the general effect of property rights in information; they affect not only, or even primarily, how much information is exchanged in our public conversations, but more importantly who gets to say what to whom, and who decides these questions.

A less commonly recognized effect of property rights in information is that they create a similar set of concerns for our normative commitment to personal autonomy. The point has to do with the degree of control that individuals have over the information environment from within which they make their life choices, and the degree of control others have to shape the information environment within which an individual chooses. To be an autonomous individual is to be, to a significant extent, the author of one's life through a series of successive choices. To choose our path in the world, we must have a sense of the range of options open to us and an evaluation of the relative worth of these options. These two elements of information—knowledge of options for action and an evaluative framework to compare them—are germane to our capacity to be the authors of our lives. The pattern of distribution in a society of control over the infor-

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102. For historical accounts of the case, from which the following discussion is drawn, see HAROLD INNIS, *THE BIAS OF COMMUNICATION* 179-80 (1991); see also Epstein, *INS v. AP: Custom and Law*, 78 VA. L. REV. 85, 90-93 (1992).

103. See 248 U.S. at 264 n.1 (Brandeis, J. dissenting).

mation that defines the range of options open to individuals in that society is central to the extent and distribution of autonomy in that society.<sup>104</sup> Property in information is one dimension of information law that can give some people control over the information environment of others, which they can use to alter the likelihood that those others will behave in a manner conducive to the plans of those who own the information. When this happens, property rights increase the ability of their owners to author the lives of others, and decrease the autonomy of those others.

Imagine that Jane wants to buy a home, having settled into a new job. Her job leaves her very little time to shop for a mortgage during times when the two banks in her town are open. Given her personal condition, her search costs are high so she only knows about mortgage rates available from these two banks.<sup>105</sup> She soothes her concern over not having time to search for a better mortgage by assuming that the market is efficient, and that all banks offer roughly equal terms. It turns out, however, that the mortgage rates of the two banks are higher than those available in larger urban areas in the state, reflecting the fact that there are many people in town who share Jane's predicament. At the mortgage rate available from either of these two banks Jane cannot afford a house—she must live in an apartment. At the mortgage rate available from banks at larger urban centers, she could afford a house. But she does not know of this choice. Given her state of knowledge, the only choice she sees as open to her is what apartment to live in, not whether to live in an apartment or a house. Assume that is a decision important enough to one's well-being to count as a choice, the presence or absence of which can plausibly be seen as important to one's personal autonomy.<sup>106</sup>

Now bring in property rights. Along comes a database company that plans to collect data from the lists of mortgages compiled and maintained

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104. For more complete statements of this point, see Benkler, *supra* note 2; see also Yochai Benkler, *Siren Songs and Amish Children: Autonomy, Information, and Law* (Feb. 10, 2000) (unpublished manuscript, on file with author).

105. Search costs are a form of transaction cost that describes the cost a party must incur to search for its most desired good. As search costs increase, a party will settle for a lower fit between the good she has and what her first best preference would have been in the absence of costs, and accept a good that is as close to that preference but that can be identified with search costs that are lower than the difference between the value of the preferred good to the party and the value of the good actually acquired.

106. See JOSEPH RAZ, *THE MORALITY OF FREEDOM* 375 (1986) (describing the need for a range of choices at many layers of importance—from the mundane to the grand—to make a life self-authored, or autonomous); see also Margaret Jane Radin, *Residential Rent Control*, 15 PHIL. & PUB. AFF. 350 (1988) (describing centrality of home to personhood).

by all the banks in the state, and compiles them into a single, easily accessible database.<sup>107</sup> Assume that, were such a database available to consumers, Jane would have the time and money to buy it and use it to expand her knowledge of available mortgages, and with it her known set of options. The company's business plan forecasts acceptable returns, assuming the present state of the law on ownership of facts—they are in the public domain, free as the air to common use. As it turns out, Congress passes a law that gives the banks a property right in the facts of their compilation, so the database producer cannot copy them into a larger, value-added database without permission.<sup>108</sup> It turns out that there are many banks in this state like the two banks in our town. These banks are quite happy to deny access to their data, or to charge a price that would compensate them for the premiums (over competitive rates) that they would lose from consumers like Jane. Faced with these new, higher costs of creating its database (paying for each bank's list rather than simply searching for and copying the lists), the database company abandons its project.

One common response to such a story would be to view it as a simple example of the well-known static efficiency losses caused by intellectual property rights, which, if justified, are usually justified by their beneficial incentive effects on dynamic efficiency. An information product that would have been produced is not produced, even though its value will exceed the marginal cost of its production.<sup>109</sup> What I would like to focus on, however, is the effect of this decision on Jane's choice set and on the distribution of power to control the definition of her choice set.

In the absence of the property right, the banks had no formal right to limit Jane's perception of the life choices open to her. Jane's perception was limited by her life conditions and the choices of others around her, but not by a legal right that prevented a change in that perception. When the banks' property rights were recognized, they received a legal right to prevent such a change, to prevent use of their information to change her knowledge of her options. By denying access to their information, a denial similarly exercised by other banks operating under similar circumstances,

107. The example of mortgage lists and their compilation in the manner described in the text is taken from the Committee Report on House Bill 1858 as an example of what its narrow scope is intended to exclude. *See* H.R. REP. NO. 106-350, pt. 1, at 8 (1999)

108. This is in fact what House Bill 354 proposes to do. *See* H.R. REP. NO. 106-349, pt. 1, at 9 (1999).

109. Note here that the marginal cost of information, once produced, is zero, and that the marginal social cost of use of the mortgage price lists that banks generate for internal purposes is similarly zero. The increased cost reflects the private cost to the banks of losing control over their information, but not a social cost. *See id.* at 10-12.

the banks imposed their preferred picture of the world on Jane, limiting her perception of her life choices so as to increase the likelihood that she will behave in a manner conducive to their interests. The banks did not care whether Jane lived in an apartment or a house. But they did want Jane to buy her mortgage from them, at a high price, and they are now entitled to prevent access to their information so as to affect Jane's choice. As a by-product of increasing the likelihood that Jane will act in a manner consistent with their plans, they restricted Jane's life options so that she now may only choose from among apartments, but not between being an apartment-dweller and a homeowner.

Imagine another alternative: that the database compiler did invest in collecting the information, relying precisely on the new property right to justify the investment. This is, after all, the beneficial incentive effect sought for the law. Assume further, however, that the costs of collection are such that only one or two companies can undertake them, given the expected market for the information itself. One of two things will happen. Either the first database compiler will sell the aggregate information to consumers like Jane, or it will sell to small town banks its agreement to abstain from selling the information.<sup>110</sup> The banks have better information about the value of the information in the database than do those consumers who should value it most highly—namely, those who, in the absence of the database, do not know about lower mortgages. But these are precisely the consumers least able to determine the value to them of access to this database. So, the company will or will not release the information, based on whether these consumers as an aggregate under- or overestimate the premium they are paying for not knowing what other mortgages are available. Competing database compilers would be warded off from entering the market to serve consumers, however, even if the first database compiler did not sell to consumers. They would expect that once they enter the market, small town banks will no longer value (and pay for) withholding the information, and the first database compiler would have to turn to consumers to appropriate the value of its investment. That provider will then be able to price below the new entrant, because it has already recouped some or all of its compilation costs from the banks, whereas the new entrant has to recoup these costs entirely from consumers.

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110. Imagine that the agreement is part of the terms of sale of the initial access to the bank's database. The bank might require, for example, that the data only be available to consumers in certain organizations, so as not to undermine the bank's advantage vis-à-vis most consumers, or that the information be included only in databases of loans available in small towns.

Recognizing property rights in information created a locus of control that allowed various players in a social environment to try to manipulate the information environment of others in that society so as to affect their behavior. When property rights are designed in ways that have a more-or-less predictable effect of centralizing control over information, or systematically tipping the scales in favor of one group or another in controlling the information environment of some other group, our normative concerns with autonomy ought to be engaged.

This effect of property in information is under-recognized. Indeed, the concern with autonomy is usually cited in opposition to policy recommendations to restrict property in information, which themselves are usually defended in the name of democracy or robust political discourse. The most explicit instance of this perception of the conflict is the debate between Owen Fiss and Robert Post.<sup>111</sup> The theory underlying both these commentators' acceptance of the conflict between democracy and autonomy as ways of approaching information law is their joint acceptance of autonomy as a sphere of noninterference by the state,<sup>112</sup> not as a personal condition admitting of degree, whose extent and pattern ought to be the concern of information law and policy.

A review of some central liberal accounts of autonomy,<sup>113</sup> however, suggests that personal autonomy is best understood both as a threshold, on/off category—which would justify treating autonomy as inconsistent

111. See, e.g., OWEN M. FISS, *LIBERALISM DIVIDED: FREEDOM OF SPEECH AND THE MANY USES OF STATE POWER* 36-38 (1996); Robert Post, *Equality and Autonomy in First Amendment Jurisprudence, Reviewing Fiss, Liberalism Divided*, 95 MICH. L. REV. 1517 (1997).

112. To be clear, I am not implying that Post's sophisticated critique takes on a simplistic libertarian conception of autonomy. But he does suggest that managerial control over life choices undermines the very concept of autonomy, and hence the value depends on abstention from managing the extent of and capacity for autonomy that people actually have. Since, he argues, a concern for democracy must derive from a concern for individual autonomy, he rejects the notion that autonomy and democracy collide, proposing instead that autonomy and equality collide. This conflict, and his overarching commitment to autonomy, lead to his acceptance of only very limited regulations, on clearly defined entities such as broadcast outlets designated as public functionaries, within a framework that generally rejects benign regulation in aid of either a robust system of public discourse or of better information flows necessary for autonomous choice. See Post, *supra* note 111, at 1538-39. See generally Robert Post, *Meiklejohn's Mistake: Individual Autonomy and the Reform of Public Discourse*, 64 U. COLO. L. REV. 1109 (1993) (providing a critique of supposedly democracy-based regulations that undermine autonomy, and the ascriptive conception of autonomy upon which his analysis relies).

113. I rely for this account primarily on Joel Feinberg, *Autonomy*, in *THE INNER CITADEL* 27 (J. Christman, ed., 1989); GERALD DWORKIN, *THE THEORY AND PRACTICE OF AUTONOMY* (1988); JOSEPH RAZ, *THE MORALITY OF FREEDOM* 369-99 (1986).

with constraints on property rights—and as a matter of degree—which would justify paying close attention to the actual effects of property rights in information on personal autonomy. Both aspects of the concept are normatively significant.<sup>114</sup> Thinking of autonomy as a threshold capacity to be self-governing, which almost all sane adults have, animates the liberal attention to treating all individuals as self-governing and deserving as such of equal regard. On this conception alone, autonomy calls for abstaining more than for designing an environment within which people can be more autonomous. Thinking of *the degree* to which individuals can exercise this capacity as normatively relevant alters one's policy focus. For, if the capacity of individuals to be autonomous while living in a world largely made by others and the amount of autonomy they actually possess, are a matter of degree, and if the degree of autonomy available to individuals should be seen as a normative concern of that society, then increasing people's autonomy becomes an important concern for policy making.

The argument about information policy and autonomy goes more or less like this. Individuals can have more or less capacity to lead autonomous lives, and their lives can be, as a factual matter, more or less autonomously lived, based on the extent to which they can play a role in authoring their own lives. The quantum of autonomy people can have and do actually enjoy is partly a function of the information they have about the world as it is, and the options open to them to live their lives. This information, central to individual autonomy, can in turn be more or less controlled by the individual. Information policy that moves the center of control over the information environment from within which each of us must choose and live our lives, in turn, affects the extent to which we can be, and are, autonomous. As law permits individuals to play a more significant part in defining the information environment from within which they choose their lives, it enhances the relative role those individuals play in authoring their own lives. As it does so, it can be seen as a more autonomy-loving law. As law shifts control over the information environment from within which its subjects choose away from most individuals, it undermines the personal autonomy of most of its subjects. Courts, acting as institutional defenders of individual rights, are the appropriate locus to protect personal autonomy from information laws that shift control over

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114. On the difference and its importance between ascribing *only* threshold capacity for autonomy as opposed to describing quanta of autonomy as normatively relevant, see Richard H. Fallon, Jr., *Two Senses of Autonomy*, 46 STAN. L. REV. 875 (1994).

individuals' information environment away from them—whatever the supposed beneficial effects of the shift in terms of the general welfare.<sup>115</sup>

The hypothetical example of Jane's mortgage focused on direct control over access to information relevant to defining the options open to one person. One finds more murky, but still instructive, examples in actual cases.

Consider the question of how intellectual property interacts with perceptions of matter so central to self-definition as sex and sexuality. At the most basic level we see the case in which the United States Olympic Commission used its statutory exclusive right over the use of the term "Olympic" to obtain a court order preventing organizers of the "Gay Olympic Games" from using this term to name their event.<sup>116</sup> The Court understood the case before it as concerned with a right to commercial exploitation. But, as Boyle has explained,<sup>117</sup> this commercial right was used in that case for private censorship—to prevent the expression of a cultural message about the acceptability of homosexuality as a way of living. While no one could plausibly claim that this decision eliminated homosexuality from the range of options known to be open to individuals defining their sexuality, it is a rather crisp instance of exclusive property rights intervening in determining who has the power to control public statements about the relative worth of this life choice as opposed to alternative life choices.<sup>118</sup>

At a more "technologically sophisticated" level, we might see two suits brought by Playboy Enterprises to try to control the social meaning of the alphanumeric string, "playboy." In one case a former playmate, Terri Welles, used the term in the metatags describing her site to search

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115. Identifying the information policies that support both individual autonomy and robust democratic discourse is a fascinating project that must be left for another day.

116. See *San Francisco Arts & Athletics, Inc. v. U.S. Olympic Comm.*, 483 U.S. 522 (1987).

117. JAMES BOYLE, *SHAMANS, SOFTWARE, AND SPLEENS: LAW AND THE CONSTRUCTION OF THE INFORMATION SOCIETY* 145-48 (1996).

118. I am not actually trying to engage the question of whether homosexuality is chosen or genetically endowed. I only suggest that whether one lives a life that is sexually fulfilling, given either a genetic or environmental context, is a matter of central importance about which an individual should be autonomous, and that autonomous choice is dependent on adequate access to information both about the availability of various ways of living a sexually meaningful life, and about their relative worth given one's endowment and context.

engines.<sup>119</sup> Playboy claimed that since her site was not authorized by the company, Welles could not use the alphanumeric string to identify her site as relevant to those interested in finding documents relevant to the term “playboy.”<sup>120</sup> In the other case, Playboy challenged the practice of a search engine, Excite, of treating the term “playboy” as a general request for soft porn.<sup>121</sup> Excite returned to users who searched for the term—in addition to sites authorized by the plaintiff—results that were not related to Playboy Enterprises, including advertisements by competitors together with the search results.<sup>122</sup> But it is important to understand that what was at stake in these cases was whether a trademark right will give its owner the exclusive right to determine the range of options open to users who rely on its mark to search for sexual materials. Most importantly, they involve the question of whether the initial role played by the mark in signifying interest in sex permits the organization, Playboy Enterprises, to define for those who seek sexual materials what counts as “sex” or “sexually gratifying expressions.”

As information about the world around us becomes increasingly diverse and dispersed, the right to control search engines, filters, and the very definition of relevance becomes the right to control the perceptions of individuals about what options are open to them. The right asserted by Playboy in these cases was a right to determine the range of options presented to users who initially expressed their interests using the term “playboy.” And control over the range of options open to individuals is control over their choice. At stake in the *Welles* case was the question of how individuals can rely on their own understanding of the cultural signification of “owned” words to present themselves as relevant to others. At stake in *Excite* was to what extent trademark owners would be able to control the definition of cultural and social signification and whether they would receive an exclusive right to dictate the options presented to those who use their “owned” signifier to represent a choice or “search.” In both cases, the result would be a more or less concentrated structure for the determination of relevant options open to one who uses a given signifier to define the choice one views oneself as making. The more centralized the structure, the more individuals seeing the world through the controlled lens come to

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119. Metatags are descriptors inserted in a web page, but not viewable to human eyes, that are used to describe the content of the page to search engines. See Meta, (<http://www.whatis.com/metatag.htm>) (visited Apr. 13, 2000).

120. See *Playboy Enters., Inc. v. Welles*, 7 F. Supp. 2d 1098, 1101 (S.D. Cal. 1998).

121. See *Playboy Enters., Inc. v. Excite, Inc.*, 55 F. Supp. 2d 1070 (C.D. Cal. 1999).

122. See *id.* at 1072.

be controlled by owners of the rights to define signification and relevance, and the less autonomous these users become.

Information, then, is central both to democratic self-governance and to personal autonomy. Laws regulating control over information flows must therefore be subject to special care in our democracy, a care we have come to institutionalize in judicial review. In the case of exclusive rights to control the use of information, Part II suggested that judicial review should be applied using two vehicles—the threshold constraints imposed by the Intellectual Property Clause and the more context-sensitive constraints imposed by the First Amendment.

### B. “Progress” and the Political Economy of Enclosure

In addition to the normative concerns surrounding enclosure of information, enclosure raises immensely important general welfare concerns that are systematically ill-represented in political processes. I will treat these problems using the admittedly quaint heuristic of “Progress,”<sup>123</sup> the value to whose service the Intellectual Property Clause is dedicated.<sup>124</sup>

The structure of the modern idea of Progress from the mid-eighteenth century until quite late in the twentieth century provides a useful guide to

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123. Basing any policy conversation on a notion of “Progress” at the beginning of a new millennium will probably strike many as quaint, ignorant, or irrelevant, and possibly all three. It might strike one as quaint or ignorant, because this concept, so central to European-North American political, economic, and social culture from the mid-eighteenth to the mid-twentieth century has been subject to extensive and sustained critique at least since the two world wars shattered the naive confidence in its beneficence. *See, e.g.*, PROGRESS AND ITS DISCONTENTS (Gabriel A. Almond et al. eds., 1982); JAMES NISBET, HISTORY OF THE IDEA OF PROGRESS (1980). It might strike one as irrelevant because Progress is such a world-historical, communal concept, one that has to do with the condition of “civilization,” or “humankind.” These universalizing corporatist concepts seem increasingly irrelevant to our individual-centered conception of society, which is tempered mostly by recognition of subcultures and small-scale communities defined more often than not in opposition to the more universalizing corporatist concepts usually implied by Progress. Despite this oddity, I will nonetheless venture to think through the general welfare side of the question of the propriety of close judicial review of exclusive rights in information through the heuristic of “Progress.” If you will, this is a standard exercise in constitutional interpretation rooted in text and the history of the value it embeds. Perhaps it is a new-found optimism of one living not only more than fifty years after Hiroshima, but also in a decade where instant satellite-borne news has pushed the international community to humanitarian action in Bosnia, Kosovo, and East Timor, where radio B92 could resist closing in Belgrade by moving to webcasting, on a medium invented only four or five years earlier—the Web. *See* Matt Richtel, *Banned Belgrade Station Turns to the Internet*, N.Y. TIMES, Apr. 1, 1999, at G3.

124. “To promote the Progress of Science and the useful Arts. . .” U.S. CONST. art I, § 8, cl. 8.

understanding the stakes of exclusive rights in information or knowledge.<sup>125</sup> In this quintessentially modern of ideas, Progress is the product of human agency, not the Divine. It is a forward movement whereby one generation builds on the attainments of its preceding generation, and in turn becomes the stepping stone of the next generation's improvements. The engine of Progress is the progress of knowledge. Knowledge itself, like Progress, advances through human agency and improves from one generation to the next in a process of accretion. It feeds technological innovation, which increases the spread of material welfare and the development of better organizational and institutional arrangements, all of which feed back on each other. Over time, these together lead to the intellectual, moral, and aesthetic improvement of the human condition.<sup>126</sup> This too was the basic structure of the idea that animated the passage of the Intellectual Property Clause.<sup>127</sup>

Understanding this structure of the idea of Progress is central to understanding why private rights in information and knowledge were understood by the drafters of the Constitution as "monopolies" to be carefully circumscribed, rather than as property rights to be cherished and protected.<sup>128</sup> The object of property is Nature, given to industrious Man to make fruitful and thereby make his own. The object of exclusive rights in

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125. See PROGRESS AND ITS DISCONTENTS, *supra* note 123, at 5; NISBET, *supra* note 123, *passim*.

126. For a particularly succinct presentation of this structure of the idea, see PROGRESS AND ITS DISCONTENTS, *supra* note 123, at 5.

127. See NISBET, *supra* note 123, at 198-200. Nisbet quotes a particularly clear reiteration of this intellectual structure from one who is not normally mentioned in the debates over copyright or patent, as an example of the pervasiveness of this intellectual structure at the time; Adams opens his preface to *Defense of the Constitutions of Government of the United States* with the following statement:

The arts and sciences, in general, during the three or four last centuries, have had a regular course of progressive improvement. The inventions in mechanic arts, the discoveries in natural philosophy, navigation, and commerce, and the advancement of civilization and humanity, have occasioned changes in the condition of the world, and the human character, which would have astonished the most refined nations of antiquity. A continuation of similar exertions is everyday rendering Europe more and more like one community, or single family. Even in the theory and practice of government, in all the simple monarchies, considerable improvements have been made.

*Id.* at 199.

The structure of the idea of progress—the move from advances in knowledge to technology, to welfare, to organizational and institutional improvement (culminating in the American system, the best to that date)—is plainly visible in this paragraph.

128. See generally sources cited *supra* note 18.

one's contributions to the Progress of knowledge is knowledge itself—Knowledge, not given in some Promethean transfer, but developed progressively over time, as one intellectual laborer adds to the common project, to be followed by others like him. More like Commerce<sup>129</sup> than like Nature, Progress is a common enterprise, carried on by all, for the benefit of all. And like exclusive rights to Commerce—monopolies—exclusive rights to segments of the great process of Progress are to be feared and curtailed. Like a monopoly on tea, or a monopoly on printing, they are feared to be the product of faction preference, of a deal between the governor and some of the governed at the expense of the common good.

What is important to understand for contemporary purposes of institutional design is that insofar as the progress of knowledge is concerned, the basic assumption is that the politics of faction will lead to *too much* recognition of exclusive rights at the expense of the common good, whereas the major concern about the politics of faction with respect to traditional property was that it would lead to *too little* respect for property, by supporting redistribution at the expense of the common good.<sup>130</sup>

So, if we try to break down the core components of the concept of "Progress" into contemporary terms, we arrive at the following uncontroversial list. First, both theoretical learning and practical innovation are central to material well-being.<sup>131</sup> Second, these advances are by nature incremental, with each new participant and each new generation building on the achievements of its predecessors, and building a platform upon which future participants in this process will themselves build.<sup>132</sup> Third, the

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129. On the idea of Commerce, see Carol Rose, *The Comedy of the Commons: Custom, Commerce, and Inherently Public Property*, 53 U. CHI. L. REV. 711 (1986).

130. See JENNIFER NEDELSKY, *PRIVATE PROPERTY AND THE LIMITS OF AMERICAN CONSTITUTIONALISM: THE MADISONIAN FRAMEWORK AND ITS LEGACY* (1990); Jennifer Nedelsky, *Roads Not Taken: Undercurrents of Republican Thinking in Modern Constitutional Theory: Democracy, Justice, and the Multiplicity of Voices: Alternatives to the Federalist Vision*, 85 NW. U. L. REV. 232, 232-38 (1990) (discussing the centrality of the concern about property in the concept of the politics of faction).

131. See JOSEPH A. SCHUMPETER, *CAPITALISM, SOCIALISM, AND DEMOCRACY* (1942). The central role of technology as the engine of growth, more than growth in capital or labor inputs, or in static allocational efficiencies, was given its most prominent imprimatur of empirical verification in Robert M. Solow, *Technical Change and the Aggregate Production Function*, 39 REVIEW OF ECONOMICS AND STATISTICS 312 (1957) (showing that of a doubling of productivity between 1909-49, 87.5% of the growth was attributable to technological development, and 12.5% to increased use of capital).

132. See Suzanne Scotchmer, *Standing on the Shoulders of Giants: Cumulative Research and the Patent Law*, 5 J. ECON. PERSP. 29 (1991). This realization was introduced into what became the standard welfare economics model of intellectual property in Kenneth J. Arrow, *Economic Welfare and the Allocation of Resources for Invention*, in THE

product of all the individual efforts making up the progress of knowledge leads to large scale, society-wide benefits at the material, organizational, institutional, and cultural levels. Knowledge production is, in other words, a high positive externality activity,<sup>133</sup> whose external benefits accrue to diffuse beneficiaries in diverse ways.

The first component of the list, the importance of innovation and the progress of knowledge to aggregate welfare, would not, by itself, counsel close judicial review. We do not, after all, think that courts are systematically better than legislatures at determining good policy. But the second and third elements of what might make for a contemporary, non-naïve understanding of "Progress," do suggest systematic weaknesses in the legislative process, weaknesses that judicial review could remedy.

The second element goes to the systematic intergenerational bias of legislators. If Progress is a joint enterprise of present and future generations, then an optimal policy in the pursuit of Progress must take into consideration the costs and benefits of any exclusive right in information to both present and future generations. But future information producers and future constituencies that benefit from their innovation do not vote for, or contribute to, present legislators. Only present participants do. What we are therefore likely to see is a systematic bias of legislators to provide exclusive rights—which favor present participants over future participants. Courts, not similarly beholden to present participants, are in a better position to take stock of the overall effects of a proposed law on the intergenerational enterprise called Progress. As among potential institutional decision-makers, they are the best residual bearer of the decision-making power, because they are the most insulated from the pressures of today's participants.

The third element—the recognition of the high positive externalities involved in information production—suggests that laws designed to respond to the interests of present producers by maximizing their private benefits will not systematically coincide with laws best tailored to optimize knowledge production. Say that a new law, for example copyright term extension, slightly increases the ability of producers to appropriate the benefits of their work but significantly limits the ability of society at large to capture the externalities created by a copyrighted work. It will rarely be the case that any individual in society bears the full public cost of these lost positive utilities as private costs. And, whenever no individual

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RATE AND DIRECTION OF INVENTIVE ACTIVITY: ECONOMIC AND SOCIAL FACTORS 609, 616-17 (National Bureau of Economic Research ed., 1962).

133. See sources cited in Benkler, *supra* note 2, at 435 n.304.

or organization sees the full public costs as private costs, the social costs of an increase in property rights will be underrepresented. Moreover, unless there happens to be an individual or organization who sees private costs that are on par with the benefits that the vendors see as private gains from the change in law, the benefits of the legislation will always be presented to legislatures as outweighing the costs. This leads to a systematic information imbalance whenever a legislature considers a measure to increase the scope of intellectual property rights. The public benefits of the measure are more completely reflected as private benefits for participants in the political conversation—the owners of the new rights—while the public costs are usually reflected as much lower private costs, for a much more widely dispersed constituency. Occasionally a set of costs may be reflected as private costs for a given constituency, and in those instances we would tend to see Congress addressing the costs presented to it by that constituency.

What we would expect to see from such a structure of the information flow into a legislative process is an expansion of rights over time, tempered by specific exemptions for those constituencies who happen to experience a particular set of public costs as private. And this is in fact what we see in the area of intellectual property law—systematic expansion of property rights tempered by exceptions and exemptions for groups who presented to Congress their own subset of the total social cost of the new rights. This structure dates back to Noah Webster's involvement in the passage of copyright acts in the states to protect his dictionary,<sup>134</sup> and was nowhere more evident than in the drafting of the Copyright Act of 1976, so comprehensively described by Jessica Litman.<sup>135</sup> More recently we saw it in the Digital Millennium Copyright Act,<sup>136</sup> which vastly expanded the ability of providers of information in digital media to exclude non-paying users from their products, tempering this expansion with a long list of exemptions for specific constituencies.<sup>137</sup> In the database bills considered in

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134. See Walterscheid, *supra* note 18, at 40-41 (noting Webster's vigorous support for strong copyright protection, but casting doubt upon Webster's alleged influence on the drafting of the Intellectual Property Clause).

135. See Jessica Litman, *Copyright, Compromise, and Legislative History*, 72 CORNELL L. REV. 857, 869-79 (1987) (describing the nature of that Act's provision as a negotiated settlement among specific stakeholders); see also Robert C. Denicola, *Freedom to Copy*, 108 YALE L.J. 1661, 1684-86 (1999).

136. Pub. L. No. 105-304, 112 Stat. 2860 (1998).

137. These include those engaged in law enforcement, intelligence, and other government activities intended to assure computer security; software manufacturers who reverse engineer a competitor's software, to the extent necessary to make the manufacturer's product compatible with that of the competitor; those engaged in encryption re-

Parts IV and V below, there is no clearer example of this than the absolute exemption given in the broader of the two bills to religious use of genealogical information, apparently central to the practices of the Church of Jesus Christ of the Latter-Day Saints.<sup>138</sup>

Unlike legislatures, which can respond to no wider a range of social benefits and costs than those internalized at the time it is passed, judges encounter the legislation over time, as its social costs come to be borne as private costs by individual parties to the litigation before them. While courts cannot completely compensate for the informational imbalance regarding legislation that encloses information, over time they nonetheless have a potentially more comprehensive view of the social costs of the exclusive rights created by the legislature. Faced with the systematic informational bias in the legislative process, courts should recognize their relative advantage in observing the social costs of these laws and adopt the role of counterweight to balance the bias's effects.

### C. Conclusion

This section suggested why we might want a robust system of judicial review for what might, at first glance, look like a normal governmental regulatory function. I proposed two answers. First, the way information flows in society, and decisions about who controls information flows under what circumstances, play a central role in defining our democracy, and in defining to what extent, and under what constraints, each of us can be an autonomous human being. Second, the political economy of regulating information flow is subject to systematic imbalance in the representation of present stakeholders relative to future generations, and in the representation of its private benefits relative to its social costs.

Judicial review is an appropriate institutional mechanism to recalibrate the process by which our society creates exclusive rights to control information flows in our information environment. Courts have traditionally played an important role in assuring the conditions of a well-functioning democracy and in protecting the value of personal autonomy against measures intended—at least purportedly—to advance the public good. Courts are also a good backstop against systematically unbalanced legislative and regulatory processes because they march to the beat of a different

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search; those engaged in excluding minors from Internet materials; users, to avoid revealing personally identifiable information about the user to the owner of the protected materials; and those engaged in bona fide security testing of computer systems. *See id.* § 1201(e)-(i).

138. *See* H.R. 354, 106th Cong. § 1403(h) (1999); *see also infra* note 166.

drum, can take a longer view of the effects of laws, and are presented with arguments from equally engaged parties.

#### IV. CONSTITUTIONALITY OF THE DATABASE PROTECTION BILLS UNDER THE INTELLECTUAL PROPERTY CLAUSE

If the House of Representatives had purposefully tried to create a test case of the constitutional bounds imposed on it by the Intellectual Property Clause, its members could not have done better than to propose the two main opposing database protection bills reported to the House on September 30, 1999. House Bill 354, reported from the Committee on the Judiciary by Representative Coble, creates a property right in raw information in all but name. As reported, House Bill 354 prohibits extraction of information from a database, both for reuse and dissemination and simply for use, and gives database owners the right to track and prevent uses of information extracted from their database into downstream products—whether or not they compete with the database. The report suggests that the law is intended to secure incentives for investment in databases and to prohibit most valuable uses of information obtained from the database without the owner's permission. House Bill 1858, reported from the Committee on Commerce by Representative Bliley, on the other hand, assiduously shies away from property, and attempts to remain within the confines of unfair competition. It addresses competitors only, not users—either consumers or downstream creative users. It prohibits duplication, defined narrowly as slavish copying of the contents of the database without adding value, for sale of this data in competition with the source database. And it vests enforcement in the Federal Trade Commission. As one reviews the background and components of each proposed law, it becomes clear how House Bill 354 fails both the threshold test imposed by the Intellectual Property Clause and the backstop constraint imposed by the First Amendment, while House Bill 1858 survives at least the former, and probably the latter. This part reviews the constitutionality of the two bills under the Intellectual Property Clause, while Part V reviews constitutionality under the First Amendment.

##### A. Background

In 1991, in *Feist Publications, Inc. v. Rural Telephone Services Co.*,<sup>139</sup> the Supreme Court held that raw facts in a compilation, or database, were not covered by the Copyright Act, and could not be so protected consistent

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139. See discussion *supra* text accompanying notes 27-38.

with the constraints imposed by the Intellectual Property Clause.<sup>140</sup> The Court held that the copyright law could protect the creative element of the compilation, its organization or selectivity, for example,<sup>141</sup> but could not protect the facts compiled. There are conflicting accounts of whether *Feist* thereby broke with a widespread practice of protecting “sweat of the brow” works—works created by investment of money and labor, but lacking creativity—or whether the Court merely acknowledged, adopted, and embedded at the constitutional level the general trend among the lower federal courts.<sup>142</sup> What is not debated is that the past few years have seen repeated efforts to pass legislation that would remedy the perceived deficiency that the Court’s holding in *Feist* created—namely, that producers of investment-intensive, uncreative collections of information did not have a property right in data they collected.

That the Court rooted its *Feist* decision in a robust interpretation of the Intellectual Property Clause created something of a difficulty for those seeking that holding’s legislative nullification—namely, it did not seem possible for them to do so without running afoul of the Intellectual Property Clause.<sup>143</sup> Efforts to protect database providers therefore eventually settled not on a sui generis quasi-property right, as that recognized in the European Database Directive,<sup>144</sup> but rather on an unfair competition law, which could be based in the Commerce Clause, free and clear of the inconvenient weight of *Feist*.

This background has created a rather unique natural experiment for testing the bounds imposed by the Intellectual Property Clause on Congress. We know from our general constitutional analysis that intellectual property rights must be passed, if at all, within the confines of the Intellectual Property Clause. Only protections that are different in kind can be passed under the more general commerce power.<sup>145</sup> We also know, from *Feist*, that intellectual property rights cannot, consistent with the requirements of the Intellectual Property Clause, be recognized in the factual contents of a database, but only in its creative elements. What we now face is

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140. See *Feist Publications, Inc. v. Rural Tel. Servs. Co.*, 499 U.S. 340, 349-50 (1991).

141. See *id.* at 348-50.

142. See *Collections of Information Antipiracy Act: Hearings on H.R. 2652 Before the Subcomm. on Courts and Intellectual Property of the House Comm. on the Judiciary*, 105th Cong. (1999) [hereinafter *CIAA Hearings*].

143. See Pollack, *supra* note 1, at 54 n.44 (citing contributions to the debate of just how fully *Feist* bound Congress not to pass such legislation).

144. See Council Directive 96/9/EC of 11 March 1996 on the Legal Protection of Databases, 1996 O.J. (L 77) 20.

145. See *supra* text accompanying notes 67-69.

the task of examining competing efforts in Congress to protect database providers, to see whether they in fact provide a *different kind* of protection, or whether they are, functionally, an attempt to legislate a quasi-property right.

### B. The Method of Comparison

The Intellectual Property Clause captures not only legislative efforts that are formally aimed at creating intellectual property rights, but also those that create exclusive rights that are functionally equivalent to intellectual property rights.<sup>146</sup> I therefore suggest here that the relevant comparison between the database protection bills and intellectual property is one of function, and here I will focus on economic function. The economic function of intellectual property rights is to provide the legal entitlement that makes information goods partly excludable.<sup>147</sup> The technological and legal characteristics of every good locate it somewhere along a range from fully a public good to fully a private or economic good, as defined by the degrees to which the good is rival and to which it is excludable.<sup>148</sup> Whether a good is rival or nonrival is solely a function of the state of technology. It either can, as a practical matter, be used by many people simultaneously without anyone's use rivaling that of another, or it cannot. Whether a good is excludable—whether its producer can as a practical matter prevent some or many people from using the good unless they promise to pay—is both a question of technology and of law. Land is excludable partly because fences can be built and partly because trespass is prohibited, so that jumping the fence will trigger a visit from the sheriff. Property rights in any given good define the parameters of its excludability in conjunction with nature.

Intellectual property rights define the excludability of information products. In order to provide producers of information goods with an incentive to produce, intellectual property rights give their owner a degree of exclusivity in controlling the use of "their" information product. They do so by stating an entitlement, and coupling it with a promise by the state to prevent users who seek to make use of the information in ways covered by the law from doing so. Since those uses are valuable to some users of the information, the owners sell permission to use to those users, and thereby appropriate the benefit that their productive enterprise has created for the users.

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146. *See id.*

147. On the meaning of excludability and its relation to information, see *supra* note 23.

148. *See id.*

Intellectual property rights are in this sense market-creating—they are constitutive of the properties of the goods sold in the market. Functionally, this distinguishes them from laws that are market-regulating, or that constrain behavior in a market for goods whose excludability is already defined by other rules—namely, property rights. Now, it should be clear that these definitions are provisional working definitions, and their borders are permeable. But they capture rather well, for example, the distinction between fair use, a limitation on all information product owners' ability to exclude users from their products, and misuse of copyright, a limitation on some owners' ability, under certain circumstances, to do things with their products that they are generally entitled to do. Even though it is formally a defense to a copyright claim, the former is a part of the definition of property in information and not part of the definition of the owner's exclusive rights. The latter, misuse, is a regulation of using already-defined property rights in certain market situations.

In interrogating the two database protection bills, we should seek to identify whether what each one does is market-creating or market-regulating in the sense just described. One inquiry would require us to identify the relationship addressed by the law: is it a relationship between sellers and buyers, producers and consumers, defining what is up for grabs between them, or is it some other relationship in the market, in particular, the relationship among competitors. Another inquiry concerns what actions are made possible or impossible by the law. In particular, we would be interested in whether the actions prohibited include the uses intended by the owner to be the source of the information's value to users. By prohibiting such actions, the law defines the "goods" that form the basis of a business in selling the information—or, more accurately, permission to make valuable use of the information. In the alternative, we might see that the prohibited actions are not those that make the information valuable to users, but rather those that permit competitors of the producer to provide *the same* value to users as the owner plans to sell.

### **C. A Functional Comparison of House Bill 354 and House Bill 1858**

#### *1. Whom Does the Law Address?*

House Bill 354 is addressed to anyone who distributes information extracted from a database,<sup>149</sup> and to anyone who uses information in a data-

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149. See H.R. 354, 106th Cong. § 1402(a) (1999) ("Any person who makes available to others, or extracts to make available to others.").

base.<sup>150</sup> House Bill 1858 has two parts, the first plainly addressed to competitors,<sup>151</sup> the second to anyone who distributes real-time market information.<sup>152</sup> As an initial matter, then, House Bill 1858 does not speak to anyone who uses information (including real-time market information) for its value as information, as opposed to its value as goods in trade. House Bill 354, on the other hand, does address anyone who uses the information in its marketable use, and could therefore, at least in principle, speak to a user for whom the value of use is precisely its value as data, not as goods in trade. It speaks to consumers of data, as well as to competitors in the market for serving consumers in data.

To illustrate the difference between the two, let us look at a simple example. Imagine that John purchases a CD-ROM with a list of daily temperatures, barometric pressure, and other such data, in 200 cities and towns throughout the United States between 1900 and 1999. He lends it to Jane. Jane copies the entire factual contents—but not the organization—of the CD-ROM onto her hard drive, where she now accesses the raw information using her own access software, having returned the CD-ROM to John. Clearly what Jane did would violate copyright, if the contents of the CD-ROM had been copyrightable, and no other factors were present. Equally clear, her actions are privileged from copyright law under *Feist*, because that decision was not based on a notion of fair use or *de minimis* use, but on the uncopyrightability of facts, which are in the public domain, free for the taking.

House Bill 1858 does not speak to Jane. She is not disseminating the information in commerce. House Bill 354 does speak to her. She has extracted the entire collection of information. Now we must determine whether her extraction harms the producer's primary market, and if so, whether or not she is privileged under one of the exceptions included in the Act. But we do not need to make that assessment to complete identifying the first central difference between the two bills. House Bill 354 is addressed to users of the information who use it for its value to them as information, as well as to competitors and others who distribute the information extracted from protected databases. House Bill 1858 is addressed only to competitors of the information provider, or with respect to real-time

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150. See *id.* § 1402(b) ("Any person who extracts all or a substantial part of a collection of information.").

151. The Bill establishes that is unlawful to sell or distribute in interstate commerce a duplicate of a database that "is sold or distributed in commerce in competition with that other database." H.R. 1858, 106th Cong. § 102 (1999).

152. See *id.* § 201 (addressing anyone who obtains real-time market information and directly or indirectly disseminates it without authorization).

market information, to those who redistribute that information on a real-time basis.

## 2. *What is Prohibited to the Law's Addressees?*

House Bill 1858 prohibits distribution or sale of a duplicate of a database.<sup>153</sup> A duplicate must be both "substantially the same" as the original, and must have been created by extraction of the information from the original.<sup>154</sup> The Committee Report explaining the definition of duplicate suggests that a database is not "substantially the same" unless the non-identical portion of the duplicate is immaterial to the overall value of the database.<sup>155</sup>

House Bill 354 prohibits both extracting to make available and making available information from a database in a manner that causes material harm to the primary or a related market of the producer of the source database,<sup>156</sup> and prohibits extracting information in a manner that causes harm to the producer's primary market.<sup>157</sup> The Committee Report on Section 1402 suggests that "material harm" is intended to exclude de minimis uses, but not to introduce a more robust limitation,<sup>158</sup> expressly rejecting the requirement imposed in *National Basketball Ass'n v. Motorola, Inc.* that the plaintiff must show that use of the facts in the manner the defendant uses it would threaten its existence.<sup>159</sup>

One implication of this difference reinforces the point made in the preceding section. The Committee Report on House Bill 354, in explaining the meaning of "material harm," includes the following statement: "[I]f a person extracts so much of an online database that the person would, in the future, be able to avoid paying a subscription fee for access to the data it contains, that person has harmed the market for the database."<sup>160</sup> Again, House Bill 1858 would not speak to such a person, whose extraction is for personal use and not for competition.

Moreover, this paragraph in the report illustrates that part of the function of House Bill 354 is to create the legal basis upon which the provider

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153. *See id.* § 102.

154. *Id.* § 101(2).

155. H.R. REP. NO. 106-350, pt. 1, at 16-17 (1999).

156. *See* H.R. 354 § 1402(a).

157. *See id.* § 1402(b).

158. *See* H.R. REP. NO. 106-349, pt. 1, at 18 (1999).

159. *See* *National Basketball Ass'n v. Motorola, Inc.*, 105 F.3d 841, 845 (2nd Cir. 1997) (limiting hot-news claims to cases where, *inter alia*, "the ability of other parties to free-ride on the efforts of the plaintiff or others would so reduce the incentive to produce the product or service that its existence or quality would be substantially threatened").

160. H.R. REP. NO. 106-349, pt. 1, at 18 (1999).

of a database can claim an entitlement to payment. In the absence of House Bill 354 the producer can physically block access to the information, and charge for access as a contractual matter. But the producer has no legal right to use the machinery of the state to prevent a user who has gained access to the information from using it, and hence has no legal claim to payment in the absence of a contract. As the quote from the Committee Report in the preceding paragraph makes clear, House Bill 354 creates this right, which is the essence of a property right—the right to exclude another from using one’s property, irrespective of whether one has, or has not, maintained physical control to implement that exclusion.

Another conceptual difference between the two bills, that goes to the “propertyness” of House Bill 354, is how differently they “track” the rights of a producer in something like the “*res*” of the collection. Imagine that Jane, in our example above, uses the information about the weather in 200 U.S. cities as part of a compilation of similar data for 5000 cities around the world that she is producing. Under House Bill 1858, the value of the 4800 cities that she added in her database (perhaps by similar extraction from other small databases) would not be “immaterial to the overall value” of her database. Accepting the interpretation that the committee placed on what makes one database “substantially the same” as the original of which it is purported to be a duplicate, her new database would not be “a duplicate,” and would therefore not violate the prohibition imposed by House Bill 1858. The report on House Bill 354, on the other hand, expressly contemplates such use of the entire contents of a database, and explicitly treats it as a prohibited act. The example used in the report is of a person who compiles a collection of public domain photographs of famous people around the United States by including, among other things, a collection of public domain photographs of such people from Massachusetts.<sup>161</sup> As the Committee Report puts it, “[t]he Act seeks to prevent market harm to the investment in collections of information, and defendants should not be able to escape liability through activity analogous to the use of a stapler.”<sup>162</sup> Once the investment in collecting is made, its value to others, including others who use it as input into their own value-added production, is captured by the law for the benefit of the collector. The collection ceases to be a set of facts, and becomes a *res* that can be tracked back to its original owner through successive compilations. Again, what we see is that the collection of facts becomes an excludable good because

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161. *See id.* at 17-18.

162. *Id.* at 18.

of this proposed law, one that can be sold—or not—to future producers who value it, whether or not they compete with the original collector.

Beyond this conceptual level, it is important to understand that House Bill 1858 and House Bill 354 regulate two *different kinds* of competitive harm—one that has traditionally been the subject of unfair competition, the other of intellectual property. Take the example given in the Report on House Bill 1858.<sup>163</sup> One database producer (“A”) collects information about bank loans from in-state individual bank databases, and creates a statewide database more efficient than those each bank produces. A second database producer (“B”) takes A’s collection, combines it with out-of-state individual bank information, and provides a more comprehensive database still. According to the Committee Report on House Bill 1858, the bill privileges the use that A made of the individual bank databases, and that B made of A’s database. In each case, the second database producer in each pair (bank, A), (A, B) added significant information value to the information copied from the first database in each pair. This additional information is material to the value of the second database in each case, the second database is therefore not a “duplicate,” and the use of the existing information collection is privileged. Under House Bill 354 both A’s and B’s actions would be prohibited. House Bill 1858 would, however, cover the behavior of each of A—vis-à-vis the banks—or B—vis-à-vis A, if the second database in each case had done nothing more than copied all of the prior database, and then sold that duplicate without adding much of value.

House Bill 1858 thus provides protection against a competitor who competes by offering *the same* product, and who can sustain a lower price for that product solely by relying on its competitor’s investments in collecting the information. House Bill 354 protects against this competitor, but in addition protects against a competitor who competes by offering a *better* and more comprehensive product that is fully or partially substitutable with the original product, which does not even necessarily undercut the original database producer in price, but *is* cheaper than it would have been had the competitor been prohibited from using existing information collections as raw materials for its better product. Such protection encumbers the subsequent producer with a production price that is higher than the social cost of its production at the time it is undertaken, and hence diminishes the production of these later, better products, to below their socially optimal level at that later time. This intergenerational tradeoff is the standard effect of intellectual property rules, but not of unfair competition law.

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163. See H.R. REP. NO. 106-350, pt. 1, at 8 (1999).

In effect, House Bill 354 functions economically like an intellectual property rule. If it is truly about unfair competition through price undercutting made possible by free-riding on the investment of another, it need not cover as many uses of information contained in databases as it does. Protection of the type provided in House Bill 1858 does that job. If it is about requiring the makers of advanced products to pay a fee to the makers of precursors and of information inputs they use in their products, then it is not about unfair competition—it is about dividing the welfare produced by investment in the collection, organization, and dissemination of information, such that subsequent producers pay predecessors who made their new production possible. It is about trading static efficiency of information production for dynamic efficiency. It is about intellectual property.

### 3. *Exceptions, Limitations, and Enforcement*

House Bill 1858 has fewer exemptions and limitations, because the scope of its initial reach is much narrower. House Bill 354 has many more limitations and exceptions. The most important for our purposes is the list of permitted acts under Section 1403—some of which create context-specific exceptions to liability, and others of which in fact limit the extent of the property right created by the bill. The most important limitations on property in facts are that extraction or dissemination of an individual fact contained in a database is permitted, and that collected facts remain in the public domain in the sense that competitors are free to collect them independently. The property right created in the investment in compilation, however, is maintained by prohibiting repeated extraction of individual facts—thus limiting this exemption, as with the definition of “primary market,” to de minimis instances of extraction—and by prohibiting collection of the facts by accessing the collection.

The remaining permitted uses provide exceptions for certain specified uses. These, however, do not change the nature of the right created, but only define its contours. There is a general reasonable use exemption, which requires context-specific weighing of factors, somewhat like the fair use defense in copyright. What is important to note about this exemption is that it does not affect its nature as a property-like right. Just as the scope of “fair use” defines *the scope* of the copyrights authors have in their writings, but does not change the nature of copyright from an intellectual property right into an unfair competition rule, so too the availability of a reasonable use exemption does not change the nature of the database protection right created in House Bill 354 from an intellectual property-like

right into an unfair competition law, but merely defines the scope of the property right.

It is not that a list of permitted uses could not, as a conceptual matter, have, if Congress so chose, fundamentally altered the nature of the right. If the permitted acts had in fact negated the basic reach and effect of the prohibitions stated in Section 1402, they would have, effectively, negated our initial conclusion that House Bill 354 creates a property right. But that is not what they do. A comparison between the exemption for nonprofit educational and research uses and the exemption for genealogical information collected or used for religious purposes is instructive.

Section 1403(c) exempts nonprofit educational and research uses that do not harm the primary market of the information provider. This is an exemption intended to permit education and research uses of investments made in collecting information for various other markets without payment, and is a real limitation on a general property right. Nonetheless, it retains the structure of a property right in the information collected to form the basis for a provider that treats nonprofit educational and research users as a primary market. "Primary market" is defined in the bill to include any market in which the provider offers a service or product incorporating the database, and from which the provider reasonably expects to receive revenue.<sup>164</sup> If the collection of information is offered for sale to educators or researchers, even only as a sideline business, then the exemption does not apply, and the provider can charge for the use. The users have no exemption from the prohibition on using the information. This exemption retains, therefore, the market-creating role of House Bill 354, as to the market in information useful in education and research. For example, a company would be protected from this exemption if it invested in collecting information from public records about family histories and offered them in a CD-ROM for use in classrooms in the study of personal family history, or to researchers of migration patterns. The exemption would not apply even if the business rationale that justified the compiler's investment in compiling the data were based purely on the value of the compilation for family entertainment, so that the existence or non-existence of the nonprofit educational or research market were irrelevant to the investment decision.

The same company that collects family history information cannot, however, decide that there is a market for its efforts among members of

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164. See H.R. 354, 106th Cong. § 1401(3) (1999). This definition of primary market is complemented by a "related market," in which the provider does not yet offer the data, but in which others who offer similar databases do sell, or which the provider demonstrably is preparing to enter. See *id.* § 1401(4).

the Mormon Church, who might be willing to pay a good deal to find information about their families because this information would help them to perform church ordinances for their deceased ancestors.<sup>165</sup> These religious users of genealogical information are entirely exempt from the Act's coverage, irrespective of the effect on the producer's intended primary market.<sup>166</sup> This is a form of exemption that excludes a property right in certain kinds of information—genealogical information useful for religious observance. It makes religiously useful genealogical information nonexcludable, and hence not the object of market transactions. Were the “permitted acts” enumerated in section 1403 generally of this structure, the property right would, indeed, be negated in many cases.

Another important practical difference between House Bill 1858 and House Bill 354 is in the enforcement mechanism. The general prohibition on duplication in competition under House Bill 1858 is enforceable by the Federal Trade Commission (“FTC”).<sup>167</sup> There is no private right of action (although there is such a right for the bill's second part, dealing with misappropriation of real-time market data). House Bill 354 does provide a private right of action.<sup>168</sup> This practical difference is important as a prudential matter. On the one hand, this limitation might render the protection ineffective by subjecting enforcement to the budget and personnel constraints of the FTC. On the other hand, it provides an important backstop against overreaching assertions of rights, if that is what one is concerned with in the database context.

These practical effects may be important, but they do not affect the constitutionality of the database laws under the Intellectual Property Clause. That trademark rights can be asserted by private owners does not make them any more, or any less, distinct from intellectual property rights of the variety that must be passed, if at all, under the Intellectual Property Clause. Similarly, that the securities laws permit private rights of action to enforce their disclosure requirements does not convert the regulatory reporting requirements into property rights of shareholders. They remain nonwaivable background rules intended to assure the efficiency of the market, not rules that define the contours of securities as objects in trade. Nor do private rights of action under the antitrust laws make these laws

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165. For a description of the role descendants have in performing ordinances for their ancestors who were not fortunate enough to hear the gospel themselves, see *Gospel Principles, Temple Work and Family History* ([http://www.lds.org/library/gos\\_pri/U08\\_C40-Temple\\_Work.html](http://www.lds.org/library/gos_pri/U08_C40-Temple_Work.html)) (visited April 26, 2000).

166. See H.R. 354 § 1403(h).

167. See H.R. 1858, 106th Cong. § 107 (1999).

168. See H.R. 354 § 1406.

into property rights for consumers. That a database owner can trigger enforcement by bringing a private suit similarly should not be the touchstone of whether the right the database protection law provides is an exclusive right of the type that must be passed under the Intellectual Property Clause.

#### D. Conclusion

The thesis and function of House Bill 354 are identical to those of the Copyright Act or the Patent Act. The thesis of these intellectual property laws is that producers of valuable information goods require legal protection to enable them to appropriate the benefits of their productive investments. To give producers this incentive, users who find the information valuable are prohibited from making use of the information, and producers are given the power to remove that prohibition. The users, in turn, pay the producers for lifting the prohibition, thereby creating a market in the information products of the producers and creating the incentive for production.

House Bill 354 operates on exactly the same assumptions, progressing in exactly the same fashion to enact a market-creating property right in collections of information. Its prohibitions are intended to apply to all users, both consumers and producers—whether these producers compete with the owner or not—and they are intended to permit providers to charge for all but *de minimis* uses. Notwithstanding the claims in the Committee Report that the bill would enact a competition rule, comparison with House Bill 1858 suggests that this is not the case. House Bill 354 addresses users, as well as competitors. It prohibits simple use of the information for its core utility, in addition to competitive use of the information as goods in trade. It tracks the collection downstream, and attaches a right to the use of the information even where it is used transformatively, for the value its information contents provide in avoiding the cost of re-gathering the information. In this too it is like a property right, attaching to composite products that incorporate the thing in which the property right is asserted.

House Bill 1858, on the other hand, addresses only competitors, not users. It prohibits only competition that free rides on the investment of a competitor to a degree that threatens the viability of the original database producer, but does not prohibit transformative use that builds on the investments of predecessors to make new information available to society. The bill is different from copyright or patent rights, and more similar to at least the confusion arm of trademark protection, which addresses competi-

tors, not consumers, and prevents only competitors' actions that interject the competitor between the plaintiff and its intended customers.

As Part II explained, the Intellectual Property Clause requires that intellectual property-like rights in information be enacted, if at all, only within the confines of that clause. In *Feist*, the Supreme Court stated that that clause did not permit recognition of property rights in the information contents of a collection. In regulating information markets under the general commerce power, Congress may only enact regulations that are different in kind from intellectual property rights, like trademark protection. House Bill 354 is functionally an intellectual property right in the information contents of databases, cannot be passed under the Commerce Clause, and is unconstitutional under the Supreme Court's interpretation of the Intellectual Property Clause throughout this century, and more specifically in *Feist*. House Bill 1858, on the other hand, is a law that regulates one particularly ruinous form of competition, and can therefore properly be passed under the Commerce Clause.

## V. CONSTITUTIONALITY OF THE DATABASE PROTECTION BILLS UNDER THE FIRST AMENDMENT

### A. Parameters of Analysis

Recognizing exclusive private rights in valuable uses of information requires that government abridge the freedom of some people—putative users—to use information, at least sometimes.<sup>169</sup> It is the prohibition on certain uses of information that forms the basis for the market in permissions to use the information. I have elsewhere explained in detail my view that laws creating private rights in information should always be subject to the same level of review as is structural media regulation.<sup>170</sup> In order to implement structural media regulation—say, require cable operators to carry broadcast signals—government tells one person that it cannot (or must) communicate in ways that it does (or does not) wish to. Government has no suppressive purpose and may be seeking to improve the quality of communications in society. Nonetheless, the structure of the regulation is to force one person—the regulated party—not to communicate in a manner that that person could communicate, absent existence of the law. Similarly, intellectual property rules tell the user that he or she may not communicate in certain ways—read, copy and distribute—that that regulated person could have communicated but for the regulation. The government's

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169. See Benkler, *supra* note 2, at 390-94.

170. See *id.* at 364-86, 390-94, 408-12.

intent is not to suppress speech, but rather to enhance information production. But the means it has chosen require it to prevent someone from speaking in a way that she wants to and can. This requires heightened scrutiny to see that the government is serving an important interest using means that are no more restrictive than necessary.<sup>171</sup>

Moreover, irrespective of how broadly one reads the Supreme Court's decision in *Harper & Row*, it is clear that the Court treated the basic requirements that it elsewhere rooted in the Intellectual Property Clause—namely, originality, exclusion of facts from coverage, etc.<sup>172</sup>—as the reason that intellectual property rights dwell in peace with the First Amendment. This reliance suggests that courts should review with particular care legislation that creates exclusive rights in information without adhering to these principles, under a different congressional power that does not require such adherence.

Both database protection bills require certain people—competitors and users in the case of House Bill 354, and competitors and redistributors of real-time market information in the case of House Bill 1858—not to communicate certain information that they wish to and can communicate. The first part of House Bill 1858, and most of House Bill 354, is, like copyright, content-neutral, in that their purpose is detached from the content of the regulated communication.<sup>173</sup> (The second part of House Bill 1858,<sup>174</sup> and at least the exception for genealogical information in House Bill 354, is content-based and must be subject to the strictest First Amendment scrutiny.<sup>175</sup>)

In order to pass muster under the intermediate level of review, the government must establish that the challenged law “furthers an important or substantial governmental interest,” that the interest “is unrelated to the suppression of free expression,” and that “the incidental restriction on al-

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171. See *Turner Broad. Sys. Inc. v. FCC*, 512 U.S. 622, 662 (1994).

172. See *supra* Part II.A.

173. See *supra*, note 85 (discussing content-neutral vs. content-based nature of these laws).

174. That part, section 201, applies to “real-time market information,” which is clearly a content-based definition in that person A is entitled to communicate information in real-time about art exhibits, but not about stock prices, and the purpose of the prohibition is to protect this specific kind of information.

175. While the exception provides preferential treatment for, rather than burdens, religious use of genealogical information, one might easily imagine members of another religion that requires a different kind of information challenging the preference for genealogy, or a non-religious organization in need of access to different kinds of information challenging the content-based discrimination against their use of the information they needed.

leged First Amendment freedoms is no greater than is essential to the furtherance of that interest.”<sup>176</sup> Stipulating that database protection law is not intended to suppress speech, this standard requires us to consider two questions: first, whether either or both bills further an important governmental interest, and second, if so, whether the manner in which they do so is significantly more speech-restrictive than necessary to serve the interest. The first part of the inquiry requires that we identify what the interest is, that we assess whether it is in fact “substantial,” and that we evaluate whether the law furthers it. The latter part of the test suggests that we consider alternative avenues and their relative efficacy in attaining the goals identified in the first step, including in this case, comparing the two bills to each other in terms of relative efficacy and cost in free speech terms.

### **B. Identifying and Evaluating the Goals of Database Protection**

Both Committee Reports include extensive statements of purpose, which of necessity must be our starting point in evaluating the government interest underlying Congress’s action.

The House Bill 354 Report begins with the statement that the bill

responds to a need to supplement copyright law to prevent the wholesale copying of another’s collection of information in a manner which [sic] harms the market for that collection. The bill ensures incentives for investment in the production and dissemination of collections of information, while maintaining continued access to information contained in such collections for public interest purposes such as education, science and research.<sup>177</sup>

The Report goes on to explain that electronic collections are “indispensable to the United States in the new information economy.”<sup>178</sup> It states that “[d]eveloping, compiling, distributing, and maintaining commercially significant collections requires substantial investments of time, personnel, and effort and money.”<sup>179</sup>

The Committee Report describes its understanding of the legal backdrop of collections of information. The description states as fact a quite controversial set of claims about the historical availability of protection for databases,<sup>180</sup> whose upshot is that copyright law provides either no, or too

176. *United States v. O’Brien*, 391 U.S. 367, 377 (1968).

177. H.R. REP. NO. 106-349, pt. 1, at 9 (1999).

178. *Id.*

179. *Id.* at 10.

180. The description even digresses to grammatical sleight of hand when, for example, it states that “[h]istorically, protection of collections of information has always been recognized as a branch of copyright law.” This is a true statement that omits that, for

thin a protection for database producers. This description outlines the gap that the Committee Report sees in the law. This gap, the object sought to be corrected by the bill, is the absence of protection—since *Feist*—against a competitor “lifting massive amounts of factual material from a copyrighted database to use as the basis for its own competing product.”<sup>181</sup> The committee then goes on to describe the passage in Europe of the European Directive on Legal Protection of Databases,<sup>182</sup> and suggests that failure by the United States to pass commensurate protection “could place U.S. firms at an enormous competitive disadvantage throughout the entire European market.”<sup>183</sup> It adds that there are debates in the World Intellectual Property Organization as to whether a sui generis property right in databases should be developed, and offers its solution as a competing, copyright-related alternative to such a property right.<sup>184</sup>

Finally, the committee describes digital technology as a potential threat to database producers’ incentives, because it makes “[c]opying factual material from another’s collection, and rearranging it to form a competing information product . . . cheaper and easier than ever. . . . Furthermore, piracy and personal theft of collections developed through the resources of another is easy to achieve and *will be* rampant without proper protections for producers.”<sup>185</sup> Note that this is the first, and only, time in the report or the bill text that “personal theft” or personal use is mentioned

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most of this period, in most courts, such protection was denied under the only law thought relevant; or, in order to describe the state of the law as one with which the present bill would be continuous, rather than the radical departure (whether justified or not) that it is, it claims that “[d]atabases or compilations have been protected by copyright in some form since 1790, when the first U.S. Copyright Act was amended” —also true, but only because of the “or,” and because “compilations” means compilations of copyrightable works, as well as compilations of facts. See H.R. REP. NO. 106-349, pt. 1, at 10 (1999). Similarly, in describing *Feist*, the report states that

the Supreme Court affirmed that originality and creativity in addition to investment and effort are required for protection under the Copyright Act, and that a related form of protection would have to be created in order to completely protect compilations or portions of compilations in which there is effort and investment but not a threshold level of originality or creativity.

*Id.* In fact, while *Feist* most certainly affirmed the necessity of creativity and originality, it did quite the opposite of “affirming” that a related form of protection would have to be used to protect unoriginal, noncreative facts. What the Court in *Feist* actually did was to state specifically that Congress lacked the power to enact such related protection.

181. H.R. REP. NO. 106-349, pt. 1, at 10 (1999).

182. See Council Directive 96/9/EC, *supra* note 144.

183. H.R. REP. NO. 106-349, pt. 1, at 11 (1999).

184. See *id.*

185. *Id.* (emphasis added).

as a reason for the law. Needless to say, stating that a law is needed because "theft" will be rampant unless we pass the very law that converts what is now privileged use into "theft" is circular. Note further that this non sequitur is the only place where a need for a law that would exclude *users*, rather than competitors, from extracting information from databases, is mentioned or explained in the report or the bill.

In conclusion the report states that these factors necessitate passage of the bill

to protect developers against piracy and unfair competition, and thus encourage continued investment in the production and distribution of valuable commercial collections of information. Such legislation will improve the market climate for collections of information in the U.S.; ensure protection for U.S. collections abroad on an equitable basis; place the U.S. on the leading edge of an emerging international consensus; and provide a balanced and measured response to the new challenges of digital technology.<sup>186</sup>

In order to pass constitutional muster, a law must advance an important government purpose that addresses a "real harm" in a manner that will "alleviate it in a material way."<sup>187</sup> Conspicuously absent from the report is any evidence that there is any "real harm" to address—that the database industry needs any new protection, other than that which it can muster under copyright law, contract law, existing unfair competition law, and technological protection measures.<sup>188</sup> The report says that digital technology changes conditions such that in the absence of a new law "piracy and personal theft . . . will be rampant," but offers no evidence to support that in the more than decade-long experience of electronic databases the database industry has languished in the absence of protection.<sup>189</sup> It says that failure to pass the law "could" place United States firms at a competitive disadvantage in Europe, but identifies no evidence that European competitors

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186. *Id.*

187. *Turner Broad. Sys., Inc. v. FCC*, 520 U.S. 180, 195 (1997); *Turner Broad. Sys., Inc. v. FCC*, 512 U.S. 622, 663-64 (1994).

188. There is serious academic debate over whether these sources offer sufficient protection. *See, e.g.*, J. H. Reichman & Pamela Samuelson, *Intellectual Property Rights in Data?*, 50 *VAND. L. REV.* 51, 55-57 (1997); *see also* Jane C. Ginsburg, *Copyright, Common Law, and Sui Generis Protection of Databases in the United States and Abroad*, 66 *U. CIN. L. REV.* 151, 169 (1997).

189. *See* H.R. REP. NO. 106-349, pt. 1, at 11 (1999).

were pirating the contents of American databases.<sup>190</sup> Indeed, the rallying cry “protect our database producers from the Europeans” rings hollow when testimony suggested that of the three major industry stakeholders only one, McGraw Hill, is an American company, while another, Reed-Elsevier, is a European company.<sup>191</sup> (The third was Thompson, a Canadian company.<sup>192</sup>)

Most importantly, there is no evidence cited or testimony to support the notion that *Feist* slowed down or in any way affected the database industry. Given the strong claim that *Feist* changed the legal background on which the database industry operated,<sup>193</sup> it should have been relatively simple to conduct an empirical study to look at trends in the industry before and after *Feist*. One would expect such a study to show at least retardation in the rate of growth, if not a more pronounced negative effect on the commercial side of the database industry. Indeed, such a study was conducted, and introduced in Congress, as we shall see in looking at the Committee Report for House Bill 1858.<sup>194</sup> It suggested that the commercial private database industry was alive, healthy, and unaffected by the absence of protection of the type introduced in House Bill 354, and rendered unconstitutional in *Feist*.<sup>195</sup>

The absence of evidence of a real problem is particularly troubling given the extensive criticisms of the predecessor bills, introduced in the 105th Congress, precisely on the basis of the absence of evidence of a problem.<sup>196</sup> There was significant academic literature, most comprehen-

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190. Indeed, in the hearings held in preparation of the predecessor bill 105 H.R. 2652, an industry representative specifically stated that no instances of such piracy had yet occurred. See CIAA Hearings, *supra* note 142 (statement of Robert E. Aber, on behalf of the Information Industry Association).

191. *Collections of Information Antipiracy Act: Hearing on H.R. 354 Before the Subcomm. on Courts and Intellectual Property of the House Comm. on the Judiciary*, 106th Cong., available at <http://www.house.gov/judiciary/106-dunc.htm> (testimony of Daniel C. Duncan, Vice President, Government Affairs, Software & Information Industry Association).

192. See *id.*

193. See *Collections of Information Antipiracy Act: Hearing on H.R. 354 Before the Subcomm. on Courts and Intellectual Property of the House Comm. on the Judiciary*, 106th Cong., available at <http://www.house.gov/judiciary/106-pete.htm> (statement of Marybeth Peters, Register of Copyrights).

194. See H.R. REP. NO. 106-350, pt. 1, at 9 (1999).

195. See *id.* For my discussion of *Feist*, see *infra* text accompanying notes 26-32.

196. See CIAA Hearings, *supra* note 142 (statement of Jonathan Band on behalf of the Online Banking Association); Letter from Pamela Samuelson in response to Tyson/Sherry Report and H.R. 2652, Oct. 23, 1997, available at <http://www.arl.org/info/frn/copy/psamlet.html>.

sively a 1997 analysis performed by professors Reichman and Samuelson,<sup>197</sup> explaining why database providers did not in fact need a new right, given the available alternatives for collecting positive returns on their investments without such a right.<sup>198</sup> Supporters of such a right had ample time to rebut these arguments, but they did not. Indeed, in the testimony of Marilyn Winokur, on behalf of the Coalition Against Database Piracy, all that the witness could do to rebut this criticism was state that “a finding that an industry has done well in the past without legislative protection does not mean that threats to present and future investments fall outside Congressional concern,”<sup>199</sup> and that “Congress has no obligation to wait until the harmful ripples created by the gaps in current law become a tidal wave.”<sup>200</sup> The lack of data supported only by the weak claim that Congress needs no evidence before it acts strongly suggests that the bill is unnecessary. This is especially true given the serious First Amendment concerns about this law raised by the Administration<sup>201</sup> and by academic critics<sup>202</sup> and the resources at the disposal of the supporters of the bill.

The goals of House Bill 1858 are much narrower, though they too are unsupported by evidence of real need, as opposed to real lobbying pressure. The report states as its baseline assumptions the central importance of information flows to efficient markets, and the long standing, “basic information policy of this country . . . that facts cannot be ‘owned.’”<sup>203</sup> It expressly states a fundamental commitment to permitting acts that would be rendered illegal by House Bill 354—for example, permitting “a database publisher [to] visit the site of every bank in a State, extract data concerning each bank’s loan programs, and construct a larger database with

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197. See J. H. Reichman & Pamela Samuelson, *Intellectual Property Rights in Data?*, 50 VAND. L. REV. 51 (1997).

198. See *id.* House Bill 354 itself was criticized on these grounds in Stephen M. Maurer & Suzanne Scotchmer, *Database Protection: Is It Broken and Should We Fix It?*, 284 SCIENCE 1129 (1999).

199. See *Collections of Information Antipiracy Act: Hearing on H.R. 354 Before the Subcomm. on Courts and Intellectual Property of the House Comm. on the Judiciary*, 106th Cong., text accompanying notes 29-30, available at (<http://www.house.gov/judiciary/106-wino.htm>) (summary of statement of Ms. Marilyn Winokur, Executive Vice President of Micromedex, on Behalf of the Coalition Against Database Piracy).

200. See *id.*

201. See Memorandum from William Michael Treanor, Deputy Assistant Attorney, Office of Legal Counsel July 28, 1998, Constitutional Concerns Raised by the Collections of Information Antipiracy Act, H.R. 2652, available at (<http://www.acm.org/usacm/copyright/doj-hr2652-memo.html>).

202. See generally sources cited *supra* notes 1-2.

203. See H.R. REP. NO. 106-350, pt. 1, at 8 (1999).

loan information for all banks.”<sup>204</sup> It goes on to say that “[a]nother database publisher can then extract some of that information, and combine it with other information—for example, loan programs from out-of-State banks . . . to create a new, more useful database. . . . Allowing scientists to reuse facts, rather than requiring them to ‘reinvent the wheel,’ ensures that research moves forward.”<sup>205</sup>

The report notes that “[w]hile this Nation’s non-proprietary information policy serves consumers and industries well, *some database publishers are concerned* that the current scope of legal protection against unfair competition is insufficient,” noting in particular the concern with the state of the law after *Feist*.<sup>206</sup> The report responds to this concern by quoting a statistical study that suggested that the commercial database industry has prospered since *Feist*.<sup>207</sup> It suggests that between 1991 and 1997, the overall number of databases increased 35%, the number of files contained in these databases increased by 180%, and the number of online searches of databases increased 80%. Furthermore, the database industry has become more, rather than less, commercial, since the 1976 Act clarified the limited extent of protection available to database producers under the Copyright Act, and commercialization has continued apace since *Feist*, both effects measured by the relative prevalence of commercial, as compared to government, academic, and non-profit database producers.<sup>208</sup>

Despite its very clear rejection of the argument that commercial database producers were suffering under the present legal regime, the report suggests that it is intended to “plug a hole that exists in current law,” to give producers “sufficient protection against unfair competition” while avoiding placing “a tax on information” that is necessary for value added publishers, research scientists, or consumers by creating a property-like right.<sup>209</sup> The report is only slightly more enthusiastic about the second part of the bill, which pertains specifically to real-time market information. It suggests that access to real-time information is very important to online trading, and that the exchanges charge brokers fees to provide them with real time market information, fees that they use to fund their operations.<sup>210</sup>

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204. *Id.*

205. *Id.*

206. *Id.* at 9 (emphasis added).

207. *See id.* at 9 & n.1 (citing Dr. Martha E. Williams).

208. *See H.R. REP. NO. 106-350, pt. 1, at 9 (1999).*

209. *See id.* at 10.

210. *See Consumer and Investor Access to Information Act: Hearing on H.R. 1858 Before the Subcomm. on Finance and Hazardous Materials of the House Comm. on Commerce, 106th Cong., available at* <http://com-notes.house.gov/ccheahr/hearings106.nsf/a317d879d32c08c2852567d300539946/>

The fear stated in the Report is that consumers or brokers who get access to the information will retransmit the real-time information and undermine the market-information provider's business, and thereby undermine the efficient collection and dissemination of market information.<sup>211</sup> These fears, as in the case of House Bill 354, were without empirical basis. Indeed, testimony of a staff member of the Securities and Exchange Commission, who supported the bill, specifically stated that the Commission has not completed its analysis of the impact on markets of structural change and the importance of fees-for-information to the operation of markets.<sup>212</sup> Theoretically, the need for a right in real-time access to information that is generated as a by-product of the market's function, of which the market is a sole source, is questionable. Investments in collecting and organizing the information are necessary for the very functioning of the market, and the marginal cost of providing that information once collected is minimal. It is not entirely clear why these investments—most of which are fixed—cannot adequately be recouped in membership fees or transac-

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cd8698843ba70417852567990066c0c1?OpenDocument) (prepared statement of Mr. Richard P. Bernard Executive Vice President and General Counsel New York Stock Exchange, Inc.) (stating that real-time market data fees constituted 15% of the NYSE's revenues for 1998); *Consumer and Investor Access to Information Act: Hearing on H.R. 1858 Before the Subcomm. on Finance and Hazardous Materials of the House Comm. on Commerce, 106th Cong., available at* (<http://com-notes.house.gov/cchea/hearings106.nsf/a317d879d32c08c2852567d300539946/fba0ad30a18737938525679900667a26?OpenDocument>) (prepared statement of Mr. S. Dean Furbush, Senior Vice President and Chief Economist, National Association of Securities Dealers, Inc.).

211. See H.R. REP. NO. 106-350, pt. 1, at 10-11 (1999).

212. The Securities and Exchange staff member testified as follows:

To address these developing issues, the Commission has undertaken a review of the structures for obtaining market data and the role of data revenues in the operation of the markets. As part of this review, the Commission intends to issue a release describing existing market data fees and revenues, as well as their relationship to the funding of the self-regulatory organizations. While we have gathered a significant amount of data on these subjects, we are just in the preliminary stages of our analyses. Unfortunately, without the benefit of completing this review, we are unable to make judgments on specific issues regarding data collection and distribution costs or on any suggested structural improvements.

*Consumer and Investor Access to Information Act: Hearing on H.R. 1858 Before the Subcomm. on Finance and Hazardous Materials of the House Comm. on Commerce, 106th Cong., available at* (<http://com-notes.house.gov/cchea/hearings106.nsf/a317d879d32c08c2852567d300539946/f674ae3a3398544b852567990052238c?OpenDocument>) (prepared statement of Ms. Annette L. Nazareth, Director, Division of Market Regulation, Securities and Exchange Commission).

tional fees, rather than as incremental charges on access to the information. Nonetheless, because the right given is of extremely short duration, fifteen minutes at the most, perhaps less as the speed of markets' response to information increases, it seems that the Committee was content to accept the need for at least this limited right.

### C. Evaluating the Fit Between the Means Employed by the Bills and their Purpose

As noted earlier, it is not sufficient that a law subject to intermediate scrutiny serves an important purpose: the law must do so without restraining speech much more than necessary. We can assume, for purposes of this part of the inquiry, the counterfactual that there was in fact evidence supporting the claim that database producers are threatened by competitors who use the information contained in their databases as a basis for competing products.<sup>213</sup> The question is whether one or both of the proposed bills protect database providers from this threat. If both do so, one must ask whether the more restrictive of the two, House Bill 354, is not rendered unconstitutional by the very availability of a plainly less restrictive means—namely, House Bill 1858.

First, the general prohibition in House Bill 354, section 1402(b), on "extraction" that causes material market harm, where "material" means "not de minimis,"<sup>214</sup> is certainly one way of making it illegal for competitors to extract information. But it sweeps too broadly. If it is unfair *competition* that House Bill 354 aims at, then the general prohibition on extraction is unconstitutionally broad, for it would prohibit too many users who are not competitors from reading and communicating facts that they wish to, and can, read and communicate. If the bill in fact aims to prohibit use by users who are not competitors, then the law is not an unfair competition law, but a property right, which cannot be passed outside the Intellectual Property Clause, and is not supported by the committee's own stated purposes.

Second, even section 1402(a) of House Bill 354, which does not limit extraction *per se* but only "extraction to make available to others," is too broad if it is aimed at unfair competition, not at clarifying property rights in information goods, which is the province of the Intellectual Property Clause. As explained in the preceding section,<sup>215</sup> while section 102 in House Bill 1858 regulates competitive free-riding, section 1402(a) of House Bill 354 regulates, in addition to that competitive relationship, the

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213. The absence of such evidence is described *supra* Part V.A.

214. See discussion *supra* Part IV.C.2.

215. See discussion *supra* Part IV.C.

division of welfare between present and future information producers. It reaches not only competition among producers of the same product, some of which undercut the others unfairly, but also among producers of different products to the extent that one product is an improvement of, or uses as an input some of, the other product. If in fact the important governmental interest is to prevent undercutting of database producers by competitors who provide the same product without paying the cost of its development, then this section too is unnecessarily broad. It captures and prohibits many forms of valuable communication that “compete” with the original database only in the very limited sense that a public reading of the names of the past year’s AIDS victims at a memorial competes with a database collecting public health records from which the list is extracted, or that a list of news tidbits from the passing week in the *New York Times* Week in Review section competes with the Associated Press newswire.

Third, the exceptions indicate a range of uses that would not fit the “permitted acts” definition, and thus would be prohibited by House Bill 354, and which suggest that House Bill 354 is not narrowly tailored. Section 1403(b) makes amply clear that nonprofit educational, scientific, and research users are prohibited from using information collected by a producer who considers nonprofit educational, scientific, and research users to be its primary market. Recall that “primary market” is not defined in House Bill 354 as the commercial *raison d’etre* of a database. It includes all markets in which a database is offered and from which the database producer reasonably expects to derive revenue, directly or indirectly. So, imagine a database producer that hits on the business idea to collect and tally information about the voting patterns of legislators throughout the United States, hoping to sell the information to lobbyists. It turns out that this database is a bonanza for political scientists. The producer realizes this, say, after one scientist uses the database, and begins to offer access to this information to political scientists, and “reasonably expects” to charge for such access. The exception in section 1403(b) seems not to apply to any political scientist who thereafter copies the database, runs analyses on the information it incorporates, and publishes the results in a scholarly analysis of the responsiveness of legislatures to, say, petition drives. The researcher’s extraction of the information, without payment, seems to fall outside the carve-out for nonprofit research. It is true that the researcher may qualify for the ad hoc balancing exception of section 1403(a), although that possibility is attenuated by the unavailability of the more specific defense. The point, however, is merely to illustrate the kind of valuable speech that would at least be threatened, sometimes prevented, and certainly burdened by House Bill 354. Burdening such speech would have

nothing to do with providing sufficient incentives for production of the database in the first place, let alone with unfair competition, and would not occur if House Bill 1858, rather than House Bill 354, is adopted.

Under House Bill 1858, the political scientist's initial act of extracting the information would not be captured by the prohibition to begin with. Moreover, under House Bill 1858's parallel exception, a nonprofit scientific, educational, or research user is privileged even to distribute or sell a duplicate, unless that distribution is "part of a consistent pattern engaged in for the purposes of competition" with the producer of the database.<sup>216</sup> So copying and distribution to students of data in a database that a teacher thinks would be useful in the classroom is privileged; only systematic duplication and distribution in competition with the producer would come under the act as envisioned in House Bill 1858.

House Bill 1858 is designed to capture a very narrow set of practices: duplication and sale in competition. The bill's definition of "duplicate" excludes copying into a second database if other materials in that second database are material to its value. This narrow definition alleviates many of the concerns raised in the preceding paragraphs about the broad reach of House Bill 354. The bill deals narrowly with the problem of undercutting competitors by relying on their investments. The primary question with respect to it, therefore, appears to be the absence of any serious justification of its purpose, other than the Committee Reports' intimation that the database producers lobbied hard,<sup>217</sup> rather than any concerns about the breadth of the net it casts in aid of that purpose.

#### D. Conclusion

Both database protection bills are regulations on information use and exchange. Both are thus regulations of speech, in the sense that they are subject to First Amendment scrutiny. For the most part, they are both content-neutral, and should be treated as functionally equivalent to structural media regulations—*i.e.*, laws that regulate information production and exchange with the intent of improving information flows, but do so by regulating how people can and cannot, produce, use, and exchange information. These laws are subject to an intermediate level of scrutiny, most plainly stated in *Turner I*.<sup>218</sup> They must be shown to be aimed at an important government interest, to be capable of actually serving that goal, and

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216. H.R. 1858, 106th Cong. § 103(d) (1999).

217. See H.R. REP. NO. 106-350, at 10 ("[T]here are complaints that systematic unauthorized commercial copying of databases, particularly comprehensive databases stored in digital form, may sometimes go unremedied because of gaps in current law.").

218. See *Turner Broad. Sys., Inc. v. FCC*, 512 U.S. 622 (1994).

not to serve that goal in a manner that is much more restrictive of speech than necessary.

House Bill 354 fails this level of intermediate scrutiny both because there is no basis to believe that the important government interest claimed by its drafters really exists, and because even if there were such basis, it regulates speech much more broadly than necessary to attain its stated goal. No serious evidence was presented to Congress or identified by the committee that the database industry in fact needs any new protection. Evidence identified in the Committee Report for House Bill 1858 specifically refutes the claim that there is a need for something like a property right in raw information in databases—whether it is called a *sui generis* property right or a robust unfair competition rule. The database industry, and in particular its commercial component, have grown robustly both before and after *Feist*. Short of generalized statements of the possibility of “piracy” there was no evidence to suggest that widespread consumer or competitor practices undercut the ability of commercial database producers to support their continued investment in the production, maintenance, and distribution of databases.

Moreover, despite this lack of evidence, House Bill 354 sweeps much more broadly than necessary given those justifications offered—if not supported—by the Committee Report on the bill. Its general prohibition on extraction, its broad definitions of primary and related markets, the sweep of productive uses it captures for the benefit of existing database owners at the expense of future database producers and their consumers, and the property-like protection (in terms of the economic function of the rights created) it provides for the information contained in databases simply cover too many ways in which people want to and can use information in databases. It prohibits or burdens with uncertainty too many valuable uses of information, both commercial and noncommercial, both amateur and professional, which do not compete with, and certainly do not undercut, commercial database producers. In the absence of serious evidence that the database industry is broken, it imposes this heavy burden for highly speculative a gain.

House Bill 1858 is similarly thin on evidence that there is a real need for a new right. Authors of the Committee Report on that bill do little to support that claim, other than begrudgingly admit that database providers sought some protection, and this seems to have been the minimal protection that would do to ameliorate the pressure whose primary product is House Bill 354. Even with respect to its second section, which creates something like a fifteen minute property right in real-time market information, most of the testimony that supported the bill came from online bro-

kers who sought greater access to the information,<sup>219</sup> while those who testified to a market need for such a right in fact supported the much broader rights created in House Bill 354.<sup>220</sup> Nonetheless, the narrowness of the prohibitions created in House Bill 1858, on both its parts and its placing of enforcement responsibility with the Federal Trade Commission, thereby limiting the risk of anticompetitive abuses of the prohibition by database owners, suggest that the harm that would be imposed by this bill, if passed, would be relatively minimal.

## VI. CONCLUSION

The United States Constitution imposes two constraints on Congress's power to regulate information production and exchange by creating and enforcing private rights. First, the Intellectual Property Clause requires that all rights that function as exclusive, property-like rights be passed under that clause, and within its constraints. Under the Intellectual Property Clause, Congress may create such rights if and when they are likely to encourage information production more than they inhibit it. Moreover, these rights must be available only to those who make original contributions to the wealth of our collective knowledge, and the exclusive right enacted should not remove from, or burden free access to, information already in the public domain. Because Congress's power to enact such property-like rights is substantively limited in this way, Congress may not pass functionally equivalent rights under any other power, including the commerce power, unless these rights too comply with the limitations imposed by the Intellectual Property Clause. If it is to regulate markets in information by creating private rights that do not comply with these basic limitations, it can only do so if these rights are different in kind than intellectual property rights.

Whether private rights in information markets are created within or without the Intellectual Property Clause, and even if they either comply with the requirements of that clause or are exempt from it because properly enacted under another power, all such private rights are subject to

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219. See *Consumer and Investor Access to Information Act: Hearing on H.R. 1858 Before the Subcomm. on Finance and Hazardous Materials of the House Comm. on Commerce, 106th Cong., available at* <http://com-notes.house.gov/cchea/ hearings106.nsf/768df0faa6d9ddab852564f1004886c0/7cfb78eed9dab88e852567cf0047a7a8?OpenDocument> (including testimony from representatives of Bloomberg Financial Markets, New York Stock Exchange, Charles Schwab and Company, National Association of Securities Dealers, DLJdirect, Securities and Exchange Commission, and Ameritrade Holding Corporation).

220. See *id.*

First Amendment review. All such rights, even if intended to aid the efficient production of information, entail prohibiting some people from accessing information or communicating it in certain ways that they can and wish to. They must all therefore pass at least the intermediate level of First Amendment scrutiny courts apply to the most closely analogous form of information market regulation—structural media regulation. To be valid, such rights must be shown to advance an important, noncensorial government purpose, and must do so without burdening more speech than necessary.

The reason for the robust judicial review created by these cumulative constraints on congressional power has to do with the importance of information to our society and with the systematic biases of the political economy of enclosure. The capacity to access information, to rework it, and to communicate it to others in society is central both to political self-governance and to personal autonomy. Laws that constrain access to information or limit the ways in which individuals or communities of interest can shape their information environment should be subject to the same careful judicial protection that has traditionally led courts to protect these values. Furthermore, legislation that encloses the public domain is systematically subject to biased presentation of its social costs and benefits. Owners of information goods usually see the social benefits of new enclosure legislation as private benefits that can be captured by enforcement of the proposed new property rights. They can fully present these benefits to the legislature. The social costs of such new rights, however, are widely dispersed and external to most users who will over time experience them. In particular, intellectual property rights systematically benefit present generations of producers over future generations of producers, who are often entirely absent from the debate when legislation whose price they will be required to pay is considered. The legislative process is therefore systematically biased in the direction of overprotection. Courts, presented as they are with disputes between similarly engaged parties, are in a better position, over time, to perceive the social costs of enclosure. The robust system of judicial review gives them an opportunity to use this informational advantage to provide a counterbalance to the legislative bias on such a central aspect of our social welfare—information production and dissemination.

The more expansive of the two proposed database protection bills currently before Congress, House Bill 354, fails both constitutional tests. Despite protestations to the contrary, a functional analysis of its provisions suggests that it creates a set of rights much more analogous to intellectual property rights than to unfair competition rules enforceable by a private

right of action. The bill creates rights to exclude users of the information for its intended use, as well as competitors. It tracks rights in a collection through successive, non-duplicative productive uses, and secures for the producers of databases a return on their investment's contributions to other, downstream producers. In all these attributes the bill functions like an intellectual property right. Its exemptions and exclusions do not affect this basic function, but merely outline its contours. As an intellectual-property-like right, the bill must be passed, if at all, under the Intellectual Property Clause. However, the Supreme Court's decision in *Feist* prevents protection of raw data in compilations by an intellectual-property like right. Congress's attempt to pass such a right under the Commerce Clause is invalid, as is therefore the proposed statute.

Similarly, even if this bill were not invalid under the Intellectual Property Clause, it would be invalid under the First Amendment. No evidence was presented in Congress to suggest that database producers in fact required any protection at all. In particular, the Committee Report focused on the fear of certain sharp competitive practices, but provided no plausible basis to think that the database industry is threatened by inability to exclude users from databases, or by inability of database producers to capture the entire value that their investment in collecting information provides to subsequent database producers. The breadth of the bill's prohibitions and its capacity to reach many valuable uses and exchanges of factual information suggest that the bill restricts speech too extensively in pursuit of too speculative a gain. This factor is emphasized by the likely efficacy of the alternative bill, House Bill 1858, to attain the core concerns regarding free riding and ruinous competition.

House Bill 1858 does in fact create a competition regulation regime, not a property-like entitlement in database producers. It addresses only competitors, and only a certain subset of competitors, namely those who sell near-identical databases to the database from which they extracted the information. It prohibits only sale in competition with the source from which the duplicative database was duplicated. It does not speak to consumers. It does not speak to producers of other databases who add their own information to information they collect from databases produced by others, whether these value-added databases compete with their source or not. These limitations narrow the focus of House Bill 1858 such that it is plainly not a part of the basic definition of the economic excludability of information contained in databases. It is a regulation of a particular form of competition deemed ruinous and nonproductive. As such, House Bill 1858 can properly be passed under the Commerce Clause without reference to the limitations of the Intellectual Property Clause, and its protec-

tion for raw data, unattainable under the Intellectual Property Clause itself, is constitutionally permissible.

As was the case with House Bill 354, evidence that House Bill 1858 is necessary to serve the important governmental interest in the growth and development of a robust database industry is lacking. The Committee Report seems to suggest only that Congress was subject to pressure from the database industry, not that it was persuaded that something was fundamentally wrong that needed to be fixed before this industry could flourish. Indeed, the report directly cites evidence to suggest that there is no problem. Nonetheless, the bill's prohibitions on use of information are so narrow that despite the limited evidence that it serves an important governmental interest, it may be an appropriate regulation of speech, at least as a general matter, barring a specific context of application where it should no longer be seen as such.

The two bills nicely exemplify the way in which the constitutional constraints on Congress's power to create private rights in information and information goods interact. They suggest a cumulative effect, with the Intellectual Property Clause functioning as a threshold constraint on Congress's power to enact such rights, and the First Amendment overlaying a more context specific judicial evaluation of such rights, whether or not they pass muster under the threshold constraint.

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## A RESPONSE TO PROFESSOR BENKLER

By Marci A. Hamilton<sup>†</sup>

### ABSTRACT

Professor Hamilton explores the constitutional complexity uncovered by Professor Benkler in his piece, *Constitutional Bounds of Database Protection: The Role of Judicial Review in the Creation and Definition of Private Rights in Information*. Specifically, Professor Hamilton highlights that our democratic structure is characterized by representation rather than self-rule. In doing so, she refocuses the role of information in the political process and highlights that different types of information require different levels of access. Professor Hamilton's analysis further illustrates how an imprecise use of terminology may lead to incorrect conclusions regarding information jurisprudence. Through her more refined lens, Professor Hamilton reconsiders the proposed database legislation under the Copyright and Commerce Clauses and under First Amendment doctrine. While critiquing Benkler's underdeveloped theoretical and doctrinal approaches, she concludes that he does correctly find the Collections of Information Antipiracy bill constitutionally deficient; however, he is incorrect in finding the Consumer and Investor Access to Information bill constitutionally sound. Indeed, Professor Hamilton's response emphasizes that a broad-brush approach cannot draw the fundamental fine line between constitutionally acceptable and unacceptable regulations of information.

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## I. INTRODUCTION

There is much to like in Professor Benkler's article on Congress's pending database bills. I agree with his conclusion that the Collections of Information Antipiracy Act bill is constitutionally deficient, and significantly more so than the Consumer and Investor Access to Information Act bill.<sup>1</sup> I do not find persuasive, however, the constitutional rhetoric in which he has wrapped this analysis. His constitutional terminology is emotionally charged—"democracy," "autonomy," and "information"—but it proves too much, at least in this iteration. Moreover, he does not employ this constitutional terminology to examine the two database statutes he analyzes, but rather turns to a doctrinal approach.

The two competing threads in Professor Benkler's article—theoretical and doctrinal analysis—are worth detangling. First, I will turn to his constitutional rhetoric and express my concern that it is too expansive at this stage to assist reliably with drawing the constitutional line between information that should be accessible to the people and information that is less constitutionally significant. Second, I will address his doctrinal analysis, which although quite sound on many grounds, also suffers from too broad a brush in certain parts.

## II. CONSTITUTIONAL AND THEORETICAL RHETORIC

Professor Benkler postulates an alliance between democracy, autonomy, and information, and concludes that one database proposal is consti-

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1. See Yochai Benkler, *Constitutional Bounds of Database Protection: The Role of Judicial Review in the Creation and Definition of Private Rights in Information*, 15 BERKELEY TECH. L.J. 535 (2000). See generally the important work by J.H. Reichman and Pamela Samuelson, *Intellectual Property Rights in Data?*, 50 VAND. L. REV. 51 (1997). See also William Patry, *The Enumerated Powers Doctrine and Intellectual Property: An Imminent Constitutional Collision*, 67 GEO. WASH. L. REV. 359 (1999); Malla Pollack, *The Right to Know?: Delimiting Database Protection at the Juncture of the Commerce Clause, the Intellectual Property Clause, and the First Amendment*, 17 CARDOZO ARTS & ENT. L.J. 47 (1999).

tutional and the other is not.<sup>2</sup> The rhetorical force of these words is hard to resist. The rhetoric, though, because it is ill-defined, does not ineluctably lead to the conclusions he draws. The central problem with Professor Benkler's *theoretical* approach is that he intends these terms to have dispositive implications, but does not stop to define what each term means.

In his defense, Professor Benkler is working in largely uncharted territory and is writing for a symposium directed primarily at intellectual property issues. Nevertheless, because the constitutional and intellectual property issues affecting data protection are so intertwined, the failure to define core constitutional terms requires some discussion.<sup>3</sup>

### A. Democracy

Professor Edwin Baker has correctly pointed out that it is necessary to define the Constitution's scheme of government before one can assess speech or information regulations.<sup>4</sup> Benkler elides this important step, however, and thereby leaves unexamined presuppositions at the foundation of his theory of information regulation. Without satisfactory explanation, Benkler repeatedly assumes that the United States Constitution institutes a system of self-rule and democracy. In particular, he asserts that this is a "democratic society" and refers to "democratic discourse" and "democratic self-governance."<sup>5</sup>

I have addressed in other fora the fact that the governmental structure created by the Framers is not a system of self-rule, but rather a system of representation that rejects democracy and precludes self-rule.<sup>6</sup> I will not replay at length those arguments for this symposium, but suffice it to say that the people do not rule. The democracy of the United States's constitu-

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2. See Benkler, *supra* note 1, at 539. He begins with the broad claim that "two cumulative constitutional constraints [the enumerated powers doctrine and the First Amendment] . . . prevent enclosure of the public domain so extensive as to be detrimental to our information environment." *Id.* at 537.

3. For a more detailed analysis of the constitutional parameters affecting regulations of information, see generally Marci A. Hamilton, Information Speech (unpublished manuscript, on file with author).

4. See C. Edwin Baker, *The Media That Citizens Need*, 147 U. PA. L. REV. 317, 318-19 (1998).

5. Benkler, *supra* note 1, at 537, 558, 559, 566 n.93, 566 nn. 115, 123.

6. See Marci A. Hamilton, *The Reformed Constitution: Representation, Calvinism, and Congressional Responsibility*, ch. 4 (unpublished manuscript, on file with author) [hereinafter Hamilton, *Reformed Constitution*]; Marci A. Hamilton, *Discussion and Decisions: A Proposal to Replace the Myth of Self-Rule with an Attorneyship Model of Representation*, 69 N.Y.U. L. Rev. 477, 479-80 (1994) [hereinafter Hamilton, *Discussion and Decisions*]; Marci A. Hamilton, *Power, Responsibility, and Republican Democracy*, 93 MICH. L. REV. 1539, 1541 (1995).

tional experiment is highly mediated, because the Framers, frankly, distrusted the people.<sup>7</sup> Representatives are not instructed by the people, which is a proposal plainly rejected at the Convention.<sup>8</sup> Rather, representatives' decisions are constitutionally legitimate regardless of how the people judge those decisions. The people's role is to predict which governors will act in their best interests the majority of the time. They are given two means of controlling who the governors will be and how they govern: the voting booth and a two-way communication pathway.<sup>9</sup>

The legal analysis of information regulation, thus, should not rest on a presumption that the people make the law, but rather on the knowledge that the people's power in the public sphere is limited to choosing who will do so. This distinction has profound implications, because it makes some information especially crucial in the effective operation of the Constitution.

Accordingly, the Constitution identifies and makes available crucial information regarding the decisions reached by governors. Congress is under plain obligations to make their deliberations and actions known to the public. It is required to keep a public record of its proceedings and to report its votes when at least one-fifth of the members request such a report.<sup>10</sup> To ensure a fuller public exchange of their positions, the Speech and Debate Clause immunizes representatives from liability for anything said during legislative debate.<sup>11</sup>

The Speech and Press Clauses of the First Amendment foster the two-way pathway of information between representatives and the people. First, the First Amendment reinforces the information running from governors to the people by protecting the press that reports on their activities. Second, it opens a pathway from the people to their government by protecting expression in the press, which is made public.<sup>12</sup> Thus, the Constitution al-

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7. See Marci A. Hamilton, *The People: The Least Accountable Branch*, 4 U. CHI. L. SCH. ROUNDTABLE 1 (1996-1997).

8. See Hamilton, *Discussion and Decisions*, *supra* note 6, at 536 n.262.

9. See Hamilton, *Reformed Constitution*, *supra* note 6, at ch. 4. See generally Hamilton, *Discussion and Decisions*, *supra* note 6, at 480, 529-30 (describing the relationship between citizen and legislator in the attorneyship model of representative democracy).

10. See U.S. CONST. art. I, § 5, cl. 3 ("Each House shall keep a Journal of its Proceedings . . . and the Yeas and Nays of the Members of either House on any question shall, at the Desire of one fifth of those Present, be entered on the Journal.").

11. See U.S. CONST. art. I, § 6, cl. 1 ("The Senators and Representatives . . . for any Speech or Debate in either House, they shall not be questioned in any other place.").

12. See U.S. CONST. amend. I.

ready identifies a privileged subset of information that must be as free as possible if the system is to work.<sup>13</sup>

Information about the character of rulers also becomes crucial because these representatives are independent of the people during their term of representation. In the absence of a right to instruct on particular issues, the people need to choose individuals who have the integrity to adhere to the positions they took during their campaigns and whose judgment can be trusted on the myriad of issues that were never discussed during the campaign but that will need to be decided. The Framers premised the Constitution's representative system on the belief that the system would only work when some virtuous individuals found their way into positions of power.<sup>14</sup> This situation is a direct result of having instituted a system in which the people do not make the law but rather select those who do.

Other information, while important, is not as critical to the operation of a representative system. For example, there is no obligation on the part of the government to educate every citizen on the intricacies of each piece of legislation, like the Clean Air Act, or on the machinations of various agencies, such as the Central Intelligence Agency. Indeed, the very premise of a representative system is that the people can be free to live their own lives and attend to their own callings, while the elected representatives take care of the business of the country.<sup>15</sup>

Benkler, though, rests his conclusions about information regulation on the assumption that the United States constitutional scheme institutes a system of democratic self-government, saying, *inter alia*, that, "[f]or a community to be democratically self-governing its members must have access to information."<sup>16</sup> Benkler further states that "[i]nformation . . . is central . . . to democratic self-governance."<sup>17</sup> In his defense, "self-rule" is part of the misguided constitutional rhetoric of contemporary constitu-

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13. The Constitution does not absolutely protect such information, however. If less than 1/5 wish to publicize their votes, the Congress need not report the names of those who voted and how they voted. *See* U.S. CONST. art. I, § 5, cl. 3. This has turned into a large loophole for the House to engage in oral votes on politically difficult legislation and should be trimmed back to permit such unreported voting only when national security is at stake. *See* Hamilton, Reformed Constitution, *supra* note 6, at ch. 6. The Speech and Debate Clause protects the member of Congress from arrest for views spoken; it does not institute a right of information per se. *See* U.S. CONST. art. I, § 6, cl. 1. Thus, it leaves open the possibility of secret substantive discussions on matters of national importance.

14. *See* Hamilton, Reformed Constitution, *supra* note 6, at ch. 4.

15. *See generally* Hamilton, Reformed Constitution, *supra* note 6.

16. Benkler, *supra* note 1, at 559.

17. *Id.* at 568.

tional legal scholars.<sup>18</sup> As Benkler has deployed the term here, it is impossible to differentiate between different types of information requiring different degrees of access, and hence to find a limiting principle on the “right of access.” Though he seems to deny that he is crafting an absolute rule of access, nothing in Benkler’s use of “democracy” would carve such a limit.

## B. Autonomy

Like “democracy,” “autonomy” is a term from the liberal tradition that loses its clear edges once examined closely. There is no such thing as pure autonomy, a principle with which I am sure Professor Benkler would agree. There can only be mediated autonomy. We are all bound to some degree by law, history, family, jobs, abilities, disabilities, and fortune. Benkler, though, speaks as though autonomy can be pure and total, and assumes without argument that autonomy is the primary goal of the Constitution. He refers to “autonomous individuals,” “personal autonomy,” and “individual autonomy,” and equates being an “autonomous individual” with being the “author[] of [one’s life],” as though pure freedom were possible.<sup>19</sup> Like Benkler’s use of the term “democracy,” “autonomy” in his article is a romantic, liberal ideal, but it is not a well-defined constitutional concept that can meaningfully guide constitutional results.

Having assumed the centrality of (an ill-defined) autonomy to the constitutional scheme, Benkler then concludes that autonomy is dependent on information: “The quantum of autonomy people can have and do actually enjoy is partly a function of the information they have about the world as it is, and the options open to them to live their lives.”<sup>20</sup> Indeed, “information . . . is central . . . to personal autonomy.”<sup>21</sup> On the one hand, such statements are truisms with which few could disagree. On the other hand, they are too empty of context to help answer the question of when “information” can be propertized or owned.

There is a lacuna in Benkler’s reasoning here that demands closer examination. He seems to demonize information ownership as an evil to the constitutional value of autonomy. On his reasoning, then, propertized information (i.e., information that would be available if paid for) should not

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18. See generally Hamilton, *Discussions and Decisions*, *supra* note 6 (providing taxonomy of legal schools of thought that have misinterpreted the Constitution’s relationship to self-rule, including public choice, civic republicanism, and dynamic statutory interpretation).

19. See Benkler, *supra* note 1, at 558.

20. *Id.* at 565.

21. *Id.* at 568.

be as problematic as secret information. To be the “author” of one’s own life, one needs as much information as possible, regardless of how the information has to be obtained. Closely held, secret information causes ignorance and therefore would create impediments to one’s autonomy in Benkler’s theory. Nevertheless, the Constitution allows information to be kept secret.<sup>22</sup> If secret information is constitutionally acceptable, then *access* to all information may not be the sine qua non of constitutional analysis, and propertized information may not be the necessary constitutional evil Benkler’s rhetoric implies.

The private control of information—through propertization or secrecy—is not necessarily a constitutional evil. It depends, at least in part, on the type of information and on the context in which that information is used. There is a vast universe of information that is currently privately controlled, but that should not pose any constitutional difficulty. In the arena of intellectual property, for example, trade secrets long have been held constitutional.<sup>23</sup> But trade secrets are only a fraction of the privately controlled information in this society. Each of us holds a depository of unpublished information about family members, fellow workers, and past experiences. Others carry intellectual knowledge, religious revelation, or sophisticated political understanding. The robust right to access for which Benkler argues seems to conflict with the ability of these information-holders to hold on to their collections of information through government-sanctioned contract or societal norms. Professor Benkler seems to imply that no one can have exclusive rights to even such kinds of information, because information must be free for all.

Rather than mandating that all information be free, however, some accounts of autonomy would seem to require that private information must be amenable to secrecy. Indeed, this is the yin of the First Amendment defamation cases<sup>24</sup> that balances the yang of Benkler’s assumption that

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22. See *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 474, 493 (1974) (upholding Ohio’s trade secret protection law and concluding that trade secret law is consistent with and complementary to patent law).

23. See *id.*

24. See *Dun & Bradstreet v. Greenmoss Builders*, 472 U.S. 749 (1985) (affirming defamation judgment where non-media defendant’s defamatory statements did not involve an issue of public concern); *Gertz v. Robert Welch, Inc.*, 418 U.S. 323 (1974) (holding that a newspaper that publishes defamatory falsehoods about an individual who is neither a public official nor a public figure may not claim a constitutional First Amendment privilege against liability for those statements); *Curtis Publ’g Co. v. Butts*, 388 U.S. 130 (1967) (holding the *New York Times v. Sullivan* standard applicable to “public figures” as well as “public officials”); *New York Times v. Sullivan*, 376 U.S. 254

information must be free for there to be autonomy. Benkler's analysis, however, makes no nod to this constitutional sphere of privacy rights that permit individuals to bring claims based on the misappropriation of their private information.<sup>25</sup> This is due surely to an underdeveloped concept of autonomy. Further, this oversight results from Benkler's use of the term "information."

### C. Information

The central problem in Professor Benkler's rhetorical and theoretical strategy is his undifferentiated use of the term "information." He does not stand alone here.<sup>26</sup> In this new era, finer reticulations of core terms are needed and are only just beginning to take shape. In the context of the First Amendment, however, this lack of precision falsifies broad conclusions.

#### 1. *Information as a Term of Art*

"Information" is a loaded term. One of the most used terms in this technological era, it has become a motley cast of different elements, including facts, data, news, report, comment, statement, message, opinion, history, secrets, expression, or works of authorship, to name a few.<sup>27</sup> There are many gradations within each category as well: there can be private facts, public facts, political facts, historical facts, discovered facts, uncovered facts, expensive facts, or cheap facts. There can be artistic opinion,

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(1964) (holding that a public official cannot recover damages for a defamatory falsehood relating to his official conduct absent a showing of "actual malice").

25. *See, e.g.*, *Florida Star v. B.J.F.*, 491 U.S. 524, 533 (1989) (acknowledging the fact that press freedom and privacy rights are both "plainly rooted in the traditions and significant concerns of our society," but holding that when private information is legally obtained from public court records, press freedom prevails (quoting *Cox Broadcasting Corp. v. Cohn*, 420 U.S. 469, 491 (1975)); *Cox Broadcasting Corp. v. Cohn*, 420 U.S. 469, 488-91 (1975) (reviewing and recognizing the right to privacy and its relation to First Amendment rights); *Salinger v. Random House, Inc.*, 811 F.2d 90, 100 (2d Cir.), *cert. denied*, 484 U.S. 890 (1987) (protecting privacy interests where the offending publication made some use of the plaintiff's unpublished letters, held to be a violation of copyright law).

26. *See, e.g.*, JAMES BOYLE, *SHAMANS, SOFTWARE, AND SPLEENS: LAW AND THE CONSTRUCTION OF THE INFORMATION SOCIETY* (1996) (applying the term information to a wide range of items, including shamans and spleens).

27. *See, e.g.*, Collections of Information Antipiracy Act, H.R. 354, 106th Cong. § 1401(2) (1999) (defining "information" as "facts, data, works of authorship, or any other intangible material capable of being collected and organized in a systematic way."); Consumer and Investor Access to Information Act, H.R. 1858, 106th Cong. § 101(3) (1999) (defining "information" as "facts, data, or any other intangible material capable of being collected and organized in a systematic way, with the exception of works of authorship").

malicious opinion, baseless opinion, religious opinion. The taxonomy is seemingly endless.

Moreover, the same information can be used in strikingly different ways. For example, the fact that Senator Squeamish flunked constitutional law in law school can be found in the school's grade records, in a newspaper article on the Senator, as part of a political advertisement during a political race, or in an Internet attack orchestrated by interest groups who are unhappy with his votes and who package this fact with false information about his other grades. Each context invites a different constitutional analysis, which depends on how the information is being used and by whom.

Benkler never distinguishes the various types of information that might be at stake under a statute creating rights in information. Nor does he address the different constitutional consequences that will be triggered depending on the type of information at issue, how it is being used, and who will be using it. If his opening example—a statute that propertizes information in news, history, and scientific information<sup>28</sup>—is any indication, he is thinking only in terms of constitutionally weighty information employed in contexts where its constitutional value is at its highest. Benkler does not address how the analysis might change—and it will—if some or all of the information being propertized is low-value information from a First Amendment perspective, such as fighting words, pornography, or defamation of a private figure. Nor does Benkler account for the differences that will arise depending on who is using the information for what purpose.

## 2. “Information” in the Supreme Court’s Cases

Benkler’s broad-brush approach to “information” also leads to an over-reading of Supreme Court cases that will be interpreted as an information jurisprudence emerges. He treats “information” as a defined category in the cases and assumes the existence of an information jurisprudence that does not yet exist. In discussing the *Trade-Mark Cases*<sup>29</sup> decided in 1879, he says the Court held that there are limits on the extent to which Congress, pursuant to the Intellectual Property Clause, may “create exclusive rights in information.”<sup>30</sup> This statement is not quite accurate. The conclusion regarding a limit on Congress in the Clause is inescapable, but the attempt to turn the holding into a pronouncement on information overstates it. The Court’s focus was on congressional power over trade-

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28. See Benkler, *supra* note 1, at 536.

29. 100 U.S. 82 (1879).

30. See Benkler, *supra* note 1, at 539.

marks, not information. Although the *Trade-Mark Cases* opinion employs the term "information," it is not in the sense used by Benkler. Rather, the Court's discussion of the copyrightability of trademarks talks in terms of "invention," "discovery," and the "writings of authors."<sup>31</sup> When the case does use the term "information(s)," it uses the term to mean "indictment."<sup>32</sup>

The truth is that the Court has not rendered a conscious information jurisprudence to date. The beginnings of such a jurisprudence exist in the cases Benkler cites,<sup>33</sup> but even when taken together they do not justify the certainty ascribed by him.

The slippage in Benkler's use of the term "information" also is apparent when he cites to Thomas Jefferson as a source for the proposition that information should not be broadly protected.<sup>34</sup> However, Jefferson did not speak in terms of the contemporary usage of "information," but rather in terms of atomistic "ideas" that originate from an "individual brain" and that are "incapable of confinement or exclusive appropriation."<sup>35</sup> In contrast, the debate about database protection has been sparked by the technological possibility that ideas and other aspects of information *can* be propertized. Thus, Jefferson would seem particularly inapplicable here. Yet, Benkler moves from Jefferson's quote to conclude that the "free exchange of information, rather than its enclosure, is the presumed beneficial state."<sup>36</sup>

Benkler's line of reasoning proves too much. Although he correctly concedes that some regulation of information is permissible under the Court's cases, his concession seems out of place in the context of his dissemination discussion. His information theory is simply too broad to

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31. See *Trade-Mark Cases*, 100 U.S. 82, 93-94 (1879).

32. See *id.* at 91, 92 (employing the contemporary English common law usage of the term "information" which referred to a formal accusation of a crime made by a prosecuting officer).

33. See, e.g., *Feist Publications v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991) (holding that mere effort cannot transform facts into copyrightable property); *Graham v. John Deere Co.*, 383 U.S. 1 (1966) (holding that obviousness is to be one of the three requirements of patentability); *Trade-Mark Cases*, 100 U.S. at 94 (stating that "while the word writings may be liberally construed, as it has been, to include original designs for engravings, prints, &c., it is only such as are original, and are founded in the creative powers of the mind.").

34. See *id.* at 542 n. 22.

35. *Id.* I will leave aside for now the question whether Jefferson, who was not even in the country at the time of the Convention, is a reliable source of the meaning of Article I of the Constitution.

36. *Id.* at 543.

draw the line between acceptable and unacceptable regulations of information. Despite the fact that Benkler argues his analysis is a “robust system of judicial review,”<sup>37</sup> it is couched in a way that makes it sound as if it were an absolute standard of review that would invalidate any legislation touching on information.

### III. PROPOSED UNITED STATES DATABASE LEGISLATION

Although I do not find Professor Benkler’s theoretical rhetoric terribly helpful, I do think he has reached the right conclusion on the Collections of Information Antipiracy Act bill (“Antipiracy bill”).<sup>38</sup> Yet, I am not as persuaded that the Consumer and Investor Access to Information Act bill (“Consumer Access bill”)<sup>39</sup> is free of constitutional difficulties. I will begin with a brief history and explanation of the bills and then turn to an examination of each bill in response to Professor Benkler’s doctrinal analysis.<sup>40</sup>

In May 1996, the first database protection bill in the United States was introduced in Congress.<sup>41</sup> It defined “database” as “a collection, assembly or compilation, in any form or medium now or later known or developed, of works, data or other materials, arranged in a systematic or methodical way.”<sup>42</sup> The bill, which proposed protection for a term of twenty-five years,<sup>43</sup> did not make it out of committee.

Since then, the proposals for database protection before Congress have proliferated. During the spring of 1999, Senator Orrin Hatch took the highly unusual step of entering three different legislative database proposals into the Senate record. Two were drafted by interest groups while the third was drafted as a middle ground by Senate staffers. Hatch did not en-

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37. *Id.* at 573.

38. H.R. 354, 106th Cong. (1999).

39. H.R. 1858, 106th Cong. (1999).

40. For purposes of this symposium, I limit my remarks to Professor Benkler’s themes.

41. *See* Database Investment and Intellectual Property Antipiracy Act of 1996, H.R. 3531, 104th Cong. (1996) [hereinafter Database Investment bill].

42. *See id.* § 2.

43. *Compare* World Intellectual Property Organization, Basic Proposal for the Substantive Provisions of the Treaty on Intellectual Property in Respect of Databases to be Considered by the Diplomatic Conference, CRNR/DC/6, art. 8 (Aug. 30, 1996) ([http://www.wipo.org/eng/diplconf/6dc\\_all.htm](http://www.wipo.org/eng/diplconf/6dc_all.htm)) (considering whether the term of protection shall expire twenty-five or fifteen years from the date of completion of the making of the database) *with* Database Investment and Intellectual Property Antipiracy Act of 1996, H.R. 3531, 104th Cong. (1996) § 6(a) (stating that the database shall remain protected “for a period of twenty-five years”).

dorse any one of these in particular, but stressed the necessity of curbing "database piracy."<sup>44</sup>

While the Senate was reviewing these three proposals, the House of Representatives had before them two proposals that mark the ends of the spectrum. Representative Howard Coble introduced the Antipiracy bill (H.R. 354) and Representative William "Bill" Bliley introduced the Consumer Access bill (H.R. 1858). The names of these bills alone indicate the disparity in their approaches.

### A. The Antipiracy Bill

As Professor Benkler points out, the sweep of the Antipiracy bill is quite broad and its provisions sound in property rights rather than misappropriation.<sup>45</sup> The Antipiracy bill would protect not only the database owner's primary market, but also any related market.<sup>46</sup> Its definition of "information" is rapacious, including "facts, data, works of authorship, or any other intangible material capable of being collected and organized in a systematic way."<sup>47</sup> To be eligible for protection, a database creator must have invested "substantial monetary or other resources" in the creation of the database.<sup>48</sup>

A user is liable to the database owner if he causes "material harm" to the "primary or related market" of the database by making a "substantial" portion available to the public or by extracting a substantial part.<sup>49</sup> Through indirection, the bill also permits a database owner to claim that a substantial portion of the database has been taken by showing that as little as two items of information were taken: By the terms of the Antipiracy bill, "individual" items of information are not "substantial," but any other taking apparently including as few as two pieces of information may be.<sup>50</sup>

The Antipiracy bill exempts certain "nonprofit education, scientific, or research purposes" from liability as long as such uses do not "materially harm the primary market."<sup>51</sup> There is also a provision permitting individual acts done for "purposes such as illustration, explanation, example, comment, criticism, teaching, research, or analysis . . . if [they are] rea-

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44. See Database Antipiracy Legislation, 145 CONG. REC. S31, 601-17 (1999) (statement of Sen. Orrin Hatch).

45. See Benkler *supra* note 1, at 575.

46. See H.R. 354, 106th Cong. §§ 1402, 1401(3)-(4) (1999).

47. *Id.* § 1401(2).

48. *Id.* § 1402(b).

49. *Id.*

50. *Id.* § 1403(c).

51. *Id.* § 1403(b).

sonable under the circumstances.”<sup>52</sup> Factors to determine whether acts are reasonable include whether the amount of information made available or extracted is appropriate for the purpose.<sup>53</sup> Users in this category enjoy this preference if their work is for nonprofit purposes, if the person using the database is acting in “good faith,” if the new database or work generated is significantly different from the database, *and* if the user is not in the same “primary market” as the database maker.<sup>54</sup> There is also protection for news reporting, including “news gathering, dissemination, [and] comment.”<sup>55</sup>

The Antipiracy bill does not set a term limit *per se*, but rather sets a “limitation” on when actions can be maintained under the bill. “No criminal or civil action shall be maintained . . . for making available or extracting all or a substantial part of a collection of information that occurs more than 15 years after the portion of the collection that is made available or extracted was first offered in commerce . . . .”<sup>56</sup>

## B. The Consumer Access Bill

The Consumer Access bill is considerably more friendly to the information user and less so to the database producer than the Antipiracy bill would be. Like most database protection formulations, the database maker must have made a substantial investment to be eligible for protection.<sup>57</sup> The “information” that would be protected under the Consumer Access bill includes “facts, data, or any other intangible material” but excludes “works of authorship.”<sup>58</sup> On this issue alone, its reach is significantly more restrained than the Antipiracy bill.<sup>59</sup>

User liabilities are considerably narrower under the Consumer Access bill than under any other proposal to date. A user is prohibited from duplicating, selling, or distributing another’s database if he is distributing the

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52. *Id.* § 1403(a).

53. *See id.* § 1403(a)(2).

54. *Id.* § 1403(a)(1), (3)-(5).

55. *See id.* § 1403(e).

56. *Id.* § 1409(c).

57. *See* H.R. 1858, 106th Cong. § 101(1) (1999) (defining database as “information . . . collected and organized . . . through the investment of substantial monetary or other resources”).

58. *Id.* § 101(3) (defining “information” as “facts, data, or any other intangible material capable of being collected and organized in a systematic way, with the exception of works of authorship”).

59. “Works of authorship” is a significant exclusion, because it precludes database legislation from removing copyrighted works of authorship from the public domain.

copy "in commerce in competition" with the original database.<sup>60</sup> The bill defines "in competition" as the displacement of "substantial sales or licenses of the database of which it is a duplicate" and a significant threat to the "opportunity to recover a return on the investment."<sup>61</sup> There is no talk of "related" markets, as in the Antipiracy bill. Moreover, there must be proof both that substantial sales or licenses have been displaced *and* that the duplicate has negated the opportunity to obtain a return on the investment.

The Consumer Access bill also provides more explicit exceptions from the bill's reach. Rather than creating a multi-part test permitting some "reasonable" uses as the Antipiracy bill does, the Consumer Access bill expressly excludes news reporting, law enforcement, scientific research, and educational uses from the scope of the bill.<sup>62</sup>

Despite its generally information user-friendly approach, the Consumer Access bill institutes no time limitation. All databases, whether new or established, can be protected against commercial competitors for an infinite term.

Both bills indicate some discomfort on the part of Congress in entering this potentially constitutionally dangerous fray. The Antipiracy and Consumer Access bills both contain a reporting requirement, which reflects how tentatively the United States is approaching this legislation. Indeed, the Consumer Access bill calls for a report to Congress within thirty-six months of enactment to ascertain the state of the database market, including the availability of databases and information, the extent of competition between producers, and the amount of investment in the industry.<sup>63</sup> As Professor Benkler notes, this may be the single most important aspect of the bill, given that the economic case has yet to be made to prove that such legislation is necessary or good for the market.<sup>64</sup> The Antipiracy bill further reflects Congress's discomfort—it also requires a report to Congress within thirty-six months of enactment on whether certain defenses to the unauthorized uses of collections of information can be extended.<sup>65</sup>

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60. See Consumer and Investor Access to Information Act, H.R. 1858, 106th Cong. § 102(2) (1999).

61. *Id.* § 101(5).

62. See *id.* § 103. Like most other database proposals, the Consumer Access bill also permits independent gathering of the same information already collected in an existing database.

63. See *id.* § 108(1)-(4).

64. See Benkler, *supra* note 1, at 591-594.

65. See Collections of Information Antipiracy Act, H.R. 354, 106th Cong. § 1410 (1999) ("No later than 3 years after the date of the enactment of this chapter, the Register

### C. Constitutional Analysis of the Two Database Bills

As Professor Benkler's article makes clear, on the basis of the existing case law, the most significant barriers to information enclosure are likely to arise from the enumerated powers doctrine and various doctrines under the First Amendment. Privacy doctrines are likely to be relevant as well, but for this piece, I will limit my comments to the cases discussed by Professor Benkler.

#### 1. *The Copyright Clause and the Pending Database Bills*

Professor Benkler argues that *Feist Publications, Inc. v. Rural Telephone Service Co.*<sup>66</sup> draws on the Intellectual Property Clause to create a right in information access and a rule against "enclosure" of aspects of the public domain.<sup>67</sup> This interpretation needs to be nuanced rather significantly.

I completely agree with Professor Benkler's implicit point that the new bills raise the question of whether any federal database legislation is *in fact* an attempt to create copyright-like rights in data.<sup>68</sup> The more the legislation resembles copyright protection, the more likely courts will find it to be an inappropriate enactment pursuant to the Copyright Clause. Congress has clearly received this message because both bills expressly postulate that they are not copyright statutes and do not affect copyright law or other intellectual property law.<sup>69</sup> Despite the disclaimer, though, and as Benkler argues, the Antipiracy bill, with its expansive protection, looks more like a copyright-based, property right than does the Consumer Access bill.<sup>70</sup> Indeed, it is so close that it is likely to be held unconstitutional.

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of Copyrights and the Assistant Attorney General, Antitrust Division of the Department of Justice, shall conduct a joint study and submit a joint report to Congress on whether the defense provided for in section 1408(c) should be expended [sic] to include collections of information that do not incorporate all or a substantial part of a government collection of information where the extracted information is not publicly available from any other source.").

66. 499 U.S. 340 (1991).

67. See Benkler, *supra* note 1, at 545-546.

68. See *id.* at 586.

69. See H.R. 354, 106th Cong. § 1405(a) (1999) (stating "nothing in this chapter shall affect rights, limitations, or remedies concerning copyright, or any other rights or obligations relating to information, including laws with respect to patent, trademark, design rights"); H.R. 1858, 106th Cong. § 105(a) (stating "nothing in this title shall affect rights, limitations, or remedies concerning copyright, or any other rights or obligations relating to information, including laws with respect to patent, trademark, design rights").

70. See Benkler, *supra* note 1, at 581-582.

Under the *Feist* vision of the constitutional structure of copyright law, all citizens may be authors, and therefore the demand for the building blocks to make new works is intense. In the words of the Court,

The primary objective of copyright is not to reward the labor of authors, but “[t]o promote the Progress of Science and useful Arts.” To this end, copyright assures authors the right to their original expression, but encourages others to build freely upon the ideas and information conveyed by a work. This result is neither unfair nor unfortunate. It is the means by which copyright advances the progress of science and art.<sup>71</sup>

Conversely, in a system where few are likely to be authors, having fewer building blocks available might be acceptable. But under a system that identifies every individual, from child to adult, as a potential author, there must be many building blocks to avoid repetition and frustration and to foster a diverse market. Thus, the *Feist* reading of the Copyright Clause presupposes the necessity of a diverse and rich public domain of facts and works of authorship that have exceeded their copyright term.

However, the necessity for a rich public domain does *not* necessarily mean that information cannot or should not be enclosed. It sets no goal of having *all* information free to the public. Rather, a significant amount needs to be free. Conceivably, even more information than is currently free could be unavailable, while leaving the public domain sufficiently diverse. Thus, some enclosure may be tolerable. Indeed, this point was made by the Court in *International News Service v. Associated Press*,<sup>72</sup> which involved quintessentially important information under the First Amendment—news.<sup>73</sup> In sum, complete enclosure of the entire public domain would violate the strictures of the Copyright Clause. Limited enclosure, though, under another congressional power is a viable constitutional possibility. The key question is what limits are appropriate and feasible.

One plausible limit on the enclosure of information intimated by the *INS* decision would be a durational limitation, which already exists in copyright and patent law. The Consumer Access bill contains no limitation on the term of protection. This omission may have resulted from an over-

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71. *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 349-50 (1991) (citations omitted).

72. 248 U.S. 215 (1918).

73. *See id.* at 241-43 (upholding injunction restraining defendant from appropriating news from plaintiff's bulletins and in doing so recognizing a limited property right in news).

abundance of caution in ensuring that the bill not appear to be a copyright bill. Yet this is a wrongheaded approach. The point in *INS* was that news could be temporarily owned by a news reporting organization and therefore competitors could be prohibited from using it, during an extremely brief time of ownership.<sup>74</sup> Thus, a term of limitation is not peculiar to copyright law nor is it a sign that the law in question must be a copyright-like law.

I do not mean to argue against the value of a rich public domain. My point is simply that the argument in favor of a vital public domain does not justify a conclusion that all or even most information must be free. The difficult question is which information, in which circumstances, needs to be free for the goals of the Constitution to be served.

## 2. *The Commerce Clause and Database Legislation*

As Professor Benkler notes, those defending federal database legislation in the United States argue that it can be passed pursuant to Congress's power under the Commerce Clause. They concede, as they must, that *Feist* precludes Congress from enacting database protection under the Copyright Clause, but argue that the Commerce Clause opens another avenue.<sup>75</sup> Benkler does not address, however, the limitations on the Commerce Clause that will plague any attempts at congressional information regulation.

There was a time in United States constitutional jurisprudence when the Commerce Clause was thought to be a catch-all for essentially any of Congress's schemes. In recent years, however, the Court has been building a series of fences around federal congressional power to protect the states

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74. See *id.* at 245-46 (expressing concern that the injunction be of reasonable length to protect the complainant's interests but not so long as to be indefinite).

75. See *Collections of Information Antipiracy Act: Hearing on H.R. 354 Before the Subcomm. on Courts and Intellectual Property of the House Comm. on the Judiciary*, 106th Cong. (1999), available at (<http://www.house.gov/judiciary/106-wino.htm>) (summary of statement of Ms. Marilyn Winokur, Executive Vice President of Micromedex, on Behalf of the Coalition Against Database Piracy); *Collections of Information Antipiracy Act: Supplemental Statement on H.R. 2652*, 105th Cong. (1998) (statement of Jane C. Ginsburg, Professor of Law, Columbia University School of Law), available in 1998 WL 62976 (F.D.C.H.); Jane C. Ginsburg, *Copyright, Common Law, and Sui Generis Protection of Databases in the United States and Abroad*, 66 U. CIN. L. REV. 151, 153 (1997) ("It is clear after *Feist* that copyright protects only the selection or arrangement of information contained within a compilation. The 'facts themselves' remain free, as do the other elements that § 102(b) of the Copyright Act excludes from the subject matter of copyright. These include ideas, processes, and methods of operation.").

against federal overreaching.<sup>76</sup> Thus, any database legislation passed pursuant to the Commerce Clause will face significant federalism challenges to the extent it addresses the states.

The Commerce Clause, by its terms, gives Congress power over *inter*-state commerce, not intrastate commerce.<sup>77</sup> The Court recently held that Congress must have proof that the activity being regulated “substantially affects” interstate commerce.<sup>78</sup> It is not enough if the activity being regulated only creates a *de minimis* impact on interstate commerce.<sup>79</sup>

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76. See *Kimel v. Florida Bd. of Regents*, 120 S. Ct. 631 (2000) (holding that the Age Discrimination in Employment Act’s abrogation of the states’ Eleventh Amendment sovereign immunity exceeded Congress’s authority under the Commerce Clause); *Alden v. Maine*, 527 U.S. 706 (1999) (holding that the powers delegated to Congress under Article I of the United States Constitution do not include the power to subject nonconsenting states to private suits for damages in state courts); *College Savings Bank v. Florida Prepaid Postsecondary Educ. Expense Bd.*, 119 S. Ct. 2219 (1999) (holding that the state’s sovereign immunity was neither validly abrogated by the Trademark Remedy Clarification Act, nor voluntarily waived by the state’s activities in interstate commerce); *Florida Prepaid Postsecondary Educ. Expense Bd. v. College Savings Bank*, 119 S. Ct. 2199 (1999) (holding that neither the Commerce Clause nor the Patent Clause provided Congress with authority to abrogate state sovereign immunity in the Patent and Plant Variety Protection Remedy Clarification Act because the Fourteenth Amendment’s authorization for “appropriate legislation” to protect against deprivations of property without due process of law did not provide Congress with authority to abrogate state sovereign immunity); *City of Boerne v. Flores*, 521 U.S. 507 (1997) (holding that the Religious Freedom Restoration Act exceeded Congress’s enforcement powers under section 5 of the Fourteenth Amendment); *Printz v. United States*, 521 U.S. 898 (1997) (holding that an obligation to conduct background checks on prospective handgun purchasers imposed unconstitutional obligation on state officers to execute federal laws); *Seminole Tribe of Florida v. Florida*, 517 U.S. 44 (1996) (holding that Congress lacked authority under the Indian Commerce Clause to abrogate the states’ Eleventh Amendment immunity); *United States v. Lopez*, 514 U.S. 549 (1995) (holding that the Gun-Free School Zones Act exceeded Congress’s Commerce Clause authority since possession of a gun in a local school zone was not an economic activity that substantially affected interstate commerce).

77. See U.S. CONST. art. I, § 8, cl. 3 (Congress shall have the power “[t]o regulate Commerce with foreign Nations, and among the several States, and with the Indian Tribes.”). The Supreme Court has held that Congress’s power to regulate commerce is specifically limited to regulating interstate commerce. See *Gibbons v. Ogden*, 22 U.S. 1 (1824) (holding that the Commerce power is “restricted to that commerce which concerns more States than one”); *U.S. v. E.C. Knight Co.*, 156 U.S. 1, 17 (1895) (holding the application of the Sherman Act to a specific business acquisition in the State of Pennsylvania invalid because the acquisition “bore no direct relation to commerce between the states or with foreign nations”).

78. See *United States v. Lopez*, 514 U.S. 549, 559 (1995).

79. See *id.* at 566.

As discussed above, though, Congress cannot use the Commerce Clause as a *pretext* for creating database legislation that would create copyright rights in information. To be on the safe side, therefore, the legislation must be directed at commerce, in this instance, commerce in databases, rather than at investing individuals with property rights in information. The safest route would be for Congress to enact a species of unfair competition legislation. Indeed, the decision in *Feist* opens the door for such legislation, stating that “[p]rotection for the fruits of [data] research . . . may in certain circumstances be available under a theory of unfair competition.”<sup>80</sup> Still, this statement raises the question of what “circumstance” would justify protection of information? Benkler is correct that, from the Court’s reading of the Copyright Clause and the First Amendment, the circumstances must be exceedingly narrow.<sup>81</sup>

As Benkler points out, the Antipiracy bill may be unconstitutional because it is neither narrowly tailored nor does it rest on a factual base that indicates a definite market evil in need of federal legislative action.<sup>82</sup> It permits individuals to horde information for up to fifteen years, but rests on no fact-finding by Congress that would indicate the necessity for such legislation. Indeed, the absence of fact-finding regarding the database industry, its economic base, its growth, and the conditions for further growth, is quite striking in the congressional record. There is a generalized sense that “pirates” should not be able to “steal” databases that others have invested in, but there is no economic analysis of any substance.<sup>83</sup>

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80. *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 354 (1991) (quoting *Rosemont Enterprises, Inc. v. Random House, Inc.*, 366 F.2d 303, 310 (1966)).

81. See Benkler, *supra* note 1, at 552.

82. See *id.* at 598.

83. Of course, this is not peculiar to database legislation. Congress is capable of passing a mind-boggling array of laws on the basis of extremely little information. When the constitutionality of congressional power is at stake, though, the Court has required some evidence of the necessity for such legislation. See *Kimel v. Florida Bd. of Regents*, 120 S. Ct. 631, 650 (2000) (“Congress’ failure to uncover any significant pattern of unconstitutional discrimination here confirms that Congress had no reason to believe that broad prophylactic legislation was necessary in this field.”); *College Savings Bank v. Florida Prepaid Postsec. Educ. Expense Bd.*, 119 S. Ct. 2219, 2225 (1999) (referencing the question required by *City of Boerne* whether the prophylactic measure taken under purported authority of section 5 was genuinely necessary to prevent violation of the Fourteenth Amendment); *Florida Prepaid Postsec. Educ. Expense Bd. v. College Savings Bank*, 119 S. Ct. 2199, 2202 (1999) (“The legislative record thus suggests that the Patent Remedy Act does not respond to a history of ‘widespread and persisting deprivation of constitutional rights’ of the sort Congress has faced in enacting proper prophylactic § 5 legislation.”); *City of Boerne v. Flores*, 521 U.S. 507, 530 (1997) (“The appropriateness of remedial measures must be considered in light of the evil presented.”); *City of Rich-*

It is informative to compare the *reference* to unfair competition in the Court's unanimous copyright law decision in *Feist* with the *discussion* of unfair competition law in the Court's unanimous decision in *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*,<sup>84</sup> both of which were written by Justice Sandra Day O'Connor. In *Bonito Boats*, the Court described unfair competition law as being concerned "with protecting *consumers* from confusion as to source. While that concern may result in the creation of 'quasi-property rights' in communicative symbols, the focus is on the protection of consumers, not the protection of producers as an incentive to product innovation."<sup>85</sup> The Antipiracy bill does not fare well under this standard, because it is not a narrowly drafted unfair competition law intended to protect consumers, but rather an attempt, on its face, to protect producers who have invested in databases. The Consumer Access bill is narrower in scope and more tailored to a goal of fair competition, but its infinite term undercuts the claim that it is necessarily constitutional.

Commerce Clause doctrine raises other hurdles. In a series of cases interpreting the Eleventh Amendment, the Court recently clarified that Congress may not employ the Commerce Clause to enact a private right of action against a state.<sup>86</sup> Thus, Congress could not provide relief for database owners against the states or their officers acting in their official capacity.<sup>87</sup> With state universities and public libraries being large data consumers, this is a significant limitation.

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mond v. Croson, 488 U.S. 469, 510 (1989) ("Proper findings in this regard are necessary to define both the scope of the injury and the extent of the remedy necessary to cure its effects.").

84. 489 U.S. 141 (1989).

85. *Id.* at 157 (emphasis added).

86. *See generally* Alden v. Maine, 527 U.S. 706 (1999) (holding that the powers delegated to Congress under Article I of the United States Constitution do not include the power to subject nonconsenting states to private suits for damages in state courts); *College Savings Bank*, 119 S. Ct. 2219 (holding that a state's sovereign immunity was neither validly abrogated by the Trademark Remedy Clarification Act (TRCA), nor voluntarily waived by the state's activities in interstate commerce); *Florida Prepaid*, 119 S. Ct. 2199 (holding that neither the Commerce Clause nor the Patent Clause provided Congress with authority to abrogate state sovereign immunity in the Patent and Plant Variety Protection Remedy Clarification Act because the Fourteenth Amendment's authorization for "appropriate legislation" to protect against deprivations of property without due process of law did not provide Congress with authority to abrogate state sovereign immunity).

87. *See Alden*, 527 U.S. 706; *College Savings Bank*, 119 S. Ct. 2219; *Florida Prepaid*, 119 S. Ct. 2199. It seems likely that given this line of cases, the Court would invalidate any attempt by Congress to abrogate state sovereign immunity and provide a remedy for database owners against state misappropriation or infringement of database property.

In sum, the Copyright Clause is forbidden territory for propertizing information and the Commerce Clause offers limited options.<sup>88</sup> As Professor Benkler points out, even if database legislation could pass muster under the Commerce Clause, the First Amendment will serve as a further limitation on the reach of such legislation.<sup>89</sup> Although he is not explicit on this point, Benkler focuses on facial challenges. It is my view, however, that as-applied challenges will play an even greater role and will pose the most interesting questions.

### 3. *First Amendment Doctrine and Database Legislation*

The initial question to ask under First Amendment doctrine is whether a particular piece of database legislation is content-based. Benkler rejects this possibility in a footnote.<sup>90</sup> I am not persuaded, however, that the issue is so free from doubt.

While database legislation is, in general, viewpoint neutral, it is aimed at a particular type of content: facts and information.<sup>91</sup> Content-based legislation is traditionally subject to strict scrutiny under First Amendment doctrine.<sup>92</sup> As a result, a content producer defending the database bill in

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88. See generally William Patry, *The Enumerated Powers Doctrine and Intellectual Property: An Imminent Constitutional Collision*, 67 GEO. WASH. L. REV. 359 (1999) (exploring the scope of Congress's power to legislate intellectual property with particular attention to the Commerce Clause power). There may also be an argument that database legislation could be enacted pursuant to the so-called "foreign affairs power." See, e.g., Marina Lao, *Federalizing Trade Secrets Law in an Information Economy*, 59 OHIO ST. L.J. 1633, 1682-85 (1998) (discussing foreign affairs power with respect to trade secrets law).

89. Because Professor Benkler does not address it, I will leave aside the question of Congress's power vis-à-vis section 5 of the Fourteenth Amendment to enact property rights in data. Suffice it to say that section 5 limits Congress to enacting laws that enforce constitutional rights. See *Kimel v. Florida Bd. of Regents*, 120 S. Ct. 631 (2000); *Florida Prepaid*, 119 S. Ct. 2199 (1999); *City of Boerne v. Flores*, 521 U.S. 507 (1997). There would have to be a showing of widespread constitutional violation by the states to justify it, and it would have to be proportional and congruent to those existing violations. See *Kimel*, 120 S. Ct. at 650; *Boerne*, 521 U.S. at 530. See generally Marci A. Hamilton & David Schoenbrod, *The Reaffirmation of Proportionality Analysis Under Section 5 of the Fourteenth Amendment*, 21 CARDOZO L. REV. 469 (1999). Thus, the entire subject would turn on a finding that the states had violated the property rights of citizens with respect to information.

90. See Benkler, *supra* note 1, at 555 n.85.

91. See Mark A. Lemley & Eugene Volokh, *Freedom of Speech and Injunctions in Intellectual Property Cases*, 48 DUKE L.J. 147, 186 (1998) (positing that intellectual property law, while view-point neutral, is not content-neutral).

92. See, e.g., *Buckley v. American Constitutional Law Found., Inc.*, 119 S. Ct. 636, 649 (1999) (Thomas, J., concurring) (recognizing the Colorado regulation at issue as content-based, and thus applying strict scrutiny and requiring narrow tailoring); *Denver Area*

court would have to prove that Congress had a compelling interest in passing the bill and that it narrowly tailored the bill to fit its goal.<sup>93</sup> In other words, the means (the provisions of the bill) must fit tightly with the end intended to be achieved. This requirement is a nearly intolerable burden to bear based on the current state of the record in Congress. As Benkler points out, Congress has not demonstrated that there is a compelling need for database protection. Aside from the fact that the European Union now has such protection which does not provide for national treatment,<sup>94</sup> there is precious little evidence that such legislation is crucial to the industry or in the interests of the United States polity. Nor have any of the proposals' proponents demonstrated that either measure is closely tailored to the particular evil at which it is aimed. The debate has been premised on presupposition rather than fact. Hence, under either intermediate or strict scru-

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Educ. Telecomm. Consortium, Inc. v. FCC, 518 U.S. 727, 783 (1996) (applying strict scrutiny to content-based restrictions on public access cable stations); Turner Broad. Sys., Inc. v. FCC, 512 U.S. 622, 642 (1994) (applying "the most exacting scrutiny to regulations that suppress, disadvantage, or impose differential burdens upon speech because of its content").

93. See *New York v. Ferber*, 458 U.S. 747, 756-57, 773 (1982) (requiring the state to demonstrate a compelling interest and finding that New York had a compelling interest in banning child pornography and determining that its approach was neither underinclusive nor overbroad); *Widmar v. Vincent*, 454 U.S. 263, 269-70 (1981) ("In order to justify discriminatory exclusion from a public forum based on the religious content of a group's intended speech, the University must therefore satisfy the standard of review appropriate to content-based exclusions. It must show that its regulation is necessary to serve a compelling state interest and that it is narrowly drawn to achieve that end.").

94. See Council Directive 96/9/EC of 11 March 1996 on the Legal Protection of Databases, 1996 O.J. (L 77) 20. The Directive, like United States law, draws a line between copyright protection for databases and other protection. Like U.S. law, the Directive limits copyright protection to the "selection or arrangement of [database] contents" resulting from the "author's own intellectual creation." *Id.* at art. 3(1). Also consistent with U.S. law, the copyright protection of databases under the Directive does not "extend to their contents." *Id.* at art. 3(2). Nevertheless, the Directive does not leave database protection at copyright law. In its most important provisions, it institutes a system of sui generis database protection, which arguably is not controlled by the international intellectual property treaties such as the Berne Convention's reciprocity requirement. Therefore, the EU has attempted to enact database protection that is non-reciprocal. Under the Database Directive, the EU countries need not provide protection to nationals owning databases within their borders if their home country does not provide database protection. *Id.* at art. 11 (stating that the right shall apply to "database[s] whose makers or rightholders are nationals of a Member State or who have their habitual residence in the territory of the Community"). See generally M. NIMMER & P. GELLER, INTERNATIONAL COPYRIGHT LAW AND PRACTICE (1998) (discussing implementation of database provisions in foreign countries' laws).

tiny, each bill lacks an empirical basis that justifies its enclosure of significant parts of the public domain.

Based on the supposition that the bills are not content-based, Benkler would apply the intermediate scrutiny standard of *United States v. O'Brien*.<sup>95</sup> Further, Benkler solely addresses the First Amendment challenges likely to arise out of facial challenges to database laws. While both are ripe for invalidation under the enumerated powers doctrine, First Amendment jurisprudence will more likely be used to narrow the reach of the current and future bills in as-applied circumstances.

Existing constitutional theory requires courts to read ambiguous statutes in a way that ensures that they do not violate the Constitution.<sup>96</sup> The plain meanings of the new terms introduced by the database bills, including “primary or related market,” “substantial monetary investment,” and “substantial part,” may be sufficiently open to permit the courts to interpret them narrowly in favor of the user, hence avoiding First Amendment invalidation. However, when applied under particular circumstances, the bills may be found unconstitutional.

First Amendment doctrine also offers the possibility of challenging database legislation as being “void for vagueness,” a possibility Benkler does not consider. If a database statute is so vague that a user cannot properly tell whether or not the information is available to her, it would lead to an intolerable chilling of speech, and the courts should invalidate the vague and severable provisions of the statute.<sup>97</sup>

In sum, while I agree with Benkler’s conclusion that the Antipiracy bill is vulnerable under existing case law, I am not persuaded the Con-

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95. See Yochai Benkler, *Free as the Air to Common Use: First Amendment Constraints on Enclosure of the Public Domain*, 74 N.Y.U. L. REV. 354, 372 n.83, 413 n.230 (1999).

96. See *NLRB v. Catholic Bishop of Chicago*, 440 U.S. 490, 500 (1979) (“[A]n Act of Congress ought not to be construed to violate the Constitution if any other possible construction remains available.”).

97. See *Kolender v. Lawson*, 461 U.S. 352, 357 (1983) (invalidating California loitering statute for vagueness and explaining that “the void-for-vagueness doctrine requires that a penal statute define the criminal offense with sufficient definiteness that ordinary people can understand what conduct is prohibited and in a manner that does not encourage arbitrary and discriminatory enforcement”); *Smith v. Goguen*, 415 U.S. 566, 572-74 (1974) (invalidating for vagueness Massachusetts flag desecration statute); *Gooding v. Wilson*, 405 U.S. 518, 519-20 (1972) (invalidating for vagueness Georgia statute prohibiting opprobrious words and abusive language); *Connally v. General Constr. Co.*, 269 U.S. 385, 391 (1926) (“[A] statute which either forbids or requires the doing of an act in terms so vague that men of common intelligence must necessarily guess at its meaning and differ as to its application violates the first essential of due process of law.”).

sumer Access bill necessarily scales all constitutional hurdles. The enumerated powers doctrine along with the First Amendment will pose both facial and "as-applied" challenges to the range of legislative proposals currently being considered in Congress.

#### IV. CONCLUSION

In this era of new challenges in intellectual property law, it is necessary to ensure that emerging answers rest on a solid constitutional foundation. While I do not disagree, from a doctrinal standpoint, with Professor Benkler's conclusion that the Antipiracy bill is plainly unconstitutional and the Consumer Access bill is more narrowly tailored,<sup>98</sup> the theoretical, rhetorical construct on which he builds his argument cannot stand, and his doctrinal analysis requires further elaboration.

In Benkler's defense, however, the parameters for constitutional analysis of information regulation at this stage are only presently being defined. Information jurisprudence will be built incrementally, but it will be built on the Constitution we have.

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98. For an introductory discussion of international database legislation, see Marci A. Hamilton, *Database Protection and the Circuitous Route around the United States Constitution*, in INTERNATIONAL INTELLECTUAL PROPERTY AND THE COMMON LAW WORLD 24-30 (Charles E. Rickett & Graeme Austin eds., forthcoming 2000).

## PUBLISHING SOFTWARE AS A SPEECH ACT

By *Lee Tien*<sup>†</sup>

### ABSTRACT

We often talk as though the First Amendment protects things that communicate, like books or pictures. Unsurprisingly, we have trouble deciding whether computer software is “speech”—to non-programmers, it seems more like a tool to be used than a book to be read. I argue that the question isn’t whether something is speech, but whether someone is speaking. First Amendment analysis should focus on speech acts, not on the things we use in those acts. Studying heads won’t tell you whether head-shaking means “no”; the answer lies in our communicative conventions. Some such conventions are widespread, like natural languages; others are specialized, like those of art and science worlds. On this approach, publishing source code generally is a speech act because computer scientists and programmers conventionally intend to communicate ideas about computational procedures by publishing source code. Accordingly, government restrictions on source code publication trigger First Amendment scrutiny.

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## I. INTRODUCTION

Computer programs are fun to write, and well-written computer programs are fun to read. One of life's greatest pleasures can be the composition of a computer program that you know will be a

pleasure for other people to read, and for yourself to read. . . . At first, I thought programming was primarily analogous to musical composition—to the creation of intricate patterns, which are meant to be performed. But lately I have come to realize that a far better analogy is available: Programming is best regarded as the process of creating *works of literature*, which are meant to be read.<sup>1</sup>

Daniel J. Bernstein, a math professor, wrote a computer program in source code form<sup>2</sup> as part of his research and wants other professors and programmers, including foreign persons, to read, study and criticize it. If the government won't let him publish<sup>3</sup> without a license, does he have a First Amendment claim? This fact situation was the heart of *Bernstein v. United States Department of Justice*,<sup>4</sup> a case<sup>5</sup> challenging the constitution-

1. DONALD E. KNUTH, *LITERATE PROGRAMMING* ix (1992).

2. Programmers normally write software in high-level programming languages like C; in this form, the software is source code. Source code isn't directly executable by a computer; the software that people buy at computer stores is in a form called object code. "A special program is used to translate the human-readable source code into computer-readable object code. If the program has been written in a high-level language like C, the program is called a compiler." Andrew Johnson-Laird, *Software Reverse Engineering in the Real World*, 19 U. DAYTON L. REV. 843, 859 (1994).

3. By "publish" I mean making a work of expression generally available to the public, whether in a book, a journal article, or on the Internet.

4. 176 F.3d 1132 (9th Cir. 1999) (affirming district court decision that export regulations on encryption items are unconstitutional) [hereinafter *Bernstein IV*], *withdrawn pending en banc reh'g*, 192 F.3d 1308 (9th Cir. 1999), *appeal dismissed without prejudice and remanded*, No. 97-16686 (9th Cir. Apr. 11, 2000). Professor Bernstein wrote his encryption program, named Snuffle, while he was a graduate student in mathematics at the University of California at Berkeley. For further background, see *Bernstein v. United States Dep't of State*, 974 F. Supp. 1288 (N.D. Cal. 1997) [hereinafter *Bernstein III*]; *Bernstein v. United States Dep't of State*, 945 F. Supp. 1279 (N.D. Cal. 1996) [hereinafter *Bernstein II*]; *Bernstein v. United States Dep't of State*, 922 F. Supp. 1426 (N.D. Cal. 1996) [hereinafter *Bernstein I*]. *Bernstein I* and *Bernstein II* challenged the encryption export control provisions of the International Traffic in Arms Regulations ("ITAR"), promulgated under the Arms Export Control Act, Pub. L. No. 90-629, 82 Stat. 1320 (codified as amended in scattered sections of 22 U.S.C. (1994)). After *Bernstein II*, the President shifted licensing authority for encryption exports to the Commerce Department. See Executive Order No. 13,026, 61 Fed. Reg. 58,767 (1996); 61 Fed. Reg. 68,572 (1996). In *Bernstein III*, the district court held the Commerce Department's encryption Export Administration Regulations ("EAR"), which were constitutionally indistinguishable from the ITAR with respect to encryption, unconstitutional. On January 14, 2000, the Commerce Department promulgated a new version of the encryption EAR, which is beyond the scope of this Article. On April 11, 2000, the Ninth Circuit remanded the case to the district court for consideration in light of the new regulations.

5. Roughly the same issues were presented in two other cases in two other circuits. See *Junger v. Daley*, 8 F. Supp. 2d 708 (N.D. Ohio 1998) (finding export regulations con-

ality of export controls on the dissemination of encryption source code<sup>6</sup> as a violation of the First Amendment's standards for pre-publication licensing schemes.<sup>7</sup> Indeed, Professor Bernstein in part intended the creation and publication of his source code as political criticism of the encryption export regulations.<sup>8</sup>

In most First Amendment cases, someone's right to speak is obviously at stake, and the question is whether the government meets its burden under the appropriate test. But in Bernstein's case, the government claims that "speech" isn't at issue, and the question is whether the First Amendment even "is brought into play."<sup>9</sup> The former cases present questions of

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stitutional), *rev'd and remanded*, No. 98-4045, 2000 U.S. App. LEXIS 6161 (6th Cir. Apr. 4, 2000); *Karn v. United States Dep't of State*, 925 F.Supp. 1 (D.D.C. 1996), *re-manded*, 107 F.3d 923 (D.C. Cir. 1997). For a discussion of the various cases, see generally Thinh Nguyen, Note, *Cryptography, Export Controls, and the First Amendment in Bernstein v. United States Department of State*, 10 HARV. J.L. & TECH. 667 (1997) (focusing on *Bernstein*); Laura M. Pilkington, Comment, *First and Fifth Amendment Challenges to Export Controls on Encryption: Bernstein and Karn*, 37 SANTA CLARA L. REV. 159 (1996); Daniel R. Rua, Comment, *Cryptobabble: How Encryption Export Disputes Are Shaping Free Speech for the New Millennium*, 24 N.C. J. INT'L L. & COM. REG. 125 (1998). As this Article went to press, the Sixth Circuit held that source code, "though unintelligible to many," is protected by the First Amendment because it "is the preferred method of communication among computer programmers" and "is an expressive means for the exchange of information and ideas about computer programming." *Junger v. Daley*, No. 98-4045, 2000 U.S. App. LEXIS 6161, at \*10 (6th Cir. Apr. 4, 2000).

6. For a detailed discussion of the regulations, see Rua, *supra* note 5, 139-44.

7. The Supreme Court evaluates administrative pre-publication licensing schemes as a form of prior restraint under the First Amendment. See, e.g., *FW/PBS, Inc. v. City of Dallas*, 493 U.S. 215 (1990) (holding a licensing provision unconstitutional under the First Amendment for lack of procedural safeguards); *City of Lakewood v. Plain Dealer Publ'g Co.*, 486 U.S. 750, 759 (1988) (holding newsrack licensing scheme facially unconstitutional because mayor had too much discretion); *Freedman v. Maryland*, 380 U.S. 51, 58-60 (1965) (finding movie licensing scheme aimed at screening out obscene movies unconstitutional because licensor had too much discretion); *Lovell v. Griffin*, 303 U.S. 444, 447 (1938) (reversing conviction of Jehovah's Witness for distributing pamphlets in violation of ordinance requiring permit prior to distributing "literature of any kind").

8. The export regulations controlled encryption programs, but not one-way hash functions. Thus, many one-way hash functions were publicly available. As a mathematical matter, however, one-way hash functions can be used to encrypt, and Professor Bernstein's Snuffle program was written to do precisely that. He thus sought to demonstrate that the regulatory distinction between encryption software and one-way hash functions was "absurd." See *Bernstein IV*, 176 F.3d at 1141 n.14 ("Snuffle was intended, in part, as political expression"); *id.* at 1135-1136 n.1 (explaining "hash function").

9. Robert Post, *Recuperating First Amendment Doctrine*, 47 STAN. L. REV. 1249, 1250 (1995).

protection; the latter, of coverage.<sup>10</sup> And we usually ask coverage questions in the form, is that “speech”?

Is software “speech”? It should be obvious that it is. A computer program states or represents a procedure or algorithm in a programming language.<sup>11</sup> The same algorithm could be written in a natural language like English or a programming language like C or LISP, but it remains the same algorithm. For years, computer scientists and programmers have published both algorithms and source code in computer science books and textbooks, academic journals, and popular computing magazines.<sup>12</sup> And computer scientists and programmers read source code just as economists and mathematicians read equations in their fields.<sup>13</sup> To publish source code is therefore to perform a linguistic act that has meaning to computer scientists and programmers. Indeed, one would think that publishing source code fits perfectly within the general category of “scientific speech”<sup>14</sup> and, for Bernstein, within “academic freedom.”<sup>15</sup>

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10. See, e.g., Frederick Schauer, *Categories and the First Amendment: A Play in Three Acts*, 34 VAND. L. REV. 265, 267-68 (1981).

11. See DONALD KNUTH, *SELECTED PAPERS IN COMPUTER SCIENCE 2* (1996).

12. See, e.g., LAURENT SIKLOSSY, *LET'S TALK LISP* (1976) (containing functions written in LISP programming language); MIT Press, *Complete Code from SICP Second Edition*, (<http://mitpress.mit.edu/sicp/code/index.html>) (visited April 9, 2000) (listing sections of code from the influential book, HAROLD ABELSON ET AL., *STRUCTURE AND INTERPRETATION OF COMPUTER PROGRAMS* (1984)).

13. I focus on source code, the conventional form in which software is published for study and criticism. See *Bernstein IV*, 176 F.3d at 1141. But programmers also can and do read object code. See Anthony L. Clapes, *Confessions of an Amicus Curiae: Technophobia, Law, and Creativity in the Digital Arts*, 19 DAYTON L. REV. 903, 941 (1994). As a practical matter, distinguishing source code from object code for First Amendment purposes appears largely pointless. One need merely compile source code to produce object code, so publishing source code effectively makes the object code available as well. It's therefore hard to see how any government interest would likely be furthered by regulating the publication of object code when the source code can be published.

14. I assume that acts like publishing an article in *Scientific American* are “high-value speech” covered and protected by the First Amendment. See Roy Spece, Jr. & Jennifer Weinzierl, *First Amendment Protection of Experimentation: A Critical Review and Tentative Synthesis/Reconstruction of the Literature*, 8 S. CAL. INTERDIS. L.J. 185, 187 (1998). But see Gary L. Francione, *Experimentation and the Marketplace Theory of the First Amendment*, 136 U. PA. L. REV. 417 (1987) (noting that noncommunicative experimentation may be regulated on rational basis test if government does not intend to suppress communication).

15. Academic freedom is “a special concern of the First Amendment.” *Keyishian v. Board of Regents*, 385 U.S. 589, 603 (1967). See also *Sweezy v. New Hampshire*, 354 U.S. 234, 250 (1957) (noting that “[t]eachers and students must always remain free to inquire, to study and to evaluate, to gain new maturity and understanding”).

My general point is that if we're trying to decide whether the First Amendment covers Bernstein's publishing his software, the query "is software speech?" is the wrong question. It's an ontological category-mistake, like trying to decide whether a plaster sculpture is covered by the First Amendment by asking, "are plaster objects speech?"<sup>16</sup> or whether parades are covered by asking, "is walking speech?"<sup>17</sup> These questions view speech as a work, a thing, and they lead us to ask if that thing qualifies as speech: does it have meaning, or is it functional? But things without meaning can be used communicatively. Walking is often quite functional—it gets you from here to there. Walking with a certain intent, however, is parading, and in that case the walker is speaking.

Thus, we should instead ask, "is Bernstein speaking?" This latter question focuses on the putative speaker's act as an act, and thus his intent. If a programmer publishes software in order to communicate its meaning or propositional content to others, then the programmer's act is done with the illocutionary force of asserting that meaning—and he is performing a speech act.<sup>18</sup> It's not irrelevant that software has meaning. But what really matters for First Amendment analysis isn't merely the meaning of the software, but the illocutionary force of the putative speaker's act.

Furthermore, without recognizing the variable of illocutionary force, we run the risk of miscategorizing speech acts as perlocutionary acts—acts intended to cause a certain effect. Because people often think of software mainly in terms of its effects, they may think that one who publishes software intends to cause effects. But our speech acts often have effects. A museum that displays nude sculptures and paintings may offend people. Without more, however, we would not characterize the museum as intending to offend anyone.

I contend that the First Amendment covers speech acts, and the nature of a thing has no logical bearing on whether what one does with it is a

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16. Even though a plaster bust of Martin Luther King, Jr. is "speech," that doesn't mean that distributing the sculpture can't be regulated. *Cf.* *Martin Luther King, Jr., Center for Social Change, Inc. v. American Heritage Products, Inc.*, 296 S.E.2d 697 (1982) (King estate wins right of publicity case against sculpture distributor).

17. Which isn't what the Supreme Court asks. *See* *Hurley v. Irish-American Gay, Lesbian and Bisexual Group of Boston*, 515 U.S. 557, 568 (1995).

18. For other applications of speech-act theory to First Amendment law, see Peter Tiersma, *Nonverbal Communication and the Freedom of "Speech,"* 1993 WIS. L. REV. 1525 (1993); Lawrence Solum, *Freedom of Communicative Action: A Theory of the First Amendment Freedom of Speech*, 83 NW. U. L. REV. 54 (1989) (relying on Jürgen Habermas's theory of communicative action); Kent Greenawalt, *Speech and Crime*, 1980 AM. B. FOUND. J. 645. I don't use "speech acts" to denote what the Court has called "verbal acts." *See* *Gompers v. Bucks Stove & Range Co.*, 221 U.S. 418, 439 (1911).

speech act. The crucial issue as to whether an act is a speech act is the speaker's intent in relation to social practices or conventions.<sup>19</sup> For First Amendment purposes, "social conventions" refers not only to practices of the community as a whole, but also to those of subcommunities, particularly "speech subcommunities" like art, music, and scientific worlds.<sup>20</sup> Thus, I'm mainly concerned with First Amendment coverage as a methodological issue, and I'll use software as the vehicle for my argument. Moreover, for the remainder of this piece I will make use of a hypothetical programmer, Alice, so that we may focus on the methodological issue without being distracted by the particularized facts of the *Bernstein* case.

Accordingly, the software cases raise two main issues for First Amendment analysis. The coverage question asks whether "uttering" software is a speech act. Alice's case is a clear instance of seeking to publish software for expository purposes. Thus, when Alice publishes source code, intending it to be read by members of the scientific community, such that by the community's conventions it is publishing, she performs the speech act of scientific publishing—which is covered by the First Amendment.

Second, to the extent that the Court speaks of speech in terms of acts, it focuses on speech acts as propositional acts or perlocutionary acts, but not as illocutionary acts. In so doing, the Court leads us to think of speaker's intent in relation to meaning or effects, but not in relation to illocutionary force. Although protection isn't my main concern, my argument implies that it should be analyzed using the general conceptual apparatus for evaluating acts.<sup>21</sup> The issues raised by software publication are like those raised by conspiracy or aiding and abetting.<sup>22</sup> There's no doubt

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19. Cf. Post, *supra* note 9, at 1254; Robert Post, *Community and the First Amendment*, 29 ARIZ. ST. L. J. 473, 481 (1997) ("Within the realm of discourse, one might say, there is not merely a marketplace of ideas; there is also a marketplace of communities."); Robert Post, *Reply to Bender*, 29 ARIZ. ST. L.J. 495 (1997).

20. Thus, sculpture is "speech" because "doing art" is a recognized speech practice, and "doing" sculpture is a way of doing art. Whether one uses oils on canvas or plaster is irrelevant. What matters is that one is "doing art," in terms of art practices and conventions. See generally HOWARD BECKER, *ART WORLDS* (1982). For a similar argument, see Joshua Waldman, Note, *Symbolic Speech and Social Meaning*, 97 COLUM. L. REV. 1844 (1997) (courts analyze expressiveness of conduct in terms of traditional social meaning of conduct's categories).

21. I assume that the central justification for regulating speech acts is the harm they might cause, and I therefore will not discuss any First Amendment theory of what harms count.

22. In those situations, it's usually said that while agreeing to participate or assist in doing an unlawful act is usually accomplished through "speech," the larger course of

that the actor is speaking, but he might “also” or “really” be doing something else. The issue therefore becomes how the law should treat behavior that can be viewed as both a speech and a non-speech act. To answer this question, then, we must identify the conditions for coverage of speech acts rather than speech works, and distinguish issues of coverage from issues of protection. Crucially, Alice’s act of publishing her software in itself causes no harm. The fear is that others may use her software to cause harm. The risk of harm is difficult to distinguish from that associated with the publication of many kinds of information.

In short, there’s nothing special about software for purposes of First Amendment coverage. The First Amendment need not be “extended” for software to be covered as “speech.” The debate over software publication merely forces us to face the logical defects associated with thinking of the First Amendment in terms of speech rather than speaking. Speech doesn’t “do” or “say” anything; people do. And hearers did things with what speakers said long before there were computers or software.

## II. THE FIRST AMENDMENT COVERS SPEECH ACTS

Whether something is “speech” matters to First Amendment jurisprudence because we believe we must justify special protection for speech. There have been many attempts to justify First Amendment coverage in terms of a free speech principle.<sup>23</sup> Our “standard list of candidates” derives from the various theories of free speech: the pursuit of truth, self-governance, the “checking value” of free speech, and so on.<sup>24</sup> But there seems to be no discernible general principle here, for these various theories don’t cohere particularly well.<sup>25</sup> And the most general candidate for a free speech principle—individual self-realization—doesn’t seem to distinguish speaking from other human activity. The Court, however, hasn’t seemed to need such a theory to decide coverage issues. While many consider the Court’s coverage doctrine to be incoherent, it can be harmonized without appealing to a grand theoretical framework of First Amendment values.

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conduct in which that speech is integrated overrides any potential First Amendment applicability.

23. Frederick Schauer’s is the most comprehensive. *See generally* Schauer, *supra* note 10.

24. *See Post, supra* note 9, at 1271.

25. *See id.*

We know that the First Amendment protects “the freedom of speech.”<sup>26</sup> I suggest that we need not appeal to any deep-seated concept of First Amendment values in order to decide coverage questions. Instead, coverage issues primarily raise practical problems about whether someone is speaking.<sup>27</sup> First, we have some general theoretical principles about communication, and publishing source code fits those principles. Second, those principles can’t resolve coverage questions by themselves. The coverage of the First Amendment has changed and will change over time. The most we can hope for is a principled set of meta-criteria to use in deciding coverage issues, which can be found in our speech practices. In short, for coverage purposes we don’t need a better theory of why we protect speech; we need a better theory of speaking.

Speech act theory provides us with such meta-criteria. Under this theory, the critical question for coverage purposes is whether the act at issue is an act of communication,<sup>28</sup> and speech act theory assists in the analysis by formalizing the notion of communication in terms of meaning, intent, and conventions. For an utterance to qualify as a *speech act*, the speaker must intend to produce understanding in the hearer by resort to or in virtue of the social context, or conventional meaning, of what the speaker says.<sup>29</sup> Both the intent and social context aspects are necessary to transform an utterance into a speech act. Thus, this definition roughly excludes acts for which the speaker does not intend to produce understanding, or for which the meaning arises without reference to conventions.

In this Part, I begin by defining the basic concepts of speech act theory, and relate them back to the act of publishing software. Once these concepts of speech act theory are established, I apply them to reframe and explain the *Spence* Court’s “expressive conduct” test, which establishes the boundary between conduct that communicates, and unprotected, uncommunicative acts, in First Amendment jurisprudence.

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26. U.S. CONST. amend. I; see Melville Nimmer, *The Meaning of Symbolic Speech Under the First Amendment*, 21 U.C.L.A. L. REV. 29, 36 (1973). He was guided by speech-act theory. See *id.* at 36 n.33.

27. The critic may argue that I’ve substituted for “values” a particular definition of “speaking,” probably a fair point. But my constraints are based on “speech acts” as normative social phenomena, not on a full-blown theory about First Amendment values. Put another way, I begin with communication and then freedom of speech, not the other way around.

28. See, e.g., Nimmer, *supra* note 26, at 36.

29. Cf. *id.* at 37 (“symbolic speech requires not merely that given conduct results in a meaning effect, but that the actor causing such conduct must intend such a meaning effect by his conduct”).

## A. Definition of Speech Acts

Anything can, in principle, be “speech.” That an object is made of metal, uses electricity, or whatever, does not disqualify it from being “speech”; any thing can be “speech” in the right circumstances because we might have a practice of using the thing that way.<sup>30</sup> Rather, coverage under the First Amendment is a merely a function of intent to communicate.<sup>31</sup> But the intention that matters isn’t merely the speaker’s or the hearer’s, or even both. It is a complex function that includes “social context.”<sup>32</sup> Two key components of social context are relevant to intention in coverage analysis: conventional social practices like language, and specific practices of what I call speech subcommunities, like art, music, and science worlds.

I argue that we must analyze coverage issues by looking at the “total speech act in the total situation.”<sup>33</sup> This approach permits us to make all the distinctions we need to understand how Alice’s act of publishing her software can be covered by the First Amendment even though other acts done with software might not be, the same way that not every act performed with respect to a flag is covered.<sup>34</sup> Or, to formalize this analysis within speech act terminology I claim that the First Amendment covers illocutionary acts,<sup>35</sup> which are acts that conform to certain community conventions.<sup>36</sup> To perform an illocutionary act, the speaker must intend to communicate the propositional content<sup>37</sup> of his utterance act,<sup>38</sup> and this

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30. Later I’ll explain what I think is necessary for it to be the case that we do, in fact, have such a practice. *See infra* text accompanying notes 55-92.

31. *Cf.* Waldman, *supra* note 20, at 1851 (arguing that while courts have focused on the actor’s actual intent as the primary element of the *Spence* test, its relevance is minimized by the second element, audience-understanding). An important caveat here is that my analysis is directed to particular speech acts, in theory. I’m not suggesting that courts should or need to do coverage analysis in every case by asking whether the particular actor intended to communicate, any more than courts should or need to ask whether the particular utterance at issue “really” meant what it means in the relevant language. Most of the time, it is clear in the total situation that both utterance meaning or a meaning-substitute and speaker’s intent exist, because of the operative background conventions.

32. *Post*, *supra* note 9, at 1252.

33. J. L. AUSTIN, *HOW TO DO THINGS WITH WORDS* 147 (1962).

34. *See Texas v. Johnson*, 491 U.S. 397, 405 (1989).

35. Illocutionary act is the term given to a complete speech act. *See* JOHN R. SEARLE, *SPEECH ACTS* 23 (1969).

36. *See* AUSTIN, *supra* note 33, at 105.

37. Propositional content corresponds to the meaning of the utterance, what it refers to or predicates. *See* SEARLE, *supra* note 35, at 23-24.

38. Illocutionary acts should be distinguished from perlocutionary acts, which are defined by the effect they have on the listener. *See* AUSTIN, *supra* note 33, at 102.

content must be communicated in a way that conforms to the language conventions of the community to which the speaker addresses the speech act.<sup>39</sup> Borrowing heavily from philosophers Austin and Searle,<sup>40</sup> in this Part I will set out the basic definition of a speech act, which includes an utterance and propositional act, intent to communicate, and a relevant speech community or convention within which the communication occurs.

### 1. *Utterance Acts and Propositional Meaning*

A physical utterance act is the first and most basic component of a speech act. It consists of the physical components of speech: producing sounds, marks on a page, or marching in a parade.<sup>41</sup> Alice performs an utterance act by typing her source code into a computer, or uploading it onto the Internet. But what we utter or say, according to Austin, are not necessarily themselves speech acts. A sentence “is used in making a statement, and the statement itself is a ‘logical construction’ out of the makings of statements.”<sup>42</sup> Thus, without more, an utterance act does not necessarily become a speech act—but a speech act necessarily includes an utterance act.

Searle, in turn, refined and extended Austin’s insights regarding speech acts; neither words nor sentences express propositions, he argued, but rather “in the *utterance* of the sentence, the speaker expresses a proposition.”<sup>43</sup> So if the utterance act is to be a speech act, according to Searle, it must also contain some propositional content. That is, the spoken words or physical actions must have some meaning. For example, Alice can write software expressing a certain algorithm or mathematical procedure. The propositional content would consist of that concept. The utterance act, together with its propositional meaning, constitutes a propositional act.<sup>44</sup>

### 2. *Intent and Illocutionary Force*

Given a propositional act, the question becomes, “[h]ow . . . do we get from physics to semantics?”<sup>45</sup> In other words, when does an utterance act

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39. See SEARLE, *supra* note 35, at 23.

40. For the interested reader, Austin describes speech act theory in AUSTIN, *supra* note 33. Searle refined and extended Austin’s insights in a general theory within which descriptive or representative uses of language are merely one class of speech act. See generally JOHN R. SEARLE, INTENTIONALITY (1983); JOHN R. SEARLE, EXPRESSION AND MEANING (1985); SEARLE, *supra* note 35.

41. See SEARLE, *supra* note 35, at 24.

42. AUSTIN, *supra* note 33, at 1 n.1.

43. SEARLE, *supra* note 35, at 29 (emphasis added).

44. See *id.* at 23-24.

45. SEARLE, INTENTIONALITY, *supra* note 40, at 161.

with propositional meaning become a speech act? The general answer is that intentions bridge the gap. Searle explained that the speaker's intent to perform a speech act transforms an utterance act—like making noise—into a speech act.<sup>46</sup> Thus, Alice's act of uploading her software can only be a speech act if she publishes with the requisite intent.

The intention that makes an act a speech act isn't simply the speaker's intent to express an idea *qua O'Brien*,<sup>47</sup> which only corresponds to the propositional act. In *O'Brien*, the defendant burned his draft card to demonstrate his antiwar beliefs.<sup>48</sup> He thus performed an utterance act of burning his draft card, which had antiwar propositional meaning to him. In general, a speaker's saying something and meaning it is closely connected with intending to produce the hearer's understanding. Also, understanding an utterance act is closely connected to whether the listener recognizes the speaker's intention. And because a speech act is always an illocutionary act, the relevant intent includes illocutionary intent. What's expressed in my saying "Hello" to you isn't merely that "Hello" is a greeting, but also that I am greeting you.

When I perform the speech act of saying "Hello," I have some intent, and I've been saying that this intent is crucial. But what is that intent? We can imagine situations where my saying "Hello" is not used to greet. I might be a non-native English speaker practicing the pronunciation of a useful word. Or I might be practicing a line in a play. In neither case do I utter "Hello" with the intent to greet anyone.

There's a double level of "intentionality" to illocutionary acts. One has an attitude or mental state expressed *in* the performance of the act and also an intent *to* perform it. When I say "It's raining," an assertive, I express the belief that it is raining and perform the intentional act of asserting that it is raining. When I say "I promise to mow the lawn," a commissive, I express the intent to mow the lawn and perform the intentional act of promising to mow the lawn. My saying "Hello," an expressive, is my performing an illocutionary act of greeting. I express an intent in what I say, an intent to greet you. I also perform an intentional act of greeting, I intentionally greet you.

These two intents aren't the same. I might not sincerely mean what I seem to mean. I might just want to conform to social nicety. But whether I really mean it or not, I intentionally perform the act of asserting a fact, of promising, or of greeting you. Searle labels these double levels of intent

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46. *See id.* at 163.

47. *United States v. O'Brien*, 391 U.S. 367 (1968).

48. *See id.* at 369-70.

the “sincerity condition” and the “meaning intention”—respectively, “the psychological state expressed in the performance of the act” and “the intention with which the act is performed which makes it the act that it is.”<sup>49</sup> Threats are a good example. A threat is a serious expression of intent to cause significant harm. Expressing an intent to cause you harm corresponds to the sincerity condition, because whether or not I really intend to cause you harm, I express that intent; seriousness of expression corresponds to meaning intention, whether I intend for you to take my words or conduct as a threat.<sup>50</sup>

Meaning intentions, in turn, have two aspects: the intention to represent and the intention to communicate.<sup>51</sup> As with the sincerity condition and meaning intention, these two intentions aren’t the same. In the genuine case of saying “It’s raining,” I intend to represent that it’s raining. But I might also want to communicate that I don’t want to walk the dog. The representing intention is prior to the communication intention; “[o]ne can intend to represent without intending to communicate, but one cannot intend to communicate without intending to represent.”<sup>52</sup>

On this analysis, “[t]he communication intention consists simply in the intention that the hearer should recognize that the act was performed with the representation intention.”<sup>53</sup> Thus, when I say “it’s raining,” I mean

49. SEARLE, *INTENTIONALITY*, *supra* note 40, at 164.

50. On this approach, insincerity doesn’t directly affect the status of an utterance as a threat. I may not really mean you harm. What matters is whether you fairly take what I say as a threat. A practical joke threat is still a threat because the practical joker intends that the victim take it as a threat—the practical joker’s intention is not satisfied if the victim takes it as a joke. In addition, the category of “true threat” generally is defined by reference to perlocutionary effects, like getting someone to do or not do something, and usually the threatener intends to produce that perlocutionary effect. Thus a threat is usually also a perlocutionary act.

51. See SEARLE, *INTENTIONALITY*, *supra* note 40, at 165 (“Characteristically a man who makes a statement both intends to represent some fact or state of affairs and intends to communicate this representation to his hearers.”). The same analysis applies to speech acts that aren’t assertives, although here we wouldn’t speak of intent to represent but rather the correlative illocutionary intent.

52. *Id.* at 166. Thus, I can make a statement about how things are with varying communication intentions, even though in every case I’ll have the same representing intention. I might intend that a hearer believe my statement or I might not. Indeed, I might not even really intend that a hearer understand me; I might be indifferent to the possibility. I might be a salesperson uttering legalese about warranties and disclaimers, or a police officer reading someone his *Miranda* rights. But even though the hearer might not actually understand the legal mumbo-jumbo, and even if the speaker really doesn’t want the hearer to understand it, the speaker doesn’t lack the communication intention the way Searle’s accidental arm-raiser does. The speaker still intends the act as a speech act.

53. SEARLE, *INTENTIONALITY*, *supra* note 40, at 168.

what I say if I said “it’s raining” with the intention that my utterance have conditions of satisfaction—that it matters to my saying it (which isn’t the same as it mattering to me) whether it really is raining. If I’m just practicing saying “it’s raining,” it’s irrelevant whether it’s raining.

With regard to the speaker’s intent, we should always ask whether it matters to the speaker’s statement that the hearer grasp the illocutionary force. I perform an act of asking you do to something only if it matters to my uttering the request that you understand that I am trying to get you to do it. The illocutionary force in this case is the status of the utterance as “asking,” as opposed to “informing” or “promising,” and my intent is communicated if you have understood that I was asking you a question. This intent is objective, not subjective.<sup>54</sup> It turns on an objective interpretation of the act in light of the circumstances in which it is made.

### 3. *Social Conventions and Community*

If I issue sounds or make marks, what matters is that I intend the sounds or marks to be a speech act. But this intention must have a certain structure and content. While anything can be used to communicate, what is distinctive about speech acts is that they are conventional, in the sense that language is a set of social conventions. One must intend to use conventions, and intend that the hearer understand in virtue of his or her understanding those conventions. In Alice’s case, the conventions that matter are those within her particular community: the world of computer scientists and mathematicians.

Earlier, I focused on meaning and intent. I mostly used examples of linguistic acts, because we presume that actors performing such acts intend to communicate, and because such acts have utterance meaning by virtue of their being in a language. But I’ve also claimed that anything can be “speech,” because anything can be used to communicate. Thus, communication can include nonlinguistic conduct like flag burning that we presume is intended to communicate and is generally perceived as having utterance meaning. At this point the skeptic may ask, does language matter at all?

Language does matter. The relationship of speech acts to language, however, is not that speech acts must be in a language, but rather that language constitutes a system of conventions that permits speakers to perform

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54. As Tiersma argues, a “joking” offer is usually still an offer because the point of the joke turns on the offeree’s believing that the offer is real. Only when under the circumstances it couldn’t reasonably be believed that the offer is real does the joking offer not count as an offer. See Peter Meijes Tiersma, Comment, *The Language of Offer and Acceptance: Speech Acts and the Question of Intent*, 74 CALIF. L. REV. 189, 227 (1986).

otherwise purely physical acts like uttering sounds that hearers understand in virtue of their knowing those conventions. But because language is not the only system of conventions that makes intersubjective utterance meaning possible, nonlinguistic acts can also be speech acts. Symbolic speech is usually conventional in a language-like way. This is easiest to see with objects that have social meaning, like flags. Flying such flags in certain ways expresses something. They are referents that can be used in speech acts. Indeed, we should think of the meaning relevant to coverage issues in terms of “meaning by convention” or “conventional meaning.”<sup>55</sup>

Language is not merely useful; it is a critical part of what makes a community a community. Languages provide sets of conventions, regular ways of expressing and communicating thoughts and ideas shared by a group of speakers.<sup>56</sup> Language is by nature a shared or community phenomenon that separates the idiosyncratic from the public. The First Amendment strengthens communities by protecting speaking to a speaker’s intended audience.<sup>57</sup> A common language makes speech to an audience possible; indeed, one may say that it defines the audience, and vice versa. Speaker and audience, sharing a common language, can speak to one another. To belong to a community is to speak its language, in a strong sense.<sup>58</sup>

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55. See Tiersma, *supra* note 18, at 1557-58; Waldman, *supra* note 20, at 1864-67. There will always be borderline or contested cases. I don’t put too much weight on how widely a convention is accepted. When the American colonists dumped tea into Boston Harbor as an act of protest against British taxes, that was clearly a speech act, even if there had never been a prior act of protesting by means of dumping tea (damaging property has long been a means of protest, I assume). My general claim is that what is important about language is that it is conventional, and as such language is only one of many systems of conventions that can supply the needed conventionality.

56. See David Lewis, *Languages and Language*, in 1 PHILOSOPHICAL PAPERS 164-66 (1983).

57. See *Dambrot v. Central Michigan University*, 55 F.3d 1177, 1188 (6th Cir. 1995) (“The purpose of the free speech clause . . . is to protect the market in ideas, broadly understood as the public expression of ideas . . . to an audience whom the speaker seeks to inform, edify, or entertain.”).

58. The philosopher Charles Taylor realized that communities themselves are largely defined by a shared language convention. See CHARLES TAYLOR, *HUMAN AGENCY AND LANGUAGE* 234 (1985). Taylor explains that

[i]f language must be primarily seen as an activity . . . then it becomes relevant to note that the primary locus of speech is in conversation. Men speak together, to each other. Language is fashioned and grows not principally in monologue, but in dialogue, or better, in the life of the speech community. . . . The language I speak . . . can never be just *my* language, it is always largely *our* language. . . . [I]t is not just the

It is also crucial to recognize that various subcommunities, such as those in the artistic or scientific world, may have their own, legitimate and particularized language conventions. Just as language, as a system of conventions, is constitutive of community in general, these subcommunities are constituted by their conventions.<sup>59</sup> Accordingly, the conventions and social practices that breathe life into the intent and meaning of speech acts must also include those of subcommunities.<sup>60</sup> Courts should defer to the conventional practices of speech subcommunities in defining speech acts.<sup>61</sup>

We've been asking whether Alice performs a speech act by publishing her computer program, or in thing-mode, whether her computer program "is speech," if not everyone takes it that way. Professor Post argues that social context is a large part of what makes something speech.<sup>62</sup> And one part of social context is our shared conventions. Thus, as Professor Post notes, the artist Marcel Duchamp's famous readymade sculpture, *The Fountain*, which is simply a urinal, is speech because the shared conventions of the art world, as expressed by the medium of an art exhibit, made it so.<sup>63</sup> In referring to conventions surrounding art exhibitions, shared by artists and spectators, Professor Post implies that the relevant conventions need not be shared by the larger world of which the art world is a part. The

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speech community which shapes and creates language, but language which constitutes and shapes the speech community.

*Id.*

59. Such conventions include traditions. For discussion of the role of tradition in musical worlds (in the context of a very different kind of argument), see generally Sanford Levinson & J.M. Balkin, *Law, Music, and Other Performing Arts*, 139 U. PA. L. REV. 1597 (1991) [hereinafter Levinson & Balkin, *Law, Music*]; J.M. Balkin & Sanford Levinson, *Hermeneutic: Interpreting Law and Music: Performance Notes on "The Banjo Serenader" and "The Lying Crowd of Jews,"* 20 CARDOZO L. REV. 1513 (1999) [hereinafter Balkin & Levinson, *Hermeneutic*].

60. Thus, Balkin and Levinson claim that the issue of musical authenticity isn't about the performer's relationship to the text or score, but "to other people . . . to some form of community, whether past or present," or "the authority of a tradition or a culture and, hence, to their embodiment in some community." Balkin & Levinson, *Hermeneutic*, *supra* note 59, at 1544.

61. Most people, I think, do not really doubt that when Alice writes and publishes her program, she is genuinely engaging in First Amendment activity from at least one perspective, that of "science." What computer scientists or engineers do is like what mathematicians or physicists do. So I'll assume, for now, that at some level of abstraction Alice's actions are covered by the First Amendment as much as scientific research and publication in general. This doesn't eliminate act-characterization questions that are generic to the First Amendment status of "science," of course.

62. See Post, *supra* note 9, at 1253-54.

63. See *id.*

parallel argument for Alice is that the shared conventions of the scientific world, especially the world of computer programming, make her publishing her software a speech act.

Why and how should courts deciding First Amendment cases accept or defer to the art world or any other kind of world? Questioning what “art” is, is intrinsic to the art world in our society, and arguably in any society that recognizes art as a status or label that matters to resource allocation.<sup>64</sup> Like the courts attempting to decide coverage issues, non-artists often ask, “what is art?,” or “what makes this work ‘art’?” But those inside the art world ask the same question.<sup>65</sup> An important part of the art world in our society is a questioning, abstract or concrete, of its own activity. Aestheticians and philosophers ask, “what is art?” artists claim that their works are “art” in a way that challenges the critics. Thus, artists and aestheticians engage in a dialogue over what “art” is.<sup>66</sup>

Art worlds provide judges with a more-or-less external and relatively objective criterion for defining what constitutes “art.” As an empirical matter, the aesthetics and practices of a world provide an invaluable source of judgments that courts can use to determine coverage issues. “Art world members characteristically, despite doctrinal and other differences, produce reliable judgments about which artists and works are serious and therefore worthy of attention.”<sup>67</sup> These judgments “stabilize values” and “regularize practice.”<sup>68</sup> As a normative matter, art worlds define art for us, not dispositively but as part of a dialogue between art worlds and the larger society. Artists, critics, aestheticians, gallery owners, and so on, participate in an ongoing dialogue over art and its meaning, not just in discourse but in their everyday activities.<sup>69</sup> Art world judgments help define

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64. The “resources and advantages” at issue in this larger social world include First Amendment coverage and intellectual property protection for art. *See generally* BECKER, *supra* note 20, at 165-91 (discussing art and the state).

65. *See* Balkin & Levinson, *Hermeneutic*, *supra* note 59, at 1541 (“For performers who inhabit an ongoing tradition, the authenticity of performance is assured by living and working within the tradition.”).

66. Becker notes, for example, that Duchamp’s urinal, “whose only claim to being art apparently lay in Duchamp’s signature on them,” “outrage[d] both commonsense and finer sensibilities.” BECKER, *supra* note 20, at 146-47. But after these works “gained great renown in the world of contemporary visual art,” aestheticians developed the “institutional theory” of art to include Duchamp’s work. *Id.*

67. *Id.* at 155.

68. *Id.* at 134; *see also* Balkin & Levinson, *Hermeneutic*, *supra* note 59, at 1545 (“People use the notions of authenticity or fidelity both to define themselves with respect to the practice and to define and regulate the practice.”).

69. Artists often challenge prevailing ideas about art, of course. But this doesn’t diminish the role of aesthetics. As Becker notes: “Among the things [artists] keep in mind

art for the rest of us. It is of great benefit to the First Amendment, and of little or no harm to it, for the law to consider these judgments as having significant authority.

Finally, deference to art worlds is consistent with the First Amendment metavalues of not freezing definitions in time.<sup>70</sup> Institutional processes in art worlds are a locus of change in our larger understandings of art;<sup>71</sup> by looking to subcommunities that have traditionally been central to speech activities, courts preserve flexibility in this essentially contested area.

If art world conventions can breathe constitutional significance into the “medium” of art exhibitions,<sup>72</sup> conventions within the scientific communities can do the same for software. The “scientific method” and other protocols appurtenant to science correspond to the art world’s aesthetics: Scientists use methodology as a standard paradigm or framework to evaluate scientific work. When an author publishes a work according to that convention, she declares it with the illocutionary force of scientific publication. In other words, the published work becomes imbued with the First Amendment coverage of scientific conventions. Therefore, if a person follows the relevant conventions, the government should bear the burden of showing that the conventional illocutionary forces associated with publication are not present in a particular case.

## B. Revisiting Expressive Conduct

The boundary between expressive conduct—conduct that communicates—and unprotected, noncommunicative acts presents special difficulties for First Amendment law. The Court’s difficulties stem from two different mistakes. First, it views speaker’s intent as independent of meaning (or force), and vice versa. But language is fundamentally intersubjective, and my appeal to language and language-like community conventions is

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in making the innumerable small decisions that cumulatively shape the work is whether and how those decisions might be defended. Of course, working artists do not refer every small problem to its most general philosophical grounding to decide how to deal with it, but they know when their decisions run afoul of such theories, if only through a vague sense of something wrong.” BECKER, *supra* note 20, at 133.

70. An “existing aesthetic needs to be kept up to date so that it continues to validate logically what audiences experience as important art work and thus to keep alive and consistent the connection between what has already been validated and what is now being proposed.” BECKER, *supra* note 20, at 138. *Cf.* Post, *Community*, *supra* note 19, at 481 (“For public discourse to provide a site for autonomous decisionmaking, it must itself remain perennially open-ended, perpetually subject to revisional experimentation.”).

71. See generally BECKER, *supra* note 20, at 300-50 (discussing “how art worlds change,” with emphasis on “how changes find an organizational base and thus last”).

72. See Post, *supra* note 9, at 1253.

intended to emphasize that language itself internally connects intent and meaning. Second, to the extent that the Court thinks of speech in terms of acts, it focuses on speech acts as propositional acts or perlocutionary acts, but not as illocutionary acts; if I advocate overthrowing the government, I perform an illocutionary act: advocating a proposition. If I intend to persuade my audience to actually follow through, my act was perlocutionary.<sup>73</sup> The Court accordingly speaks of speaker's intent in relation to the meaning of what is said (the government should be overthrown) or effects (persuading others to overthrow the government), but not in relation to illocutionary force (asserting that the government should be overthrown). This distinction is unimportant for many speech acts. If I mention that someone insulted you, you ask me what he said, and I quote him, you know that I was not insulting you. You would probably say that I did not mean to insult you even though I said the same words. As linguistically competent speakers, we share communicative conventions like reporting or quoting that enable us to grasp illocutionary force as part and parcel of meaning. But this blurring can be problematic when the conventions are not so widely shared.

The Court's approach to expressive conduct can be clarified by incorporation of speech act theory. The following analysis addresses the Court's current doctrinal approach to expressive conduct, and attempts to clarify that approach through application of the principles of speech act theory developed above. Speech act theory provides a more precise and consistent method for determining when particular conduct can be considered an act of communication that should be entitled to the coverage of the First Amendment.

1. *The Court's Stated Approach to Expressive Conduct: The Spence Test*

*Spence v. Washington* presents the archetypal example of expressive conduct protected by the First Amendment. The defendant in *Spence* taped a peace symbol to a United States flag, and hung the flag upside-down from his window as a protest of the Cambodian invasion and the Kent State killings.<sup>74</sup> The state prosecuted him under a flag desecration statute, which the Court held violated the First Amendment as applied to the defendant's communicative act.<sup>75</sup> The case forced the Court to articulate a standard for when expressive conduct should be treated as speech protected under the First Amendment. The Court insisted that the defendant's

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73. See AUSTIN, *supra* note 33, at 101.

74. See *Spence v. Washington*, 418 U.S. 405, 406-08 (1974).

75. See *id.* at 414-15.

conduct be evaluated in light of “the factual context and environment in which it was undertaken. . . .”<sup>76</sup> The *Spence* Court explained that the defendant’s conduct was expressive because “[a]n intent to convey a particularized message was present, and in the surrounding circumstances the likelihood was great that the message would be understood by those who viewed it.”<sup>77</sup>

The Court recently modified the *Spence* test in *Hurley v. Irish-American Gay, Lesbian & Bisexual Group of Boston*,<sup>78</sup> holding that parade organizers’ refusal to include a gay, lesbian and bisexual parade contingent was covered by the First Amendment.<sup>79</sup> The Court characterized parading as a “form of expression” and the parade organizers’ selecting parade contingents as a “presentation of an edited compilation of speech generated by other persons.”<sup>80</sup> The Court admitted that the parade failed to convey a particularized message as required by *Spence*.<sup>81</sup> But it rejected the particularized message requirement of the *Spence* test as inconsistent with well-established protection of a “painting of Jackson Pollock, music of Arnold Schoenberg, or Jabberwocky verse of Lewis Carroll,” all of which it apparently felt conveyed non-particularized messages.<sup>82</sup> After *Hurley*, therefore, a “narrow, succinctly articulable message is not a condition of constitutional protection.”<sup>83</sup>

The major variable in modern First Amendment jurisprudence is “content,” which roughly corresponds to what most people call “meaning.”<sup>84</sup> Unsurprisingly, then, difficulty with the concept of meaning lies at the heart of the Court’s problems. The *Spence* test in particular fails to adequately distinguish the source and content of the speaker’s meaning from the audience’s understanding and reaction. First, the Court seems to believe that every human act has “meaning,” and thus may convey a “message.” For example, in holding in *Dallas v. Stanglin* that social dancing is

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76. *Id.* at 410.

77. *Id.* at 410-11.

78. 515 U.S. 557 (1995).

79. *See id.* at 566.

80. *Id.* at 568, 570.

81. *See id.* at 569.

82. *Id.*

83. *Id.*

84. I’m chiefly concerned with the aspect of meaning known as “sense.” Philosophers distinguish *Sinn* and *Bedeutung*, or sense and reference. Sense denotes, roughly, public meaning, what John Locke called “common acceptation,” how a word is commonly used. When I refer to Julius Caesar, it is publicly established that I mean a specific Roman emperor. *See* IAN HACKING, WHY DOES LANGUAGE MATTER TO PHILOSOPHY? 46-51 (1975).

not speech, the Court noted that “some kernel of expression” can be found in all human activity.<sup>85</sup> This conception of “found meaning”<sup>86</sup> puts us on a misleading path, because it suggests that the meaning of speech is not speaker’s meaning but hearer’s meaning. But if meaning can be “found” in this way, meaning proliferates and the boundaries between protected and unprotected conduct blur.

The Court’s test also unacceptably depends on the notion of audience effects. For example, in belatedly deciding that movies are speech, the Court noted that they “may affect public attitudes and behavior in a variety of ways, ranging from direct espousal of a political or social doctrine to the subtle shaping of thought which characterizes all artistic expression.”<sup>87</sup> Here, the Court seems to suggest that meaning can consist in some vague notion of “audience effects.” The notion of audience effects may be useful for handling speech acts with no ascertainable meaning, like displaying and performing works of art or music. But like “found meaning,” “audience effects” doesn’t usefully constrain the range of meaningful acts. Such meaning could be found in natural phenomena like eclipses and earthquakes.<sup>88</sup> Because meaning can be found in all human acts under the Court’s conception, and can consist of subtle effects on audiences, it isn’t a sufficient boundary criterion. The Court must still define which meaningful acts count and which don’t.

The Court has tried to solve the incorrigibility of meaning by using the variable of intent. But it seems clear that the notion of intent articulated in *O’Brien*, that “the person engaging in the conduct intends thereby to express an idea,” has not solved the problem that any act could be so intended.<sup>89</sup> An “apparently limitless variety of conduct can be labeled

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85. *Dallas v. Stanglin*, 490 U.S. 19, 25 (1989).

86. See Lawrence Alexander & Paul Horton, *The Impossibility of a Free Speech Principle*, 78 NW. U. L. REV. 1319, 1322 (1984) (“[A]n audience can derive meaning from all sorts of human and natural events.”).

87. *Joseph Burstyn, Inc. v. Wilson*, 343 U.S. 495, 501 (1952) (finding movies covered by the First Amendment and overruling *Mutual Film Corp. v. Industrial Comm’n*, 236 U.S. 230 (1915)). Although the Court didn’t speak of coverage versus protection, it’s clear that its holding went to coverage. See 343 U.S. at 501 (“it is urged that motion pictures do not fall within the First Amendment’s aegis.”).

88. Alexander & Horton, *supra* note 86, at 1330 (criticizing Schauer for implying that “[i]f government forbade [him] to view the Matterhorn in order to prevent him from being awed by it . . . this government regulation would fall within the jurisdiction of his Free Speech Principle”) (footnote omitted).

89. Post, *supra* note 9, at 1252 (“[T]he doctrine is transparently and manifestly false” because “any action can at any time be made communicative in a manner that satisfies the *Spence* test,” like “the racist who commits a violent crime successfully to communicate a message of racial prejudice and hate.”) (footnote omitted).

‘speech’” if speech is defined in terms of the actor’s “intend[ing] thereby to express an idea.”<sup>90</sup> *O’Brien* suggests that only the speaker’s subjective intent is relevant. This approach fails to adequately account for language conventions, which, by forcing the speaker to conform to a language convention the audience will understand, transform a bare propositional act into an act of communication.

We can “find” meaning in any human act and any human act can be intended by the actor to “express” meaning. But “found meaning” turns on observers, effacing the actor, while the latter notion turns on actors, effacing the audience. In the Court’s approach, meaning can be found no matter what the actor intended, and can be intended whether or not others might “find” it.<sup>91</sup> As a result, the variable of intent doesn’t solve the problem of too much meaning.

## 2. *Expressive Conduct as a Speech Act*

The Court has correctly identified meaning, intent and audience understanding as crucial to speaking, but it lacks a theory of how they are connected. Speech act theory can provide such a connection. Under speech act theory, there are three points crucial to performing a speech act. First, the speaker must intend that the hearer grasp illocutionary intent.<sup>92</sup> Second, the meaning that matters is utterance meaning. Third, the actor must intend that the hearer grasp the illocutionary force through the hearer’s knowledge of the conventions that govern meaning and intent, which requires an internal connection between the two.<sup>93</sup>

The first major problem with the Court’s approach is that it treats intent and meaning as disconnected issues. Thus in *O’Brien* it refused to let the speaker’s intent alone define the boundary of speech, while in *Stanglin* it refused to let found meaning alone define speech. And in *Spence* and *Hurley* it attempted to link intent and meaning, but through the device of audience understanding, arguably viewed probabilistically. The Court would be better off defining intent and meaning intersubjectively in the first place.<sup>94</sup> It could define meaning primarily in terms of utterance mean-

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90. *United States v. O’Brien*, 391 U.S. 367, 376 (1968).

91. *But see Waldman*, *supra* note 20, at 1856 (arguing that the Court doesn’t really care about an actor’s actual intent).

92. One practical reason, then, for presuming linguistic acts to be speech acts is that actors who perform linguistic acts are likely to be intending to communicate.

93. Tiersma gives the example of a person who coughs in our presence. We would infer that this person is sick. But the person didn’t speak that fact. *See Tiersma*, *supra* note 18, at 1554.

94. As I’ve already argued, speaker’s intent should be understood as the intent that goes with the illocutionary act. Illocutionary intent is intersubjective because we recog-

ing, which is fundamentally objective and intersubjective. Utterance meaning significantly restricts the range of meanings that a human act can have, and generally confines the proliferation of meaning.

This approach would exclude, for example, the concept of found meaning, which bears no relation to the speaker's intended utterance. Under this approach, the *Stanglin* Court would not need to struggle with the potential for found meaning in recreational dancing. Indeed, the Court's real problem with recreational dancing was intent, not meaning. There was no obvious intent to communicate in *Stanglin*, because the conventions surrounding recreational dancing are quite different from those surrounding other forms of dancing, like classical ballet.<sup>95</sup> In contrast, *Spence* presented a clear case of intent to communicate in a conventional way. The defendant deliberately chose symbols, the United States flag and the peace symbol, which have clear utterance meaning. Moreover, flags are in a sense a medium of expression: Doing things to flags, under certain circumstances, is a conventional way of making political statements.<sup>96</sup> The utterance meaning in *Spence* was therefore relatively clear to the Court.

The Court's second error lies in failing to adequately recognize illocutionary acts and the role of illocutionary force. For First Amendment purposes, the relevant intent is the speaker's intent that the hearer understand the act as a speech act—particularly as an illocutionary act. But the Supreme Court thinks of meaning mainly as propositional content. Without illocutionary force, a speech act is either propositional or perlocutionary, and the speaker can only have propositional or perlocutionary intent.

Going back to Alice may make this clearer. In thing mode, we can recognize that Alice's software has meaning, and that it also has effects. If we think of speaking in terms of acts, but ignore illocutionary force, we

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nize illocutionary force through our knowledge of a common language or shared conventions.

95. There's no inherent reason why recreational dancing couldn't be a kind of speech that lacks a particularized message and instead appeals to a "meaning substitute," as art or music does. But when people dance recreationally, they don't obviously intend to communicate. For many other kinds of dancing, we do recognize intent to communicate. Classical ballet and modern dance are quite conventional. Ceremonial or ritual dancing has communicative intent in a different way, but it is still intended to communicate. The performing arts in general appeal to the subset of convention typically known as "tradition." See generally Balkin & Levinson, *Hermeneutic*, *supra* note 59 (discussing the analogy between law and the performing arts); Waldman, *supra* note 20, at 1876-77 (contrasting views of barroom nude dancing as unlike operatic-type nude dancing or as "part of the 'ancient art' of performance dance" (footnote omitted)).

96. See *Spence v. Washington*, 418 U.S. 405, 410 (1974); *accord Texas v. Johnson*, 491 U.S. 397, 404-05 (1989).

still can't easily distinguish software published for an expository purpose from software published for someone's use. Proper understanding of publishing software as a speech act must consider the speaker's illocutionary intent, especially all the illocutionary forces that go along with genuine scientific publication.

The Court's approach shows us some of what is misguided about asking "is software speech?" Ignoring the illocutionary aspect of speaking drives us to view speech works as disembodied utterances, things in the physical world. We then ask whether that thing—in this case, software—has meaning or effects. And if we believe that most people wouldn't grasp its meaning, we end up thinking that the only or dominant intent is perlocutionary or effect-oriented.

Campaign finance regulation supplies a simple example of the importance of illocutionary force in relation to speaker's intent. Under *Buckley*, "express advocacy" of a clearly identified candidate may be subject to regulation, but not so-called "issue advocacy."<sup>97</sup> Whether speech constitutes express advocacy is to be determined by the words themselves,<sup>98</sup> and the Court even listed some "magic words" that it deemed "express words of advocacy."<sup>99</sup> One may dispute the soundness of this approach, but my point is simply that the Court is following the speech act approach here; these words are seen as linguistic indicators of the force of advocating that people vote for a candidate. Indeed, the Court has expressly referred to express advocacy as a "directive."<sup>100</sup>

A more complex example of the Court's occasional recognition of illocutionary force appears in its Establishment Clause decisions. The Court applies a three-pronged test in such cases; a statute or official practice that touches upon religion is permissible under the Establishment Clause if it has a secular purpose, neither advances nor inhibits religion in its principal or primary effect, and does not foster an excessive entanglement with religion.<sup>101</sup> The Court's inquiry in these cases can amount to asking whether the government's conduct constitutes a certain kind of speech act.

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97. *Buckley v. Valeo*, 424 U.S. 1, 44, 79-80 (1976).

98. *See id.* at 43-44.

99. *Id.* at 44 n.52. Some of these magic words include: "vote for," "elect," "support," "cast your ballot for," "Smith for Congress," "vote against," "defeat," and "reject." *Id.*

100. *FEC v. Massachusetts Citizens for Life, Inc.*, 479 U.S. 238, 249 (1986) (finding that an anti-abortion group's newsletter "provides . . . an explicit directive: vote for these (named) candidates").

101. *See Lemon v. Kurtzman*, 403 U.S. 602, 612-13 (1971) (laying out the three-pronged test).

In assessing the constitutionality of a period of silence for “voluntary prayer or meditation,” for example, the Court noted in *Wallace v. Jaffree* that “whenever the State itself speaks on a religious subject, one of the questions that we must ask is ‘whether the government intends to convey a message of endorsement or disapproval of religion.’”<sup>102</sup> Government may present a religious text with the intent to endorse or disapprove the text’s utterance meaning, or with some other intent that is neutral with respect to the text’s meaning. In speech act terms, the Court looks at the illocutionary force of the government’s actions.

Justice O’Connor’s “endorsement” approach to the three-pronged Establishment Clause test in *Lynch v. Donnelly*<sup>103</sup> is also a clear example of speech act analysis. O’Connor frames her analysis of the “purpose” prong in terms of illocutionary force, specifically whether the speech act is expressive.<sup>104</sup> The effects prong is couched in terms of conventional meaning:

If the audience is large, as it always is when government “speaks” by word or deed, some portion of the audience will inevitably receive a message determined by the “objective” content of the statement, and some portion will inevitably receive the intended message. Examination of both the subjective and the objective components of the message communicated by a government action is therefore necessary to determine whether the action carries a forbidden meaning.<sup>105</sup>

In sum, her approach recognizes that “[t]he meaning of a statement to its audience depends both on the intention of the speaker and on the ‘objective’ meaning of the statement in the community.”<sup>106</sup>

*Allegheny County v. ACLU*<sup>107</sup> may provide the clearest example of all. At issue were two holiday displays located on public property: a crèche on the Grand Staircase of the county courthouse, and a Hanukkah menorah placed near outside the City-County Building.<sup>108</sup> Although there was no clear majority, the opinion stating the judgment of the Court adopted Jus-

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102. *Wallace v. Jaffree*, 472 U.S. 38, 60-61 (1985) (citation omitted). I deliberately ignore here the questions related to “government speech;” my point is simply that the Court has viewed government conduct as a potential speech act.

103. 465 U.S. 668 (1984).

104. *Id.* at 691 (O’Connor, J., concurring).

105. *Id.* at 690.

106. *Id.* at 690.

107. 492 U.S. 573 (1989).

108. *See id.* at 580.

tice O'Connor's analytical framework first articulated in *Lynch*:<sup>109</sup> “[t]he effect of the display depends upon the message that the government’s practice communicates: the question is ‘what viewers may fairly understand to be the purpose of the display,’”<sup>110</sup> i.e., the government’s illocutionary point.

Answering this question required the Court to examine the conventional or “reasonable” meaning associated with the artifacts used in the display, as well as their location and context: “a typical museum setting, though not neutralizing the religious content of a religious painting, negates any message of endorsement of that content.”<sup>111</sup> The Court concluded that the county’s crèche display “communicat[ed] a religious message,” not only because it was a crèche, but because it contained words of praise for God, and nothing in its setting detracted from that religious message.<sup>112</sup> In contrast, the menorah display not only contained a clear religious symbol, but also a Christmas tree and a sign saluting liberty, creating an “overall holiday setting.”<sup>113</sup> The Court concluded that because the 45-foot tree, which it deemed a secular symbol, dominated the 18-foot menorah, and both were accompanied by the sign, the display was best characterized as having the effect of celebrating the winter holiday season.<sup>114</sup>

### III. SOFTWARE SPEECH ACTS ARE COVERED BY THE FIRST AMENDMENT

In speech act terms, Alice performs a propositional act—a physical utterance act of producing marks on paper or a video screen. Her marks have some definite meaning within a language because anyone who understands that language understands what she says. Depending on the context, she thus performs various illocutionary acts: In publishing her source code, she states or asserts it, asks for criticism, and advocates that it be

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109. See *id.* at 595, 597 (noting that the general principles of O'Connor's framework from her *Lynch* concurrence are “sound,” and “have been adopted by the Court in subsequent cases”).

110. *Id.* at 595 (quoting *Lynch v. Donnelly*, 465 U.S. 668, 692 (1984) (O'Connor, J., concurring)).

111. *Id.* (quoting *Lynch*, 465 U.S. at 692 (O'Connor, J., concurring)).

112. *Id.* at 598. In contrast, the crèche display in *Lynch* included “Santa’s house and his reindeer” and a “‘talking’ wishing well” as “separate” visual focal points. *Id.*

113. *Id.* at 614 (quoting *Lynch*, 465 U.S. at 692 (O'Connor, J., concurring)).

114. See *id.* at 617-20. Neither the purpose nor entanglement prong of *Lemon* was before the Court.

used, studied, or considered. By publishing it, Alice intended her publication of encryption software as an act of political expression.<sup>115</sup>

However, what is the covered “speech” in software? Those critical of *Bernstein* seem to doubt that software has any meaning the First Amendment would cover.<sup>116</sup> The simplest answer to that question is that Alice is stating a description of an algorithm, method, or procedure. The next few parts will attempt to unpack this argument a little. First, I will argue that the content of software is identical regardless of its form—be it on paper or in a computer—and thus deserving of coverage. Second, I will discuss how programming languages convey specific and precise meanings within the computer science community as part of that community’s discourse. Participation in the discourse and its utterance of procedures places software within the coverage of the First Amendment. Finally, I will sort out protected software speech acts from the mundane software acts, focusing particularly on software acts on the borderline between speech and non-speech acts.

#### A. Placing Software in the Context of Meaning, Medium and Form

The encryption regulations require a license to export electronic encryption source code, but wholly exclude the export of encryption source code on paper.<sup>117</sup> Thus, the regulations draw an arbitrary distinction between the media of paper and pixels. Although the justifications for this distinction remain unclear, the government may have drawn this line based on the ease with which one may implement and disseminate encryption source code. Source code on paper requires additional steps of translation before today’s computers can recognize them as an executable program. As to the ease of dissemination, the average person can more cheaply and widely propagate information on the Internet than in other media.<sup>118</sup>

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115. See *supra* note 8 and accompanying text.

116. See, e.g., *Karn v. United States Dep’t of State*, 925 F. Supp. 1, 9 n.19 (D.D.C. 1996), *remanded* 107 F.3d 923 (D.C. Cir. 1997) (“The Court makes no ruling as to whether source codes, without the comments, fall within the protection of the First Amendment. Source codes are merely a means of commanding a computer to perform a function.”).

117. See 15 C.F.R. § 734.3(b)(3) note (1996).

118. One might therefore wonder whether using a fax machine or “Web cam” to transmit a hand-scrawled copy of encryption source code is an electronic export. The transmission medium is electronic, but no one could “directly” input the received copy into a computer for execution. The same is true of various digital formats for pictures or

In drawing this distinction, the encryption regulations distinguish software in the forms of source code and object code from software expressed in natural language and mathematical algorithms. The regulations seem to ignore the meaning of source code to programmers. To sustain my argument, I need to first explain the distinctions between meaning, medium, form and effect on audiences. Medium refers to the mechanical or physical vehicle of expression: paper, stone for some sculptures, sound waves for audible works, or electromagnetic waves for radio or TV broadcast. Form, on the other hand, pertains to the choice of communication method, such as choosing to use English instead of French, or words instead of pictures. Meaning is roughly independent of the medium, but is somewhat tied to its form because of the difficulty in translating one form into another. A news story has roughly the same meaning whether it is printed on paper or engraved in stone, while it is unclear that a person fully captures the meaning of that news story in a painting. Beyond form, medium or meaning, the effect that a work has on an observer is highly contextual<sup>119</sup> and may either be communicative or non-communicative.<sup>120</sup> As the Court has recognized, “[e]ach method of communicating ideas is a law unto itself and that law must reflect the differing natures, values, abuses and dangers of each method.”<sup>121</sup>

By drawing this arbitrary distinction between electronic and paper media, the government ignores the fact that publishing software can be a speech act, regardless of the medium of publication. As a text, software is indistinguishable from any other kind of linguistic “speech.” An example may clarify this argument. Suppose that Alice wanted to write a cryptographic program. To write this program, she would rely on prime numbers—which are essential to modern cryptography—but she would need to first determine which numbers are prime numbers. In mathematics, two numbers (a, n) are relatively prime if their greatest common divisor is equal to 1.<sup>122</sup> In mathematical language, we can say “gcd (a, n) = 1.” So, gcd (15, 28) = 1, but gcd (15, 27) = 3. This function is easy to set forth and

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graphics like GIFs, JPEGs, or PDF and Postscript files, the rough electronic equivalent of a photograph.

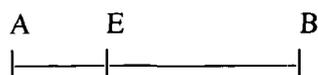
119. For instance, oral speech acts are necessarily audible. We can use loudness for meaning, as when we emphasize a particular word, or for disturbance, as when we loudly heckle.

120. A printed pamphlet has communicative effect when read, but a noncommunicative effect when crumpled and tossed on the sidewalk.

121. *Metromedia, Inc. v. City of San Diego*, 453 U.S. 490, 501 (1981).

122. For example, 15 and 28 are relatively prime because they share no common factors other than 1. However, 15 and 27 are not relatively prime because both are divisible by 3.

compute for small numbers, but not for larger numbers. To compute larger numbers, Alice would need to rely on a method, such as Euclid's algorithm.<sup>123</sup> As written by the great mathematician himself, Euclid's algorithm would take the following form.<sup>124</sup> Let's call this example (1).



|—| line G



To find the greatest common measure of two given numbers not relatively prime.

Let AB and CD be the two given numbers not relatively prime.

It is required to find the greatest common measure of AB and CD.

If now CD measures AB, since it also measures itself, then CD is a common measure of CD and AB. And it is manifest that it is also the greatest, for no greater number than CD measures CD.

But, if CD does not measure AB, then, when the less of the numbers AB and CD being continually subtracted from the greater, some number is left which measures the one before it.

For a unit is not left, otherwise AB and CD would be relatively prime, which is contrary to the hypothesis.

Therefore some number is left which measures the one before it.

Now let CD, measuring BE, leave EA less than itself, let EA, measuring DF, leave FC less than itself, and let CF measure AE.

Since then, CF measures AE, and AE measures DF, therefore CF also measures DF. But it measures itself, therefore it also measures the whole CD.

But CD measures BE, therefore CF also measures BE. And it also measures EA, therefore it measures the whole BA.

But it also measures CD, therefore CF measures AB and CD. Therefore CF is a common measure of AB and CD.

I say next that it is also the greatest.

123. See BRUCE SCHNEIER, *APPLIED CRYPTOGRAPHY: PROTOCOLS, ALGORITHMS, AND SOURCE IN C* 245-48 (Phil Sutherland ed., 2d ed. 1996).

124. EUCLID, *ELEMENTS*, bk. VII, proposition 2, available at D.E. Joyce, *Euclid's Elements*, (<http://aleph0.clarku.edu/~djoyce/java/elements/bookVII/propVII2.html>) (visited Apr. 26, 2000). Please note that the lines are not to scale.

If CF is not the greatest common measure of AB and CD, then some number G, which is greater than CF, measures the numbers AB and CD.

Now, since G measures CD, and CD measures BE, therefore G also measures BE. But it also measures the whole BA, therefore it measures the remainder AE.

But AE measures DF, therefore G also measures DF. And it measures the whole DC, therefore it also measures the remainder CF, that is, the greater measures the less, which is impossible.

Therefore no number which is greater than CF measures the numbers AB and CD. Therefore CF is the greatest common measure of AB and CD.

Corollary[:] From this it is manifest that, *if a number measures two numbers, then it also measures their greatest common measure.*

Even written in English as in Example (1), Euclid's version is not as understandable as the next version from a class handout I found on the Internet.<sup>125</sup> Let's call this example (2):

#### UNIT 4

##### Programming Techniques

##### Lesson 6 - Euclid's Algorithm

##### OBJECTIVE

To allow students to further develop their problem solving skills

##### CLASS EXERCISE:

In order to determine the greatest common divisor of two numbers, Euclid's Algorithm is stated as follows:

Divide the smaller number into the larger. If the remainder is not zero, replace the original two numbers by the remainder and the smaller of the two numbers, and repeat the division. Eventually the remainder will be zero, in which case the smaller number is the greatest common divisor.

With a partner, create pseudocode that accomplishes the description above.

Write a Pascal program that determines the GCD based on your pseudocode.

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125. See Mr. Abdelnour, *Unit 4: Programming Techniques*, (<http://www.blueskies.net/abdelnou/dccoa6d/lessons/less6-u4.htm>) (visited Apr. 9, 2000).

It is difficult to follow Example (1), but not Example (2).<sup>126</sup> Another way to express Euclid's algorithm is in "pseudo-code."<sup>127</sup> Call this example (3):

```

                                Algorithm gcd(a, n)

begin
    g0 := n;
    g1 := a;
    i := 1;
    while gi /= 0 do
        begin
            gi+1 := gi-1 mod gi;
            i := i + 1
        end;
    gcd := gi-1
end

```

A fourth way to express Euclid's algorithm is in the C programming language.<sup>128</sup> Let's call this example (4):

```

/* returns GCD of x and y, assuming x and y are >0 */

int gcd (int x, int y)
{
    int g;

    if (x < 0)
        x = -x;
    if (y < 0)
        y = -y;

```

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126. The procedure in Example (2) works for 15 and 27 as follows: divide 15 into 27, with remainder 12; now divide 12 into 15, with remainder 3; now divide 3 into 12, which divides exactly, so the remainder is 0. Thus, 3 is the greatest common divisor of 15 and 27.

127. See DOROTHY E. DENNING, *CRYPTOGRAPHY AND DATA SECURITY* 44 (1983).

128. See SCHNEIER, *supra* note 123, at 245.

```

if (x + y == 0)
    ERROR;
g = y;
while (x > 0) {
    g = x;
    x = y % x;
    y = g;
}
return g;
}

```

We have here the same basic “idea” stated in different forms. Each communicates roughly the same meaning to the competent reader. As a native English speaker, Example (2) is easiest for me to understand. Example (1), however, shows that English can be quite difficult to understand. With a little help from someone with mathematical training, I also understood Example (3). A computer science student who has not yet encountered Euclid’s algorithm might find Examples (3) or (4) more understandable. Certainly, a programmer could work backward from Example (4) to Example (2).

If Examples (1) and (2) are protected speech, it is unclear why Examples (3) and (4) are not. The only apparent distinction rests in the fact that Examples (3) and (4) are Euclid’s algorithm written in a programming language. Euclid’s algorithm remains Euclid’s algorithm whether it appears on paper or on a display terminal screen. Although Euclid’s algorithm appeared in different forms in the four preceding examples, it retained the same meaning and effect: the determination of whether large numbers are relatively prime. Examples (3) and (4) above clearly communicate a message that should be protected under *Spence* against discrimination based on viewpoint, content or subject-matter. Yet, the government’s encryption regulations ignore this fact.

## B. Finding the “Speech” in Software

If Euclid’s algorithm has content, what is that content for First Amendment coverage purposes? A common categorization of software focuses on the genre of “instructions.”<sup>129</sup> This approach, however, presents a problem: software instructions seem to be addressed to a machine. The

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129. See, e.g., Marci A. Hamilton & Ted Sabety, *Computer Science Concepts in Copyright Cases: The Path to a Coherent Law*, 10 HARV. J.L. & TECH. 239, 239 n.1 (1997) (“[A] program is the sequence of instructions that are executed by the computer when it performs a desired task.”).

notion of “instructions,” however, contains an illocutionary force indicator that implies too much. Instruction-giving carries a fair amount of First Amendment baggage because it infuses action or conduct into “speech.”<sup>130</sup> In terms of utterance meaning, we should instead think of Euclid’s algorithm as a procedure. In this part, I discuss how programming languages are like and unlike natural languages, how computer science involves not only the stating of procedures but also the discussion of methodology for stating procedures, and how procedures are not equivalent to instructions.

1. *Programming Languages Convey Specific and Precise Meaning Within the Computer Science Community*

We normally think of language in terms of natural languages like English or French. Language is, however, far more complex. Within each language, there exist sub-communities of speakers who have adopted a specialized subset of the language as their conventional form of communication. For instance, lay native English speakers might have difficulty understanding the technical vocabulary used by oncologists discussing a cancer patient’s progress. Musicians use artificial notation for writing and reading music, while mathematicians and scientists employ terms and conventions that sound wholly incomprehensible to the untrained ear.<sup>131</sup> Yet the members of these fields understand each other.

Similarly, programming languages define a particular community. Programmers, computer scientists and other scientists use programming languages to communicate with each other. Writing programs resembles the writing of other kinds of works. Programmers and computer scientists, like more conventional writers or artists, view their works in terms of aesthetic and stylistic criteria of beauty and elegance.<sup>132</sup> As the District Court

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130. Professor Schauer, for example, is dubious that “how-to” instructions that accompany products are covered by the First Amendment. He gives the example of a chainsaw manufacturer who provides instructions on how to remove the chainsaw’s safety devices, but explaining that the safety devices should only be removed by a trained mechanic for testing purposes after repair. A consumer removes the devices and a bystander is injured. In his opinion, the chainsaw manufacturer cannot successfully raise a First Amendment defense. See Frederick Schauer, *Mrs. Palsgraf and the First Amendment*, 47 WASH. & LEE L. REV. 161, 164-66 (1990) (“We would say not that instructions are less protected by the First Amendment (which would mean that every instruction case still must be tested against a first amendment-inspired set of doctrinal rules) but that they are not covered at all.”).

131. See, e.g., KNUTH, *supra* note 11, at 96-108 (surveying a number of mathematical algorithms that a non-mathematician cannot comprehend).

132. When a program is clean and neat, nicely structured and consistent, it can be beautiful. I guess I wouldn’t compare a program with the Mona Lisa, but a good program does have a simplicity and elegance that’s

recognized, native speakers of programming languages “participate in a complex system of understood meanings within specific communities.”<sup>133</sup>

Because programming languages enable the precise and concise exposition of scientific ideas, they deserve the protection of First Amendment coverage. Instead of expressing mundane everyday thoughts,<sup>134</sup> programming languages express procedures and ideas about procedures without the ambiguity plaguing natural languages. For instance, programming languages avoid the difficulties that English has in describing algorithms and may stand as the only practical means of expressing certain algorithms that require precise articulation.<sup>135</sup> Programming languages provide the best means for communicating highly technical ideas—such as mathe-

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quite handsome. Stylistic distinctions of different programs are intriguing, very much like the differences art critics might see between Leonardo’s *Mona Lisa* and a Van Gogh. I like the LISP programming language because it’s so pleasing. There’s a concise form of LISP called the M expressions. When you write an algorithm using M expressions, it’s so beautiful you almost feel it could be framed and hung on a wall.

SUSAN LAMMERS, *PROGRAMMERS AT WORK* 64 (1986) (quoting Gary Kildall, author of CP/M, a principal early operating system). See also FREDERICK P. BROOKS, *THE MYTHICAL MAN-MONTH* 7 (1975) (“The programmer, like the poet, works only slightly removed from pure thought-stuff. He builds his castles in the air, from air, creating by exertion of the imagination. Few media of creation are so flexible, so easy to polish and rework, so readily capable of realizing grand conceptual structures. . . . Programming then is fun because it gratifies creative longings built deep within us and delights sensibilities we have in common with all men.”).

133. See *Bernstein I*, 922 F. Supp. 1426, 1435 (N.D. Cal. 1996) (quotation and citation omitted); see also Robert X. Cringely, *ACCIDENTAL EMPIRES: HOW THE BOYS OF SILICON VALLEY MAKE THEIR MILLIONS, BATTLE FOREIGN COMPETITION, AND STILL CAN’T GET A DATE* 28 (1992) (“Programs are written in a code that’s referred to as a computer language, and that’s just what it is—a language, complete with subjects and verbs and all the other parts of speech we used to be able to name back in junior high school. Programmers learn to speak the language, and good programmers learn to speak it fluently. The very best programmers go beyond fluency to the level of art, where, like Shakespeare, they create works that have value beyond that even recognized or intended by the writer.”).

134. See Hamilton & Sabety, *supra* note 129, at 265-66 (explaining that programming languages are “composed of a set of grammar rules and a set of symbols” and that, unlike natural languages, the grammar of typical programming languages is “context-free” thus enabling a computer to check grammar mechanically without knowing what the symbols mean) (footnotes and citations omitted).

135. See DONALD KNUTH, *THE ART OF COMPUTER PROGRAMMING: FUNDAMENTAL ALGORITHMS* 5 (1st ed. 1968) (“Each step of an algorithm must be rigorously and unambiguously specified for each case. The algorithms in this book will hopefully meet this criterion, but since they are specified in English, there is a possibility that reader might not understand exactly what the author intended.”).

mathematical concepts—within the community of computer scientists and programmers.

An analogy to natural language can illustrate the communicative value of precision, and its relation to form. In using natural language to express procedures, it is easier to be precise in writing than in speaking. The difference lies in both the medium and the form: Written language uses punctuation, capitalization, and other visual tools to make communication more precise. For example, the convention of using quotation marks indicates to the reader that certain words should be treated literally, not as a reference. However, this precision disappears when one speaks: If I say, “say ‘your name’ aloud,” you may respond “your name,” or “Ezra.” Written English would avoid this possible confusion.

*Cohen v. California*<sup>136</sup> underscores the importance accorded to a speaker’s precise choice of form. In *Cohen*, the Supreme Court reversed Cohen’s conviction for disorderly conduct that arose when he wore a jacket bearing the words “Fuck the Draft” in a courthouse.<sup>137</sup> Instead of using the uncivil phrase “fuck the draft,” Cohen could have stated “I strongly disapprove of the draft.” Although the content of these two statements is identical, the Supreme Court had no doubt that they differed in the message that they conveyed and that the First Amendment protected Cohen’s choice of language to express his emotional views.<sup>138</sup> When speakers express ideas, the First Amendment principle of “speaker autonomy” protects the form or means of expression.<sup>139</sup>

Programming languages make it possible to express exceedingly precise, particularized meanings. Computer programs are statements in languages peculiarly suited for expressing procedures and ideas about procedures. For this reason, asserting source code is a speech act.

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136. 403 U.S. 15 (1971).

137. *See id.* at 16.

138. *See id.* at 24-25.

139. *See Hurley v. Irish American Gay, Lesbian and Bisexual Group of Boston*, 515 U.S. 557, 573 (1995) (“[T]he fundamental rule of protection under the First Amendment [is] that a speaker has the autonomy to choose the content of his own message.”); *Riley v. National Federation of the Blind of N.C., Inc.*, 487 U. S. 781, 790-91 (1988) (“The First Amendment mandates that we presume that speakers, not the government, know best both what they want to say and how to say it.”); *Meyer v. Grant*, 486 U. S. 414, 424 (1988) (“The First Amendment protects [individuals’] right not only to advocate their cause but also to select what they believe to be the most effective means for so doing . . .”).

## 2. *The Use of Software in the Scientific Discourse Places it Within the Coverage of the First Amendment*

In using and stating source code, programmers not only assert a particular procedure or set of procedures—they also participate in a scientific discourse about the asserted procedures. Such discourse occurs at several levels. First, they discuss the particular procedure or algorithm itself.<sup>140</sup> Second, individual algorithms often belong to a larger class of algorithms that address a set of problems.<sup>141</sup> Publishing an algorithm can create a discourse about those classes of algorithms and problems. Within the literature devoted to search algorithms, the act of publishing a search algorithm puts the publisher in the middle of that discourse.<sup>142</sup> Third, the publication of computer programs—algorithms in source code form—contributes to the development of mathematics itself.<sup>143</sup> Conversely, mathematical problems have stimulated various areas of computer science, including cryptography.<sup>144</sup>

This discourse is central to the marketplace of ideas in computer science. Scientific communities participate in a discourse through the processes of open publication and peer review, where new ideas are shared, evaluated, and independently criticized.<sup>145</sup> As a subset of computer science, cryptography possesses its own discourse. Taking advantage of the precision inherent in source code, cryptographers often publish their algorithms in source code form as “reference implementations,” benchmarks

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140. See Hamilton & Sabety, *supra* note 129, at 280 (“[T]here are many cases of one programmer making an improvement to another’s existing algorithm.”).

141. A simple example lies in algorithms that solve the problem of information retrieval, such as a telephone number in a directory.

142. See KNUTH, *SELECTED PROBLEMS IN COMPUTER SCIENCE* 61-78 (discussing sequential search, binary search, and other search algorithms).

143. See *id.* at 12 (“[T]he study of algorithms themselves has opened up a fertile vein of interesting new mathematical problems.”).

144. Some mathematical functions that are simple to compute in one direction but extremely difficult in the other direction are the basis of important cryptographic algorithms. Euclid’s algorithm, discussed *supra* text accompanying note 124, is an example of an algorithm related to such hard problems. The hard problem to which Euclid’s algorithm applies is that of factoring large numbers, i.e., to find the prime numbers that when multiplied yield that number. Computers can quickly multiply two very large prime numbers of 100 digits. But taking the product of that multiplication and factoring it to recover the two prime factors requires much more computing power. See SCHNEIER, *supra* note 123, at 245.

145. See, e.g., Thomas Emerson, *Colonial Intentions and Current Realities of the First Amendment*, 125 U. PA. L. REV. 737, 741 (1977) (noting that a theory of marketplace of ideas “is essentially the method of science,” which seeks “progress through free and rational inquiry”).

against which other implementation may be verified.<sup>146</sup> This free flow of ideas embodies the discursive relationship between speaker and audience that Professor Post considers necessary for First Amendment coverage.<sup>147</sup> Thus, in publishing her encryption program in the cryptographic “market-place of ideas,” Alice does more than simply assert her algorithm; she seeks and expects comment or criticism about that algorithm.

The open publication of scientific works for evaluation and criticism stands as the scientific community’s central convention and places it within the coverage of the First Amendment.<sup>148</sup> While I have mainly argued that deference to speech subcommunity conventions is consistent with First Amendment values and useful to courts, we should not lose sight of the constitutive nature of subcommunity conventions and practices. We define science worlds in terms of conventions like the scientific method, and we would not think someone a full-fledged member of a science world if he or she did not work within the scientific tradition. These mutually accepted practices constitute the subcommunity; conversely, to be a member of a subcommunity is to take a certain stance toward its conventions. Thus, conventions and practices are not merely signposts for external observers; they are what makes it possible for a subcommunity to be a subcommunity, and for artists or programmers to be members of their respective worlds. Publishing her source code in accordance with the tradition of open scientific publication is one way that Alice affirms her membership in the world of computer science.

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146. Schneier Decl., ¶ 34, Appellee’s Excerpts of Record, vol. 1, *Bernstein v. United States Dep’t of Justice*, 176 F.3d 1132 (9th Cir. 1999) (No. 97-16686) (“Source code is an especially important dissemination tool because it is exact . . . [and] not subject to interpretation. Cryptographers often publish ‘reference implementations’ of their algorithms. These are meant to be benchmarks against which other implementations are verified. If a cryptographer wants to study an algorithm, he often tests his own code against the reference implementation to ensure that the implemented the algorithm correctly.”).

147. See Post, *supra* note 9, at 1254 (“[S]ocial conventions, to serve the values protected by the First Amendment, must do more than merely facilitate the communication of particularized messages. They must at a minimum also presuppose and embody a certain kind of relationship between speaker and audience. We might roughly describe that relationship as dialogic and independent.”).

148. See Francione, *supra* note 14, at 425 (“[S]cientific publications would ordinarily be protected by first amendment rights to publish.” (quoting John A. Robertson, *The Scientist’s Right to Research: A Constitutional Analysis*, 51 S. CAL. L. REV. 1203, 1217 (1978))).

### 3. *Software “Utters” Procedures Covered by the First Amendment*

By characterizing software as instructions, many people imply that publishing software corresponds to giving instructions.<sup>149</sup> If a person gives instructions to a computer and not to humans, the First Amendment would not be implicated. It is misleading to think of software as instructions however, because giving instructions differs from stating a procedure. Computer programming, computer science, and programming languages are fundamentally about procedures, not instructions.<sup>150</sup> Euclid’s algorithm is a mathematical procedure, and writing it in a programming language does not change that fact. The content of a computer program embodies at least the particular procedure that it contains.

When used in speech acts, procedures are not necessarily instructions. A chocolate cake recipe describes a procedure, but not every speech act involving it entails the giving of instructions. The recipe involves instructions when I utter the recipe to someone with the intent that the person bake a cake according to the recipe. Yet, when a copy editor performs a grammar or spelling check on the recipe to include it in a cookbook, its “recipe-ness” is hardly relevant. The editor treats the recipe as a linguistic object and checks to see if it conforms to our rules of language. Moreover, I might buy the cookbook as a gift. My act of giving the cookbook to a friend does not involve my “instructing” him to try a particular recipe. It seems odd to think that I am instructing him when I might not even know how to bake the cake myself. Furthermore, when I cook with a recipe, I understand the recipes as procedures, not as instructions. I have many cookbooks, but I rarely follow any particular recipe. Instead, I study several different recipes for a dish, identify its “essence,” and then create my own version. When I do this, I do not follow any particular set of instructions. I treat each recipe as a text and learn from them, similar to reading many cases and distilling the majority and minority opinions on an issue.<sup>151</sup> Computer programmers often treat programs the same way.<sup>152</sup>

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149. . See, e.g., R. Polk Wagner, Note, *The Medium is the Mistake: The Law of Software for the First Amendment*, 51 STAN. L. REV. 387, 407 (1999) (“[S]oftware, to the extent it can be considered a set of instructions, communicates only to machines”).

150. See KNUTH, *supra* note 11, at 2-5 (“A computer program is a representation of an algorithm in some well-defined language. Algorithms are abstract computational procedures for transforming information; programs are their concrete embodiment . . . . My favorite way to describe computer science is to say that it is the study of algorithms.”).

151. *But see* Lars Noah, *Authors, Publishers, and Products Liability*, 77 OR. L. REV. 1195, 1207-08 (1998) (“I daresay that few cookbooks are read while relaxing at the beach; instead, they are used in the kitchen while preparing a meal.”); Jonathan Mintz,

These various ways of interacting with a text become “mushed together” when we characterize a recipe, algorithm, or software as “instructions.”

So the best way to think of Euclid’s algorithm, or any algorithm, is not as “instructions” but as procedures. The characterization of “speech” as procedures does not disqualify it from coverage.<sup>153</sup> The First Amendment issues associated with procedures flow from acts done with procedures, like actually executing them<sup>154</sup> or teaching others to execute the procedures.<sup>155</sup> In short, a computer program in source code form is a procedure written in a programming language. When Alice publishes her program, she performs the speech act of uttering a procedure.

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*Strict Liability for Commercial Intellect*, 41 CATH. U. L. REV. 617, 645 (1992) (explaining that consumers expect recipes “to be directly usable . . . rather than . . . capable of being read and contemplated as information for information’s sake”).

152. The most obvious example is computer science textbooks, which commonly contain sample programs for students to study. An example in the field of cryptography is SCHNEIER, *supra* note 123 (containing numerous algorithms relevant to cryptography described in English, mathematical functions, and source code).

153. Virtually any representation or depiction of someone’s doing something or any explanation of how to do something can be “taken as” instructions by a person so inclined. The so-called “copycat” cases, like *Yakubowicz v. Paramount Pictures Corp.*, 536 N.E.2d 1067 (Mass. 1989) (First Amendment bars liability against producer of motion picture where viewers killed a youth while allegedly imitating the violence depicted therein), and *Video Software Dealers Ass’n v. Webster*, 968 F.2d 684 (8th Cir. 1992) (invalidating on constitutional grounds state statute prohibiting the sale or rental to minors of videos “depicting violence”), exemplify the first case. *Herceg v. Hustler Magazine, Inc.*, 814 F.2d 1017 (5th Cir. 1987) (denying civil liability claim for death caused by following procedures described in magazine), *cert. denied*, 485 U.S. 959 (1988) and *Rice v. Paladin Enters., Inc.*, 128 F.3d 233 (4th Cir. 1997) (permitting wrongful death suit against publisher of manual for assassins on aiding-and-abetting theory), *cert. denied*, 523 U.S. 1074 (1998) illustrate the second.

154. See Terri R. Day, *Publications that Incite, Solicit, or Instruct: Publisher Responsibility or Caveat Emptor*, 36 SANTA CLARA L. REV. 73, 92-100 (1995) (discussing consensus view of courts that publishers are not liable in tort for content of “how-to” publications because of First Amendment considerations).

155. For instance, the courts have long sought to distinguish “abstract” advocacy of illegal conduct from more concrete “teaching” or training. See, e.g., *Dennis v. United States*, 341 U.S. 494, 581 (1951) (Douglas, J., dissenting) (arguing that the mere abstract teaching of the moral propriety of violence is protected, but not “the teaching of methods of terror”); *Brandenburg v. Ohio*, 395 U.S. 444, 448 (1969) (distinguishing abstract teaching from “preparing a group for violent action and steeling it to such action” (quoting *Noto v. United States*, 367 U.S. 290, 297-98 (1961))).

#### 4. *Beyond the Academic Setting: Other Uses of Software Are Protected "Speech"*

Many software acts fall into the same category as Alice's intended publication of her source code on the Internet for academic purposes. Given the irrelevance of the physical medium to our inquiry,<sup>156</sup> the First Amendment should cover source code published either in a journal<sup>157</sup> or on the Internet. Although the coverage argument relies on the illocutionary force of conventions in a scientific discourse,<sup>158</sup> the coverage characterization should not depend on the status of the declarant. It should not matter that Alice is a professor or a mere programmer, as long as she publishes with a similar intent. Nor should it matter that Alice merely communicates her program to a community's subset—a class, conference, or colleagues—instead of to the world or the computer science community at large. Teaching in a class, presenting work at academic conferences, and sharing work with colleagues for review and criticism appeal to the same conventions that imbue her act with the illocutionary force of a scientific discourse.<sup>159</sup> As long as Alice's communications are consistent with conventional scientific communicative practices, she has performed a speech act. Thus, any programmers who publish their source code—on the Internet, in Usenet newsgroups, or on mailing lists—with the intent for others to read and study the source code are performing a speech act covered by the First Amendment.

#### C. **Sorting Protected Speech Acts from Mundane Software Acts**

The treatment of freedom of speech in terms of speech-acts avoids a number of conceptual confusions. To accomplish that goal, speech-act theory provides a framework that formalizes meaning in relation to a speaker's intent and in terms of sub-communities' conventions and practices. This part categorizes software acts based on that framework. While traditional speech-act methodology underpins this categorization, First Amendment doctrine itself creates a penumbra around "core" speech acts.<sup>160</sup> So this part attempts to isolate core software speech acts from non-

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156. *See infra* Part IV.A.

157. Under the encryption export regulations, printed encryption source code is not controlled. *See* 15 C.F.R. § 734.3(b) (1996).

158. *See infra* Part IV.B.1-2.

159. Perhaps the best evidence for this proposition is the export regulations themselves, which generally exempt from licensing the export of software that results from fundamental research or is educational. *See* 15 C.F.R. §§ 734.3(b)(3), 734.8, 734.9 (1996) (supplement defining "fundamental research" and "educational").

160. First Amendment doctrines that permit facial invalidation of statutes that unconstitutionally restrict speech acts are the most obvious example. *See, e.g.,* *Brockett v. Spo-*

speech acts and to address borderline situations in light of First Amendment doctrines.

### 1. *Clear Cases of Non-Speech Acts*

There are software acts that are not speech acts. Often, aspects of the act or the context negate any claim to the communicative intent that is necessary for coverage. For example, when Microsoft sells software in object code form and prohibits viewing the object code, it is saying, “don’t read the software even if you can.”<sup>161</sup> The dissemination of “autonomous” software—such as viruses or Trojan horses—for malicious purposes provides another example where the use of software does not constitute a speech act. Commentators have asked how First Amendment coverage of software can be reconciled with concerns about computer viruses and other “malicious” software,<sup>162</sup> given the unlawful nature of the act.<sup>163</sup> The simple answer lies in the fact that releasing a virus or worm onto the Internet lacks any communicative intent, and therefore can not be a speech act.<sup>164</sup>

The same answer applies to instances where hackers cause damage over the Internet by exploiting a security flaw in an Internet site. A person may create a web page that contains the words “Delete All” that, when

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kane Arcades, Inc., 472 U.S. 491, 503 (1985) (discussing the overbreadth doctrine); NAACP v. Button, 371 U.S. 415, 432-33 (1963) (holding that enforcement of statute may be invalid if it prohibits First Amendment conduct “whether or not . . . the petitioner has engaged in privileged conduct”). In general, the Court manages this penumbra by using formal doctrines like vagueness or procedural devices like shifting or increasing burdens of persuasion. *See, e.g.*, Speiser v. Randall, 357 U.S. 513, 526 (1958) (“Where the transcendent value of speech is involved, due process certainly requires in the circumstances of this case that the State bear the burden of persuasion to show that the appellants engaged in criminal speech.” (citation omitted)).

161. Programmers normally publish source code when they intend for their software to be read. If there’s only one level of programming language for the software, then of course we cannot rely on this rough-and-ready distinction. Also, some programmers read and write object code the way that others read and write source code, and they may well publish object code as a speech act. *See Clapes, supra* note 13, at 941 (“In the early days of programming, programs were written by humans directly in object code form. Object code could obviously be read in those days.”). In my example, the provision against viewing the object code rules out communicative intent on the speaker’s part.

162. *See, e.g.*, Wagner, *supra* note 149, at 388 (using example of software for “cracking” into computers); Nguyen, *supra* note 5, at 677.

163. Such conduct is illegal under federal law. *See* Nguyen, *supra* note 5, at 677 (citing 18 U.S.C. § 1030(a)(5)(A) (1994)).

164. Other acts involving viruses are speech acts. One can publish a virus without infecting computers. Indeed, publishing virus source code may be a way to help others fight it.

clicked, deletes the innocent browser's hard drive.<sup>165</sup> In that case, the person who created this trap did not utter "Delete All" with communicative intent. Even if the words "Delete All" arguably constitute a message, this categorization would torture the presumption of coverage for linguistic acts and ignores the issue of illocutionary intent. The actor's goal of causing the erasure of innocent victims' hard drives is not illocutionary: The actor does not intend to achieve that goal by having the victims understand the utterance as causing the erasure. The actor's goal remains concealed and is unlikely to succeed if openly declared. Cases of this sort isolate the linguistic part of an act, but ignore the total act in the total situation. In sum, a lack of communicative intent places an act outside of the First Amendment's coverage.

## 2. *Cases on the Borderline Between Speech Acts and Non-Speech Acts*

Some software acts are harder to characterize. I set aside problems arising from our inability to read minds, and instead focus on two main classes of software acts: (a) those that lack communicative intent but for which the law imputes communicative intent; and (b) those that are done with communicative as well as other intents.

### a) Acts Involving a Legally Imputed Communicative Intent

The most obvious examples of acts to which the law imputes communicative intent are acts of dissemination performed by intermediaries, such as a bookstore's selling a book or a delivery person's tossing a newspaper on the front porch.<sup>166</sup> A bookstore may sell a book to make money, remaining indifferent as to whether anyone actually reads it. We would have to make strong assumptions about its transactions in order to say that the bookstore itself performed a speech act.<sup>167</sup> Nevertheless, First Amendment coverage traditionally applies to the distribution or selling of protected works.<sup>168</sup> For example, the Court has consistently held that selling a book

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165. See Nguyen, *supra* note 5, at 677 ("Suppose someone put a simple command on her internet page, consisting of the words 'Delete All,' which, when triggered by a vulnerable party innocently browsing the page, would wipe the victim's entire hard disk drive." (citation omitted)).

166. See, e.g., Lovell v. Griffin, 303 U.S. 444 (1938).

167. My personal experience is that many bookstore employees (if not the store itself) do care about the books they sell and the recommendations they make about book purchases.

168. See *City of Lakewood v. Plain Dealer Publ'g Co.*, 486 U.S. 750, 768 (1988) (holding that discretionary newsrack licensing scheme infringes "right to circulate newspapers").

is as much a speech act as giving it away.<sup>169</sup> From the Court's approach, one might say that the protection of publishing—a speech act at the core of First Amendment coverage—requires the strategic coverage of acts relating to the circulation and distribution of published works.<sup>170</sup>

Similarly, the act of publishing source code to a general audience ought to fall within the First Amendment's coverage. If Alice publishes for a general audience that is less likely to understand the source code, suspicion may grow that Alice distributes her work for others to use rather than to communicate.<sup>171</sup> The publication to a general audience should not, however, change the coverage characterization because many scientific and technical publications—such as *Scientific American*—target a general audience.<sup>172</sup> The government appeared to agree with this premise when it failed to require an export license for the worldwide publication of the book *Applied Cryptography*, which discusses encryption software and contains a print appendix of encryption source code.<sup>173</sup> The publication of a book along with a disk or CD-ROM containing the same source code should not be treated any differently.<sup>174</sup>

#### b) Acts Involving the Use of Software

Another category of borderline speech acts involves the use of software in our everyday life. Software permeates our lives, from controlling our home heating or alarm system to word processing or browsing the Internet to search for information. In some situations, software appears so closely related to speech acts that both the use of the software in a speech

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169. See *Riley v. National Fed'n of the Blind of N.C., Inc.*, 487 U.S. 781, 801 (“It is well settled that a speaker's rights are not lost merely because compensation is received; a speaker is no less a speaker because he or she is paid to speak.”); *New York Times Co. v. Sullivan*, 376 U.S. 254, 266 (1964) (“That the Times was paid for publishing the advertisement is as immaterial in this connection as is the fact that newspapers and books are sold.”).

170. See *Ex parte Jackson*, 96 U.S. 727, 733 (1878); *Lovell v. Griffin*, 303 U.S. 444, 452 (1938).

171. See *Bernstein IV*, 176 F.3d 1132, 1148-49 (9th Cir. 1999) (arguing that while “academics and computer programmers” may use source code communicatively, most people neither understand nor are interested in what is said in source code).

172. One need only browse the newsstand or scientific parts of today's megastores to see many highly technical publications being offered to the public at large.

173. See *Karn v. United States Dep't of State*, 925 F. Supp. 1, 3 (D.D.C. 1996), *remanded*, 107 F.3d 923 (D.C. Cir. 1997).

174. The government's position that printed source code is simply “not subject to the EAR” should have doomed licensing of source code published electronically under cases like *Florida Star v. B.J.F.*, 491 U.S. 524, 541 (1989), under which the government lacks a compelling interest in prohibiting the publication of information that is already in the public domain.

act and the software itself should fall within the coverage of the First Amendment.

As a threshold matter, we need to distinguish between publishing software and using software. People, including judges, seem to confuse these two wholly different kinds of acts.<sup>175</sup> One may read a recipe, but using the recipe to prepare food is not in itself a speech act. That does not mean, however, that using software is never a speech act. Using software might be part of a larger speech act, such as when one writes a social science article by performing statistical analyses with software.

Encryption software presents a situation in which using software is a speech act. Because certain things have a special relationship to speaking, even facially speech-neutral regulation can bring the First Amendment into play.<sup>176</sup> Tools of speech—like printing presses, paper and ink, or newsracks—have a close “nexus” to expression,<sup>177</sup> so that any government regulation that may aim at their use in communication becomes suspicious.<sup>178</sup> Encryption software constitutes one such tool of speech. An analogy to envelopes will illustrate this point. An important aspect of speaking is being able to speak to one’s intended audience but not others.<sup>179</sup> A ban on using envelopes to assure some level of privacy for written correspondence would likely affect the content of written correspondence and cause people to shift to some other means of private communication. If using envelopes for written correspondence is a kind of speech act, then using encryption for electronic correspondence should be as well.<sup>180</sup>

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175. In *Karn*, the D.C. Circuit used a hypothetical involving a program that operates a tank. That hypothetical involves the use of software that is clearly not a speech act. See Transcript of Proceedings at 28:8-14, *Karn v. United States Dep’t of State*, 107 F.3d 923 (D.C. Cir. 1997) (No. 96-5121).

176. See *Minneapolis Star & Tribune Co. v. Minnesota Comm’r of Revenues*, 460 U.S. 575 (1983) (striking down tax on newsprint and ink that imposed disproportionate burden on publication).

177. See generally *City of Lakewood v. Plain Dealer Publ’g Co.*, 486 U.S. 750 (1988).

178. See *Arcara v. Cloud Books, Inc.*, 478 US 697, 706-07 (1986) (finding First Amendment scrutiny warranted if “statute based on a non-expressive activity has the inevitable effect of singling out those engaged in expressive activity”); *id.* at 708 (O’Connor, J., concurring) (using generally applicable law to close bookstore may be pretextual).

179. See *United States v. United States District Court*, 407 U.S. 297, 314 (1972) (“fear of unauthorized official eavesdropping” may deter “discussion of Government action in private conversations”).

180. That software applications, like Web browsers or word-processing programs, are “tools of speech” should not lead to many practical difficulties. In many cases, that a

### c) Acts Involving Multiple Intents

The other major category of borderline speech acts involves acts done with multiple intents.<sup>181</sup> Because this is an enormous category, this part will focus on one type of added intent: the intent to use the software.<sup>182</sup> This added intent generates the main source of concern in software speech acts. In other words, the problem focuses on whether the act of disseminating software—intending both to communicate and to provide the software—is a speech act.

The literature provides two perspectives on this question. The first view argues that the existence of an added intention devoid of any protected meaning does not in itself negate the protection accorded to the speech act.<sup>183</sup> A different approach attempts to discern the predominant motive or intent.<sup>184</sup> This second approach appears reasonable if it does not create any category excluding the possibility that an actor may have the proper communicative intent. The superior approach, in my opinion, lies in precisely defining the speech act of concern in terms of the prohibited intent and with great sensitivity to line-drawing issues.

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speech act is at issue will trigger only intermediate scrutiny, or even no First Amendment scrutiny if the statute is a law of general applicability. *See, e.g.,* *Cohen v. Cowles Media*, 501 U.S. 663, 669 (1991) (stating that “generally applicable laws do not offend the First Amendment simply because their enforcement against the press has incidental effects on its ability to gather and report the news” and allowing breach of contract claim against newspaper for identifying confidential source); *Arcara*, 478 U.S. at 703-04 (stating that generally applicable laws are subject to First Amendment scrutiny if they disproportionately burden speech or if the conduct that drew the sanction itself had a significant expressive component).

181. Solum argues for a strong distinction between “pure” communicative action and “strategic action.” He seems to say, following Habermas, that if even one participant in a linguistically mediated interaction has perlocutionary intent, the overall interaction is strategic rather than communicative. *See* Solum, *supra* note 18, at 91. But Solum recognizes that speech often seems to have a “mixed nature.” He suggests that much speech that appears strategic because it appeals to emotion or rhetoric to persuade is not necessarily strategic.

182. This is an interesting issue for encryption software and other software that might be considered “tools of speech.”

183. *See* Nimmer, *supra* note 26, at 37 n.36 (“There is no reason why the fact that the actor may intend his conduct to cause both a meaning and nonmeaning effect should in itself negate the protection to be accorded the meaning effect.”).

184. *See* Solum, *supra* note 18, at 92 (“[I]t may be possible to identify individual speech acts and certain classes of speech acts as predominantly strategic or predominantly communicative.”).

i) Distributing Software for Personal Use

Let us suppose that Alice gives people encryption source code for them to review *and* to use in protecting the privacy of their electronic mail. Would this additional purpose detract from the communicative intent that makes an act a speech act? The answer must be a qualified “no,” in light of general First Amendment principles. Many works of speech, like instructions and how-to books, can be used as well as read. The author of a book on how to avoid probate undoubtedly intends for the book to be read and used.

At some point on this spectrum, the act of distributing software will occur more for its use than for study or some other illocutionary purpose. *United States v. Mendelsohn* provides a good illustration of this point.<sup>185</sup> In *Mendelsohn*, the defendants were convicted of aiding and abetting the interstate transportation of wagering paraphernalia that consisted of a computer disk containing a program called SOAP (Sports Office Accounting Program).<sup>186</sup> On appeal, the defendants argued that they were entitled to a First Amendment defense because “SOAP is speech.”<sup>187</sup> Although acknowledging that a computer program might warrant First Amendment protection under some circumstances, the Ninth Circuit decided that the integral and essential role played by SOAP in an ongoing criminal activity precluded any First Amendment defense.<sup>188</sup> Such cases involve no obvious illocutionary intent, and thus the act is not a speech act in the first place.<sup>189</sup>

ii) Writing Software for Publication and Personal Use

Let us now suppose that Alice writes a program and intends to publish the source code for others to read, but also intends to use the program herself. Would this additional purpose detract from her communicative in-

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185. 896 F.2d 1183 (9th Cir. 1990).

186. *See id.* at 1184 (“SOAP could be used to record and review information about game schedules, point spreads, scores, customer balances, and bets. A SOAP user could calculate changing odds and factor in a bookmaker’s fee to bets . . . . The defendants knew that most customers used SOAP for illegal bookmaking.”).

187. *Id.* at 1185.

188. *See id.* at 1186; *see also* *United States v. Freeman*, 761 F.2d 549, 552 (9th Cir. 1985) (“Where speech becomes an integral part of the crime, a First Amendment defense is foreclosed even if the prosecution rests on words alone.”).

189. *See Freeman*, 761 F.2d at 552 (explaining that First Amendment defense must go to jury on counts under which defendant advocated violations of tax laws at seminars, but not on counts where he prepared, reviewed and approved false tax returns, because “the First Amendment is quite irrelevant if the intent of the actor and the objective meaning of the words used are so close in time and purpose to a substantive evil as to become part of the ultimate crime itself”).

tent? Here again, the answer must be “no.” After all, we recognize certain solitary linguistic acts as speech acts, even if there is no audience.<sup>190</sup> One still speaks, for example, when writing a personal diary kept under lock and key.

Much the same problem plagues the general enterprise of scientific work. The case for coverage is strongest when the scientific work is part of a larger act that culminates in publication.<sup>191</sup> However, publishing the blueprints or designs of one’s device is no less an act of publication because another might use the device. Writing with the intent to publish is a speech act. The difficult case arises when it is unclear whether one intends to publish. My position, however, is that acts such as designing devices and writing software are speech acts because of the conventions of the relevant scientific community. Because such acts are so often part of larger speech acts such as publication, the exclusion of these mixed-intent acts from the First Amendment’s coverage risks an undue distortion of scientific communication.

#### d) Acts Involving Viruses and Other “Dangerous” Software

Let’s return to the virus hypothetical.<sup>192</sup> The main concern lies in the fact that the software may be “diverted” toward unlawful purposes, regardless of the speaker’s intent. This concern is, however, not unique to software. It also applies to other types of information usable for mischief or harassment, whether highly technical like information about nuclear weapons, or utterly mundane like a person’s name, address or telephone number.

Even if the virus author merely posts the source code and fails to release it in active form, the issue remains whether the posting was done with an intent to communicate. If the author claims that she intended it to communicate, we would need to examine the context to decide the plausi-

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190. See *Stanley v. Georgia*, 394 U.S. 557, 565 (1968) (“A state has no business telling a man sitting alone in his own home, what books he may read or what films he may watch.”). This article focuses almost entirely on communicative speech acts; acts of “pure” expression and reception (*e.g.*, reading) are beyond the scope of this article.

191. See *Spece & Weinzierl*, *supra* note 14, at 214-15 (“Although considered alone experimentation might not be communicative and entitled to First Amendment coverage, when considered with other parts of the pursuit of science which are clearly communicative, both they and it are entitled to constitutional [First Amendment] coverage.”); see also *Francione*, *supra* note 14, at 471-73 (criticizing the argument that all experimentation is protected merely as a precondition of scientific publication, but noting that First Amendment may well apply if government regulates out of concern for the information to be published).

192. See *supra* Part III.C.1.

bility of that claim. There will often be a plausible claim. There is no question that people study viruses and other dangerous software in order to prevent or relieve harm.<sup>193</sup> One way to control a virus is to publish its source code so that systems operators can disable or protect against it. Communicating a virus' source code as part of such an effort qualifies as a speech act because the publisher intends to communicate how the virus works in a conventional way. In fact, one could imagine entire journals or Internet sites devoted to viruses and other dangerous software.<sup>194</sup> When such publications aim to alert the world to these dangers, their intent is clearly communicative.

#### IV. RESPONDING TO THE CRITICS OF SOFTWARE AS SPEECH

This part focuses on the arguments against considering software as speech. These arguments appear in two different forms. The first argument contends that the First Amendment does not cover "functional things." In other words, the functionality of software disqualifies it from being treated as speech, regardless of any textual meaning it might have. The second argument asserts that the First Amendment requires that audiences understand a speaker's message for the message to qualify as protected speech. Therefore, because most people are unable to "read" software, software is not speech. Taken together, the "functionality" and "incomprehensibility" arguments support a third argument: that software's effects are non-communicative even if it is speech.

Both arguments are flawed, although in different ways. The functionality argument frames the First Amendment coverage issue in terms of the nature of the thing—is it expressive or functional?—and essentially attributes that nature to acts performed by using the thing. This ontological approach makes no sense. Instead, we must focus on the actor's act. Asking whether source code is "expressive" differs from asking whether a soft-

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193. For instance, Carnegie-Mellon University maintains a Computer Emergency Response Team that coordinates the sharing of information about various kinds of malicious attacks. See Carnegie Mellon Software Engineering Institute, *CERT Coordination Center*, (<http://www.cert.org>) (visited Apr. 9, 2000). Obviously, commercial vendors of anti-virus software also study viruses.

194. See, e.g., *ALT.COMP.VIRUS Posting Guidelines*, (<http://www.faqs.org/faqs/computer-virus/posting-guidelines>) (visited Apr. 9, 2000) (showing that Usenet users post virus source code); *Virus Bulletin*, (<http://www.virusbtn.com>) (visited Apr. 9, 2000) (showing online journal devoted to computer viruses).

ware act is “expressive” because the former question entirely ignores the putative speaker.

The incomprehensibility argument highlights the issue of audience understanding. We cannot consider audience understanding without referring to a sub-community’s conventions. No logical relationship exists between an act’s conventional meaning within a small subcommunity and in the larger community. Even though few actually comprehend Braille, there is no doubt that Braille holds conventional meanings for its readers. Thus, we must reject any notion of audience understanding that insists that most people must comprehend a form of speech.<sup>195</sup>

The most that the functionality and incomprehensibility arguments show is that publishing software could be a non-speech act. Yet, a variety of acts using fully comprehensible, non-software information can also be non-speech acts. So, the basic questions remain: (1) “is this person really speaking?” and (2) “is this person also doing something else?” Analyzing software as a thing or based on its general understanding does not resolve either of these two questions. In short, both arguments, incomprehensibility and functionality, must be rejected in analyzing the coverage doctrine.

This Part will analyze the critics’ arguments in detail. Although the functionality argument is more important, it also appeals to the incompre-

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195. Some First Amendment doctrines seem to require a general, probabilistic assessment of this issue. Bernstein, for instance, facially challenged the encryption export regulations. A licensing scheme may be facially challenged if, among other things, it has a “close enough nexus to expression, or to conduct commonly associated with expression” to pose a threat of censorship. *See City of Lakewood v. Plain Dealer Publ’g Co.*, 486 U.S. 750, 759 (1988). Thus, while Judge Nelson, dissenting in *Bernstein IV*, appeared to accept that Professor Bernstein’s as-applied challenge was valid, he argued that Professor Bernstein was not entitled to bring a facial challenge because “encryption source code is not conduct commonly associated with expression . . . . The overwhelming majority of people do not want to talk about the source code and are not interested in any recondite message that may be contained in encryption source code.” *Bernstein IV*, 176 F.3d 1132, 1149 (9th Cir. 1999) (Nelson, J., dissenting). The doctrinal answer to Judge Nelson’s concern about the propriety of facial attack is that he misreads *Lakewood* and misread the encryption regulations as a law of general application. Even if one believes that the risk of censorship is low, the discretionary nature of the regulatory scheme is damning. *See Saia v. New York*, 334 U.S. 558, 562 (1948) (“In this case a permit is denied because some persons were said to have found the sound annoying. In the next one a permit may be denied because some people find the ideas annoying. Annoyance at ideas can be cloaked in annoyance at sound.”). The theoretical answer is that he wrongly assumes that *Freedman-Lakewood* facial challenges are like overbreadth facial challenges, which are concerned primarily with the quantity of impermissible applications. But the *Freedman-Lakewood* doctrine is a type of “valid rule” facial challenge that isn’t resolved by a quantitative assessment. *See generally* Marc E. Isserles, *Overcoming Overbreadth: Facial Challenges and the Valid Rule Requirement*, 48 AM. U. L. REV. 359 (1998).

hensibility argument. The incomprehensibility argument, however, largely stands on its own. Thus, this Part will begin with incomprehensibility.

### A. The Incomprehensibility Argument

The incomprehensibility argument comes in two versions. The pure ontological argument considers software programmers' work as engineering, rather than writing, thinking or any other act covered by the First Amendment.<sup>196</sup> The second version concedes that source code is "speech" for programmers, but emphasizes the way most people understand source code.<sup>197</sup> Both versions raise the question of the audience's role in First Amendment analysis. The question is thus whether a mass audience's inability to read source code should matter to First Amendment coverage.

#### 1. *The "Programming Language Is Not a Linguistic Form that Expresses Ideas" Argument*

The doctrinal basis for inquiring about a message's comprehensibility lies in *Spence's* requirement of audience understanding.<sup>198</sup> *Spence* however strongly implies that this inquiry becomes unnecessary when speakers use words.<sup>199</sup> Thus, *Spence* is inapplicable to Alice's situation. Instead of being expressive conduct, publishing source code is conventional linguistic conduct.

Yet the critics offer two flawed arguments to rebut this contention. Their first argument, as championed by the court in *Junger v. Daley*,<sup>200</sup>

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196. See, e.g., Joel C. Mandelman, *Lest We Walk into the Well: Guarding the Keys, Encrypting the Constitution*, 8 ALB. L.J. SCI. & TECH. 227, 255 (1998) ("What 'idea' or 'controversial thoughts' are expressed by an algorithm? The answer is none."); *Karn v. United States Dep't of State*, 925 F. Supp. 1, 9 n.19 (D.D.C. 1996), *remanded* 107 F.3d 923 (D.C. Cir. 1997) ("Source codes are merely a means of commanding a computer to perform a function.").

197. See, e.g., *Bernstein IV*, 176 F.3d at 1149 (Nelson, J., dissenting) ("Only a few people can actually understand what a line of source code would direct a computer to do."); *Junger v. Daley*, 8 F. Supp. 2d 708, 717 (N.D. Ohio 1998) ("[E]ncryption source code . . . is all but unintelligible to most people."), *rev'd and remanded*, No. 98-4045, 2000 U.S. App. LEXIS 6161 (6th Cir. Apr. 4, 2000).

198. See *Spence v. Washington*, 418 U.S. 405, 411 (1974).

199. See *id.* at 409 (because "appellant did not choose to articulate his views through printed or spoken words," the Court must "determine whether his activity was sufficiently imbued with elements of communication" to be covered by First Amendment).

200. 8 F. Supp. 2d 708 (N.D. Ohio 1998), *rev'd and remanded*, *Junger v. Daley*, No. 98-4045, 2000 U.S. App. LEXIS 6161, at \*10 (6th Cir. Apr. 4, 2000). In reversing the district court in *Junger*, the Sixth Circuit agreed that "computer source code, though unintelligible to many, is the preferred method of communication among computer programmers" and "is an expressive means for the exchange of information and ideas about computer programming." *Junger v. Daley*, No. 98-4045, 2000 U.S. App. LEXIS, at \*10.

contends that software is really “conduct” and not speech.<sup>201</sup> Rejecting any appeal to software’s linguistic form,<sup>202</sup> the *Junger* court analogized software to the unprotected category of “fighting words.”<sup>203</sup> This analogy must fail, however, because it confuses coverage and protection. As the Supreme Court held in *R.A.V. v. St. Paul*, fighting words are “not entirely invisible” to the First Amendment.<sup>204</sup> The government may regulate speech in categories traditionally considered unprotected by the First Amendment—like defamation and obscenity—because of their “constitutionally proscribable content.”<sup>205</sup> Hence, regulations based on grounds other than content, like the fact that software is conduct rather than speech, should not stand. In any case, the *Junger* court cannot appeal to *Chaplinsky* to buttress its argument. *Chaplinsky* simply recognized that categories of speech become “proscribable” based on their “fit” with First Amendment values.<sup>206</sup> Regardless of whether everyone understands source

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201. See *Bernstein IV*, 176 F.3d at 1148 (Nelson, J., dissenting) (“encryption source code is more like conduct than speech”); *Bernstein I*, 922 F. Supp. 1426, 1434 (N.D. Cal. 1996) (government argued that Snuffle was “not speech but conduct”); *Clark v. Community for Creative Non-Violence*, 468 U.S. 288, 293 n.5 (1984) (finding that one who desires to engage in assertedly expressive conduct has the burden “to demonstrate that the First Amendment even applies”).

202. See *Junger*, 8 F. Supp. 2d at 716 (“‘Speech’ is not protected simply because we write it in a language. . . . what determines whether the First Amendment protects something is whether it expresses ideas.”) (citation omitted). See generally *Wagner*, *supra* note 149, at 402-03 (terming Judge Patel’s approach “formalistic” and criticizing the use of linguistic form as an analytical device).

203. See *Junger*, 8 F. Supp. 2d at 717 (“‘Fighting words’ are written or spoken in a language. . . . [but] they are excluded from First Amendment protection.”) (citing *Chaplinsky v. New Hampshire*, 315 U.S. 568, 572 (1942) (holding that fighting words are not protected by First Amendment)). The definition of fighting words is somewhat fuzzy, but it is generally understood as face-to-face insults that would provoke the average addressee to respond violently. See *Gooding v. Wilson*, 405 U.S. 518, 523 (1971).

204. *R.A.V. v. City of St. Paul*, 505 U.S. 377, 383 (1992). At issue in *R.A.V.* was a juvenile’s prosecution under an ordinance prohibiting bias-motivated crimes for burning a cross in a black family’s yard. The defendant sought to dismiss the charge on First Amendment grounds, and the state Supreme Court ultimately construed the ordinance as limited to conduct that amounted to fighting words. See *id.* at 379-80. The U.S. Supreme Court held that even as construed, the ordinance constituted impermissible viewpoint-based discrimination under the First Amendment. See *id.* at 391-92.

205. *Id.* at 383-84. “Thus, the government may proscribe libel; but it may not make the further content discrimination of proscribing only libel critical of the government.” *Id.* at 384.

206. *Chaplinsky v. New Hampshire*, 315 U.S. 568, 572 (1942); accord *R.A.V. v. City of St. Paul*, 505 U.S. 377, 385 (1992) (“We have not said that [fighting words] constitute ‘no part of the expression of ideas,’ but only that they constitute ‘no essential part of any exposition of ideas’ . . .”).

code, this software language fits within those covered values: The dissemination of source code plays an essential part in the exposition of ideas within the computer science community.<sup>207</sup> Whether the First Amendment protects a speech act is an entirely different question from whether something is "speech" in the first place.

The second argument made by the critics is that, because they are not natural languages like English or French, programming languages should not be covered by the First Amendment. As the argument goes, programmers neither read nor write.<sup>208</sup> The characterization of software as containing "information" rather than "meaning" testifies to this largely unstated belief.<sup>209</sup> From this perspective, the reading of source code by a programmer would constitute "reverse-engineering."<sup>210</sup> Instead of writing, they engineer or build, making the communicative aspect of source code no different from looking at how a car works. In other words, a programmer is like a chemist who must unbake a slice of cake to produce the recipe

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207. In *Bernstein IV*, Judge Fletcher also held that encryption source code (and presumably all source code) is covered by the First Amendment. See *Bernstein IV*, 176 F.3d 1132, 1141 (9th Cir. 1999). She found that source code is "meant to be read and understood by humans" and "can be used to express an idea or a method." *Id.* at 1140. Furthermore, "in the field of cryptography . . . cryptographic ideas and algorithms are conveniently expressed in source code." *Id.* at 1141. "By utilizing source code, a cryptographer can express algorithmic ideas with precision and methodological rigor that is otherwise difficult to achieve," which "facilitat[es] peer review . . . Thus, cryptographers use source code to express their scientific ideas in much the same way that mathematicians use equations or economists use graphs." *Id.* Thus, Judge Fletcher rejected the government's functionality argument, which at this point in the case was invoked to show that the EAR is not directed toward software's communicative aspect. See *id.* at 1141-42.

208. See *Bernstein IV*, 176 F.3d at 1148-49 (Nelson, J., dissenting) ("Software engineers generally do not create software in object code . . . because it would be enormously difficult . . . [they] use high-level computer programming languages . . . to create source code as a shorthand method . . . In this respect, lines of source code are the building blocks or the tools used to create an encryption machine."). See also Mandelman, *supra* note 196, at 247-68.

209. During oral argument in *Karn v. United States Dep't of State*, for instance, one judge referred to how programmers "draw inferences" from "the program information." Transcript of Proceedings at 22:15-19, *Karn v. United States Dep't of State*, 107 F.3d 923 (D.C. Cir. 1997) (No. 96-5121). This comment indicates that he was dubious that programmers really read software. In a later comment, the judge sought to distinguish, as did the district court in *Karn*, between the program and its comments. See *Karn v. United States Dep't of State*, 925 F. Supp. 1, 9 n.19 (D.D.C. 1996) *remanded*, 107 F.3d 923 (D.C. Cir. 1997). Some comments are clearly text, but "that doesn't seem to work on what are really the guts of [the program]." See Transcript of Proceedings at 22:16-17, *Karn v. United States Dep't of State*, 107 F.3d 923 (D.C. Cir. 1997) (No. 96-5121).

210. For discussions of reverse engineering, see Clapes, *supra* note 13, at 931-47 (1994).

and a list of the raw ingredients. However, to the extent that source code is like a recipe, the difference is obvious. A slice of cake has no utterance meaning, while a recipe does. Like a recipe, source code has utterance meaning.<sup>211</sup> The difference between a procedure written in English, a mathematical algorithm, and source code stems from purely formal delineations. Every well-formed statement in a language has utterance meaning, and this fact applies to statements in programming languages as well. Moreover, the key difference between reading and reverse-engineering lies in reading's dependence on conventionality. The programmers do not make "sophisticated inferences" from the program's behavior or physical form; they read and understand what the source code's author stated.<sup>212</sup> As with natural languages, the relationship between what source code states and the meaning that a trained programmer derives from it is based on vocabulary and syntax.<sup>213</sup> Similar to the use of natural languages, a programmer publishing source code intends for other programmers to understand the source code linguistically. The critics thus ignore an important point: The speaker's intent that the audience understand source code based on its knowledge of programming languages and the communicative practices and conventions of computer science, brings the publishing of source code into the category of covered speech acts.

## 2. *The "Software Is Not Sufficiently Communicative" Argument*

The Court treats non-linguistic conduct differently from linguistic conduct because of a presumption about intent and conventionality. However, using language to communicate more or less guarantees that the actor intends to communicate in a conventional way. Therefore, programming languages are languages for First Amendment purposes and source code is, as a doctrinal matter, pure speech.

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211. See *infra* Part IV.C.3.b.

212. I do not rule out the possibility of First Amendment coverage of reverse-engineering or other scientific analysis of physical objects by reference to the conventions of the scientific community. Even a stand-alone encryption box can be used in a communicative way. I could, in a lecture, take the box apart to show a class of students how the box works. This is a complex speech act for which both object and words are integral. What I say about what I'm doing—annotating, one might call it—depends on the box itself, and vice versa. As I argued earlier, presenting something in an expository way is a speech act no matter what is presented. This bothers people, it seems, because this allows anything to be presented. But I'm only saying that the act is a speech act and therefore covered, not that it's necessarily protected.

213. See Hamilton & Sabety, *supra* note 129, at 265 ("Computer languages are composed of a set of grammar rules and a set of symbols.").

However, some critics have argued the contrary. The district court in *Junger* relied on *Spence* to decide that encryption source code “is not sufficiently communicative” to constitute expressive conduct for First Amendment purposes because it does not convey “an unmistakable message” and because its communicative nature is not “overwhelmingly apparent.”<sup>214</sup> Computer scientists and programmers would be surprised to hear that their source code does not “convey an unmistakable message,” given the precision of source code.<sup>215</sup> Similarly, any programmer who publishes source code to another programmer would be astonished to hear that the communicative nature of her act was not overwhelmingly apparent.

The *Junger* court’s use of *Spence* raises an issue as to the role of audiences in coverage analysis: To whom must software “convey an unmistakable message” and to whom must its “communicative nature” be “overwhelmingly apparent”? Arguably, the court is right if the relevant audience is everyone. However, if coverage requires a “great likelihood” that a message be understood by everyone who viewed or heard it,<sup>216</sup> then the First Amendment would not cover many obvious cases of speech. For instance, very few people can understand obscure languages like Navaho, or specialized technical languages like mathematics. Should the complicated math in Einstein’s theory of relativity, when published on the Internet or in a book, not be considered “speech” because most people do not understand it? Doing so would over-stretch *Spence*. The better interpretation of *Spence* is to comprehend audience understanding as representing what this article terms “meaning by convention.”<sup>217</sup> Hence, the size or type of audiences should not affect coverage.

### 3. *The “An Audience Does Not Understand Programming Language” Argument*

Critics who maintain that audience understanding does matter could try a different argument: Even if source code were published to communicate a message, people would be more interested in the software for its

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214. *Junger v. Daley*, 8 F. Supp. 2d 708, 717 (N.D. Ohio 1998).

215. *See infra* Part IV.B.1.

216. *See Spence v. Washington*, 418 U.S. 405, 410-11 (1974).

217. *Spence* also examines “the nature of [the] activity, combined with the factual context and environment in which it was undertaken” to determine whether the activity has enough communicative elements to receive protection under the First Amendment. *Id.* at 409-10. This approach is better; it doesn’t assign the audience any fixed role in assessing whether an act is a speech act. And I think it is self-evident that publishing software in source code form on the Internet for academic purposes would be speech under this part of *Spence*.

utility than in the message.<sup>218</sup> In other words, the First Amendment does not cover software because what the speaker intends as a message is understood by a lay audience as a tool. For them software is like some meaningless noise or a useful tool.<sup>219</sup>

But we often treat acts as speech acts even when we do not understand what was said, such as when someone speaks in a foreign or technical language, or when we view abstract art. Even without understanding meaning, we can recognize from our knowledge of social conventions and practices that the speaker is attempting to communicate. Accordingly, those unable to read source code could nevertheless recognize that: (i) Alice's source code has utterance meaning to others; and that (ii) she is asserting something with meaning to others. Thus, non-programmers could understand that publishing software is a speech act with meaning and force, even though they do not comprehend what the software's author said. In other words, they may without more recognize her to be attempting to communicate. What should matter for First Amendment coverage purposes is not that the audience actually understands a speech act's propositional content or even its specific illocutionary force. What should matter is that the act can be recognized as a speech act, an attempt to communicate under a sub-community's conventions.

#### 4. *The Incomprehensibility Argument Is a Red Herring*

No version of the incomprehensibility argument makes sense. The acceptance that source code has meaning logically entails that one may assert that meaning. Things that have no utterance meaning, like one's hands, may be used in illocutionary acts.<sup>220</sup> Even if there are doubts about a particular act of publishing software being a speech act, there should be no doubt that publishing software is in general a speech act.

As a practical matter, incomprehensibility is a red herring. We do not have trouble with most unconventional speech acts—even if we are surprised to learn that they were speech acts to others—unless we associate

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218. See, e.g., *Bernstein IV*, 176 F.3d 1132, 1146 (9th Cir. 1999) (holding that “the availability and use of secure encryption may offer an opportunity to reclaim some portion of the privacy we have lost”).

219. The entire notion of incomprehensibility, of course, turns on meaninglessness. The district courts in both *Karn* and *Junger* assumed that software is thought of as a tool by non-programmers. See *Karn v. United States Dep't of State*, 925 F. Supp. 1, 9-10 (D.D.C. 1996), *remanded* 107 F.3d 923 (D.C. Cir. 1997); *Junger v. Daley*, 8 F. Supp. 2d 708, 712 (N.D. Ohio 1998), *rev'd and remanded*, *Junger v. Daley*, No. 98-4045, 2000 U.S. App. LEXIS 6161, at \*10 (6th Cir. Apr. 4, 2000).

220. In this country, there's a widespread social convention that raising one's hand is a request for attention.

them with baleful consequences. Indeed, the government's interest in regulating source code exists whether or not source code is understandable to most people. Even if everyone could read encryption source code, the government could still argue that its use overseas would frustrate U.S. signals intelligence. After all, the same kinds of concerns plague "pure speech" that is not functional—such as the nuclear weapon information at issue in the *Progressive* case.<sup>221</sup> Yet, this concern bears no relation to incomprehensibility.<sup>222</sup> Thus, the allure of the incomprehensibility argument seems ultimately to turn on "functionality." The problem, if there is one, is not source code's incomprehensibility, but its effects.

## B. The Functionality Argument

Some critics have claimed that source code, because of its functionality, is not the kind of thing that the First Amendment covers. In this Part, I unpack the possible meanings of functionality and conclude that the government's concern about software's functionality is a concern about the effects of someone's using software. First, I discuss the fallacies in the critics' functionality arguments. First Amendment case law does not rely on functionality to categorize speech. Yet, the *Bernstein* critics have relied on that argument. In the process, they have confused the medium and the message, focused on the wrong speech acts for their analysis, and disregarded that the use of software can be a speech act. Second, I rebut the government's claim that software speech acts only deserve intermediate instead of strict scrutiny. Functionality makes little sense as an analytical concept other than as a proxy for effect or harm. In fact, to target a particular kind of functionality, like cryptographic functionality, is content-based discrimination. The correct inquiry should focus on software acts, not software as a thing.

### 1. *Fallacies in the Critics' Functionality Arguments*

#### a) Functionality Is Not a First Amendment Doctrine

A threshold problem with the functionality argument lies in the fact that functionality is ill defined and has no obvious doctrinal equivalent.

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221. See *United States v. Progressive Inc.*, 467 F. Supp. 990, 998-1000 (W.D. Wis.), *reh'g denied*, 486 F. Supp. 5 (W.D. Wis.), *appeal dismissed*, 610 F.2d 819 (7th Cir. 1979) (government sought injunction against publication of information allegedly useful to making nuclear weapons).

222. See, e.g., Adam Kegley, Note, *Regulation of the Internet: The Application of Established Constitutional Law to Dangerous Electronic Communication*, 85 KY. L.J. 997, 1011-19 (1996/1997) (describing Congressional debate and testimony about bomb-making information on the Internet).

First Amendment case law does not recognize functionality as a basis for categorizing speech.<sup>223</sup> For instance, the weak protection accorded to fighting words derives from the idea that their use may objectively provoke violence. Similarly, the weak protection given to obscenity, child pornography, and indecency is unrelated to functionality.<sup>224</sup> The case law defines incitement in terms of both the speaker's intent and the act's likely effect, not in terms of functionality.<sup>225</sup>

If the case law recognized a functionality doctrine, what would it look like? Functionality cannot merely mean that the work of speech is useful, since instructions, recipes and manuals are both useful and covered by the First Amendment. Indeed, the First Amendment partly covers commercial speech because consumers can benefit from widespread information.<sup>226</sup> Similarly, functionality cannot simply mean that a form of speech could cause harm since much speech—chemistry books teaching bomb-making or calls to revolution—could cause harm.<sup>227</sup>

To state that software “functions” only means that one can use software to do something. Yet, many forms of “speech” can be used to do

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223. The Court's main vehicle for creating categories of “proscribable” speech has been the reasoning summarized in *Chaplinsky v. New Hampshire*, 315 U.S. 568, 572 (1942) (excluding “utterances [that] are no essential part of any exposition of ideas, and are of such slight social value as a step to truth that any benefit that may be derived from them is clearly outweighed by the social interest in order and morality”). Although such categories are clearly content-based, within them “the evil to be restricted so overwhelmingly outweighs the expressive interests, if any, at stake, that no process of case-by-case adjudication is required.” *New York v. Ferber*, 458 U.S. 747, 763-64 (1982).

224. See *Miller v. California*, 413 U.S. 15 (1973) (obscenity); *Ferber*, 458 U.S. at 757-58 (child pornography); *FCC v. Pacifica Foundation*, 438 U.S. 726 (1978) (indecency). Obviously, these categories of speech are based largely on *Chaplinsky's* notion of the social interest in morality, although in *Ferber* the Court also emphasized the psychological harm experienced by children in the production and dissemination of child pornography. See *Ferber*, 458 U.S. at 757-58.

225. See *Brandenburg v. Ohio*, 395 U.S. 444, 449 (1969).

226. See *Virginia Bd. of Pharmacy v. Virginia Citizens Consumer Council, Inc.*, 425 U.S. 748, 763 (1976) (in addressing a ban on prescription drug prices, the Court found that “a particular consumer's interest in the free flow of commercial information” may be keener than interest in “the day's most urgent political debate”). Note here that the reasons articulated for subjecting commercial speech to intermediate scrutiny are mostly unrelated to its utility.

227. See *American Booksellers Ass'n, Inc. v. Hudnut*, 771 F.2d 323, 333 (7th Cir. 1985), *aff'd mem.*, 475 U.S. 1001 (1986) (“Much speech is dangerous. Chemists whose work might help someone build a bomb, political theorists whose papers might start political movements that lead to riots, speakers whose ideas attract violent protesters, all these and more leave loss in their wake.”) (emphasizing necessity of direct causation and speaker's intent).

things. For instance, although charitable solicitations “function” to raise money, the First Amendment covers charitable appeals because they involve important interests like the communication of information, the dissemination and propagation of ideas, and the advocacy of causes.<sup>228</sup> To push the analogy further, erotic works “function” to sexually arouse people, seditious libel “functions” to subvert government, defamation “functions” to damage reputation, and textbooks “function” to confer knowledge and abilities. In short, there is no doctrinal foundation for not treating software as speech simply because it “functions.” This idea encompasses so much speech that it is useless as an analytical tool.

#### b) Software Is Not a Machine or Machine Part

The government and the courts have relied on the functionality argument, despite its logical problems as an analytical tool. In *Bernstein*, the government argued that source code differs from blueprints, recipes, and “how-to” manuals because a person can use software to control the operation of a computer.<sup>229</sup> The dissent in *Bernstein IV* and the district court in *Junger* adopted this view in finding that source code is purely functional because, unlike other speech, it “actually performs the functions it describes.”<sup>230</sup>

These champions of functionality rely on two basic analogies. First, they argue that software is a device designed to plug into a computer.<sup>231</sup> In adopting this view, they completely ignore the linguistic form and text in which software is written.<sup>232</sup> Second, they regard software as a template that only embodies instructions to a machine.<sup>233</sup> This template analogy suggests that, even if software is a text, its “audience” consists of computers and not people.<sup>234</sup> Both analogies suggest that software is—by de-

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228. See *Schaumburg v. Citizens For Better Env't.*, 444 U.S. 620, 632 (1980).

229. See *Bernstein IV*, 176 F.3d 1132, 1141-42 (9th Cir. 1999) (“[T]he government maintains that source code is different from other forms of expression (such as blueprints, recipes, and ‘how-to’ manuals) because it can be used to control directly the operation of a computer without conveying information to the user.”).

230. *Junger v. Daley*, 8 F. Supp. 2d 708, 717 (N.D. Ohio 1998).

231. See *Bernstein IV*, 176 F.3d at 1147 (Nelson, J., dissenting) (“[T]he basic function of encryption source code is to act as a method of controlling computers.”).

232. See *id.* at 1148 (“[P]rograms are, in fact, machines . . . that have been constructed in the medium of text (source code and object code)”).

233. See NATIONAL COMMISSION ON NEW TECHNOLOGICAL USES OF COPYRIGHTED WORKS, FINAL REPORT 23 (1978).

234. A third point might be that software is like a device in that it's complete—its function can be performed without more, in contrast to a procedure like a recipe, which requires cooking equipment, ingredients, and so on. But software itself does nothing. A person must use it, and on a computer. By focusing on software as a thing we efface the

sign or inherently—functional<sup>235</sup> and thus has little communicative aspect. Both analogies derive their force from looking at software as a thing, ignoring how one can speak software. Yet, these analogies are flawed because they confuse the medium and the message, focus on the wrong acts, and ignore the speech act characteristics of software publication.

i) The Critics Confuse the Medium and the Message

The oral argument in *Karn v. United States Dep't of State*<sup>236</sup> presents an example of how critics confuse the medium and the message. During the oral argument, the D.C. Circuit presented a hypothetical about AWACS planes—ordinary planes converted to perform special functions. The court hypothesized that one could place this special function into a CD-ROM containing a computer program, then display this software as text or numbers on a screen, and finally transcribe it into a book that the First Amendment would cover. The court then asked, “Does it follow that the CD-ROM that got slipped into the hardware of the airplane is speech?”<sup>237</sup>

This question confuses the information recorded on the CD-ROM with the package consisting of the disk and the recorded information. The correct approach must distinguish between the software as text, the form of the text, the physical medium, and running the software. The information on the CD-ROM is a text, just as what is on the pages of a book or the digital music on a CD is a text. By considering the package as a whole, the D.C. Circuit thinks that the software on a physical CD-ROM is a machine part that can be inserted into the airplane.<sup>238</sup> The mechanical aspect of the medium, however, should not affect the issue of coverage. After all, copyright law teaches us not to confuse the work with the copy in which the work is fixed.<sup>239</sup> The inquiry should not focus on the medium on which the work is fixed.

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relevant actor. Software is both recipe and thing only in that the government cares about what people do with it. Bomb-making information isn't a bomb, but the government cares about its being used to make bombs.

235. See *Junger v. Daley*, 8 F. Supp. 2d 708, 717 (N.D. Ohio 1998), *rev'd and remanded*, No. 98-4045, 2000 U.S. App. LEXIS 6161 (6th Cir. Apr. 4, 2000).

236. 107 F.3d 923 (D.C. Cir. 1997).

237. See Transcript of Proceedings at 22:21-23, *Karn v. United States Dep't of State*, 107 F.3d 923 (D.C. Cir. 1997) (No. 96-5121).

238. See *id.* at 22:21-23, 27:24 (“But a floppy disk is itself a machine.”).

239. See 17 U.S.C. § 101 (1994) (“[L]iterary works” are copyrightable “regardless of the nature of the material objects . . . in which they are embodied.”).

## ii) The Critics Focus on the Wrong Acts

Coverage analysis should focus on acts, not things. To provide the correct result, the analysis must concentrate on the right acts. Yet the critics often confuse the core speech act of publishing software with other software acts. For instance, the D.C. Circuit's AWACS hypothetical focuses on the act of slipping the CD-ROM into the hardware. It is unclear why the court examined that particular act. Loading the CD-ROM software on the AWACS computer is a different act from communicating the software to a person. In addition, using the loaded software to fly the AWACS plane is also a different act.

The critics have also confused the mechanical acts performed by a machine with the message in software. Adopting this view, the D.C. Circuit stated that the AWACS software seemed more like a process that transforms an ordinary plane into an AWACS plane than a design manual for building the plane.<sup>240</sup> When Karn's attorney stated that source code requires compilation, the judge replied that the computer—not a person—does the compiling.<sup>241</sup> In making that remark, the judge focused on the role of humans in the execution of a software act. Yet, the compilation step is immaterial because running or executing software differs from communicating it to a person, in the same way that following a recipe is not telling someone a recipe. In addition, the remark betrayed the judge's belief that the only act that one could perform with the AWACS software was to execute it. Although this limitation may be true for the computer on an AWACS airplane, it does not apply to most computers: One could input the software into the computer simply to view, read or edit the software. That a person must use a machine to read a text is irrelevant to whether something is text. In sum, the critics have missed the crux of the coverage argument by focusing on the wrong acts and by ignoring the communicative aspect of software use.

## iii) The Critics Confuse Software as a Thing with Software as Speech Act: The Inherent Functionality Confusion

The notion of "inherent" functionality attempts to answer the coverage question by looking at software as a thing and asking whether it is expres-

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240. See Transcript of Proceedings at 24:17-23, *Karn v. United States Dep't of State*, 107 F.3d 923 (D.C. Cir. 1997) (No. 96-5121) ("[T]he code itself seems to be something that is not like a design manual. It's like a machine or process that builds the AWACs. Add . . . water and there you have it.").

241. See *id.* at 25:17-22 ("But it seems to be something that the computer does, right? A person doesn't do the compiling . . . . You slip the disk in and the source code is compiled into object code.").

sive or functional. In so doing, it ignores the intent of software speakers and the context in which software acts occur. This approach would view the words “Kill him!” as an order no matter how the words are expressed. In the previous sentence, the words are obviously not expressing an order. Software acts are neither inherently expressive nor inherently functional. This distinction between expression and function must always depend on the actor’s intent as viewed through the lens of conventions.<sup>242</sup>

The district court in *Junger* adopted this inherency approach when it categorized encryption source code as “inherently” functional because ordinary people consume it for its function.<sup>243</sup> The court viewed the expressiveness of software from the perspective of a computer user who is not a programmer; this approach caused the court to ignore the ways in which software authors might communicate with other programmers. *Junger* disregarded the communicative uses of, and the different audiences for, encryption source code in order to categorize such code as functional.<sup>244</sup> In adopting this approach, it failed to consider the possibility of illocutionary acts involving the software.

The D.C. Circuit’s template analogy further illustrates this ontological confusion. When a template guides a lathe or key-making machine,<sup>245</sup> the court explained, it has no other function than telling the machine what to do. The court asked whether software functions similarly to a template in guiding the lathe.<sup>246</sup> In analogizing software to a template, the court treated the template as a thing with no other function than instructing the machine. However, a person may use a template—whether a silhouette or

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242. This point has been recognized by some commentators. See Nguyen, *supra* note 5, at 676-78 (“[S]oftware inseparably incorporates elements of both expression and function.” First Amendment protection “attaches not to particular *things* or types of *objects* . . . but to *activities* where the free exchange of ideas and information is at stake.”).

243. See *Junger v. Daley*, 8 F. Supp. 2d 708, 716 (N.D. Ohio 1998) (finding that some software “is inherently functional. With such software, users look to the performance of tasks with scant concern for the methods employed or the software language used to control such methods. Among computer software programs, encryption software is especially functional rather than expressive.”), *rev’d and remanded*, No. 98-4045, 2000 U.S. App. LEXIS 6161 (6th Cir. Apr. 4, 2000).

244. See *id.* (“In the overwhelming majority of circumstances, encryption source code is exported to transfer functions, not to communicate ideas . . . . For the broad majority of persons receiving such source code, the value comes from the function the source code does.”).

245. Lathes are used to shape objects like table legs by following a template or silhouette, the way that copies of keys are made at the hardware store from an original key. See Transcript of Proceedings at 30:21-25, 31:1-7, *Karn v. United States Dep’t of State*, 107 F.3d 923 (D.C. Cir. 1997) (No. 96-5121).

246. See *id.* at 30: 9-16.

a lathe control card—to communicate. A furniture maker may manufacture a wonderfully ornate table leg on a lathe. He would record all the operations needed to reproduce that table leg onto a lathe control card that a computerized lathe can read to display a three-dimensional image of the leg. The furniture maker could then publish the control card for others to use. The published control card communicates the furniture maker's design despite having the function of instructing a machine.

The notion of “inherent” functionality or expressiveness confuses a thing, software, with an act—publishing software. This approach confuses the functionality of software with the functionality of publishing software. The “inherence” fallacy seems to say that, if a thing is functional, then acts done with it inherit the quality of functionality.<sup>247</sup> However, things are neither inherently functional nor inherently expressive, because people can use them both ways. This is true even though we tend to use things for one purpose or another. In other words, there is nothing to inhere because it all depends on the intent of the person using the software. This inherency fallacy infects every attempt to link the nature of software to software acts, or the nature of programming languages to acts done with them.

The Supreme Court's analysis of trademark protection for color in *Qualitex Co. v. Jacobson Products Co., Inc.*<sup>248</sup> illustrates how the law can accommodate the illocutionary use of a functional feature.<sup>249</sup> The basic purpose of trademark law aims to allow consumers to distinguish a particular maker's goods or services from those of others.<sup>250</sup> Qualitex had manufactured distinctively colored pads used by dry cleaners for some time when a rival began selling similarly colored pads. These pads were colored to hide stains,<sup>251</sup> but served to identify Qualitex as their manufacturer.<sup>252</sup> The traditional rule held that a color could only be trademarked as part of a distinctive design,<sup>253</sup> partly because color was considered func-

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247. One might shift “functionality” from software itself to its form of expression, i.e. programming languages, which are also tools. But we're simply pushing the fallacy down a level.

248. 514 U.S. 159 (1995).

249. *See id.* at 164 (“The functionality doctrine prevents trademark law . . . from inhibiting legitimate competition by allowing a producer to control a useful product feature” for longer than if the feature were protected by patent.”).

250. *See id.* at 162.

251. *See id.* at 166; Peter Koebler, Note, *Qualitex Co. v. Jacobson Products Co.*, 115 S. Ct. 1300 (1995): *It is Possible to Trademark Color Alone*, 12 COMPUTER & HIGH TECH. L.J. 509, 516 (1996).

252. *See Qualitex*, 514 U.S. at 166.

253. *See Koebler, supra* note 251, at 509. A few circuits had departed from this rule. *See id.* at 510.

tional.<sup>254</sup> Following this rule, the Ninth Circuit held that Qualitex could not register its “color alone” as a trademark. On appeal, the Supreme Court reversed and held that no such *per se* bar existed because colors can identify the source of a good. In other words, a mark’s ontological status as a color, fragrance, word or sign is irrelevant to this basic purpose.<sup>255</sup> The Court thus recognized that ontology does not determine functionality. The ontological status of a mark—what it is, whether color or words—tells us little about whether it is a trademark. Indeed, to use something intentionally “as a mark” is analogous to the speech act of identifying oneself as a work’s author.<sup>256</sup> Therefore, the ontological status of software should not determine whether the First Amendment covers software. What matters is how software is used in an act.

Human actions are usually described in reference to intentions. To think about First Amendment coverage as attaching to things obscures the role of intentions in a way that thinking of First Amendment coverage as attaching to speech acts does not. Many critics appear mesmerized by the belief that they must categorically decide what kind of thing software is.<sup>257</sup> Some believe that people can not use source code to communicate. Some ignore the possibility that an actor can intend to communicate software for its meaning or content—as text, not tool—because that possibility is not the “normal” thing people do with software.<sup>258</sup> These approaches beg the question because they focus on software’s “nature” as a thing. Actors, not things, intend to speak.

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254. Trademark law recognizes two main kinds of functionality. Utilitarian functionality refers to a feature that affects the use, purpose, cost or quality of the product. *See Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 850 n.10 (1982). Aesthetic functionality refers to features that make products more aesthetically attractive to consumers. *See Koebler*, *supra* note 251, at 515-16. The traditional rule also relied on theories of “color depletion” and “shade confusion.” *See Qualitex*, 514 U.S. at 167-69 (rejecting both theories).

255. *See Qualitex*, 514 U.S. at 164.

256. Conversely, not identifying oneself as a speaker—speaking anonymously—is also a speech act. *See McIntyre v. Ohio Elections Comm’n*, 514 U.S. 334, 342 (1995) (“[A]n author’s decision to remain anonymous, like other decisions concerning omissions or additions to the content of a publication, is an aspect of the freedom of speech protected by the First Amendment.”).

257. *See, e.g., Bernstein IV*, 176 F.3d 1132, 1148 (9th Cir. 1999) (Nelson, J., dissenting) (noting that “[w]hile it is conceptually difficult to categorize encryption source code under our First Amendment framework, I am still inevitably led to conclude that encryption source code is more like conduct than speech” because “it is inherently a functional device.”); *Junger v. Daley*, 8 F. Supp. 2d 708, 716 (N.D. Ohio 1998), *rev’d and remanded*, No. 98-4045, 2000 U.S. App. LEXIS 6161 (6th Cir. Apr. 4, 2000).

258. *See Junger*, 8 F. Supp. 2d at 716.

## c) "Its Effects Are Unlike Those of Other Forms of Speech"

The government's main argument in *Bernstein* focused on the fact that, when it is executed, software enables people to do things. Because of this "executable" characteristic, the government contends that software differs from works covered by the First Amendment. Many works of expression, however, provide ways of achieving a certain result because they are intended to be "executed."<sup>259</sup> Choreography, musical scores, and stage direction are just a few examples of such works.<sup>260</sup> Within the context of a Shakespearean play, every line of dialogue represents an instruction to the actor to utter the words on the page. Similarly, musical scores provide instructions to the musicians who read them. Indeed, one can "execute" Bach's score on an organ or on a computer, given the proper medium and form.<sup>261</sup> To take this argument a step further, many simple facts enable people to do things. If I want to call someone, I need a fact—a phone number. If I ask someone for a phone number and he replies "123-4567," the respondent has performed the speech act of stating the phone number. And yet it would seem ludicrous to claim the act of saying a phone number is not protected simply because I now can execute the act of calling on a telephone. To allow the government to regulate software based only on this characteristic means that the government may control many works covered by the First Amendment.

A more sophisticated version of this argument concedes that much speech conveys a capacity to do something, but notes that in general such capacities are mediated by human agency.<sup>262</sup> According to this argument, software differs from such speech because it does not require human action.

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259. See generally Jane Ginsburg, *Four Reasons and a Paradox: The Manifest Superiority of Copyright over Sui Generis Protection of Computer Software*, 94 COLUM. L. REV. 2559 (1994).

260. See Jessica Litman, *Copyright in Stage Direction of a Broadway Musical*, 7 COLUM.-VLA J.L. & ARTS 309, 312-18 (1982).

261. See Peter Suber, *What is Software?*, 2 J. SPECULATIVE PHIL. 89, 90 (1988) (asking "[i]s Bach's written score to the *Art of the Fugue*, perhaps with a human interpreter thrown in, the software of an organ?"); Balkin & Levinson, *Hermeneutic*, *supra* note 59, at 1531 (noting that "[a] Beethoven symphony is more than a set of marks on a page; its score is merely a set of directions for performance").

262. See Brief for the Appellants at 27-28, *Bernstein v. United States Dep't of Justice*, 176 F.3d 1132 (9th Cir. 1999) (No. 97-16686) ("[R]ecipients of encryption source code do not have to be able to read and understand it in order to use it. . . . [but] a recipe cannot be used to make a casserole or a cake unless it is read by a person who understands the information it contains.").

The proper question, however, is whether this “executable” capacity is conveyed differently from publishing other information. The government seems to think so. At one point, it argued that a recipe for a cake is not a cake, but software is both the recipe and the cake.<sup>263</sup> This argument appears far too sweeping. Software is not a cake. Just as a recipe for a cake does not become a cake without a baker, encryption software does not perform without a person to use it. Only if it is used by a person, on a computer, will it have these effects.<sup>264</sup> If someone publishes bomb-making information, it only has effects if someone else uses it to make a bomb. The effects always run through a person’s use of it.

An important part of this more sophisticated argument depends on the fact that software can be used without being read or comprehended. Focusing on this point, the government would argue that the bomb manual and software situations differ because a person’s understanding of the manual can mediate its harmful effects, whereas encryption software can create damaging effects without any human agency. It is unclear how or why this difference matters to a coverage analysis. Let us take leafletting as an illustration. People have a tendency to create litter by tossing leaflets on the street. This harm has a non-communicative effect because it is unnecessary for people to read the leaflet before they litter. The harm arises without mental mediation and occurs whether or not the leaflet conveyed a message. Most likely, the litterers largely consist of those who did not read the leaflet. By the government’s argument, leafletting is not a covered speech act because many people would discard them on the street without reading them. Clearly, this argument sounds specious.

The issue, in short, is what people can do with computers, because executability is not really about software. Cutting to the heart of the matter, the court in *Bernstein IV* observed that computers will soon be able to respond directly to spoken commands.<sup>265</sup> Computers would then execute all sorts of commands or queries without any need for the mediation of a programming language. At that point, it would sound strange to say that the First Amendment does not cover some speech simply because a computer could execute it. If I ask my daughter to turn up the heat, I have performed a speech act even if I use the same words to command a computer-controlled thermostat. Thus, software is merely a procedure written in a language that today’s computers can understand.

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263. *See id.* at 28.

264. I’m ignoring “autonomous” software, like viruses, which can simply be “released” onto computers or the Internet and wreak havoc. Arguably, infecting a computer with a virus is no more a speech act than infecting a person with a virus.

265. *See Bernstein IV*, 176 F.3d 1132, 1142 (9th Cir. 1999).

Executability is not merely a logical property of software, in the same way that "speechness" is not a logical property of sounds or marks. When we discuss executability, we discuss what people can do with computers. We do not talk about what software does in isolation. For coverage purposes, we should not treat functionality any differently from the risks of information use or abuse in First Amendment jurisprudence. A person can use a bomb-making manual to kill people or can use software to do something harmful. Standard doctrine already permits regulation of these sorts of effects, even though the causal chain runs through reading or understanding.<sup>266</sup>

## 2. *Revisiting the Government's Argument in Bernstein: Functionality and Protection*

If the First Amendment covers some software acts as speech acts, we must then determine what level of scrutiny should apply to any functionality-based regulation of software speech acts. The government approaches this question by arguing that any statute that criminalizes the publication of encryption source code based on its functionality is content-neutral.<sup>267</sup> Under this approach, even if source code can sometimes be speech, its functionality is a non-communicative aspect of software or a non-communicative effect of software acts.<sup>268</sup> Therefore, only intermediate scrutiny should apply to this statute.<sup>269</sup>

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266. See, e.g., *NAACP v. Claiborne Hardware*, 458 U.S. 886, 915-20 (1982) (finding civil liability for speech acts requires both causation and specific intent); *New York Times v. United States*, 403 U.S. 713, 730 (1971) (Stewart, J., concurring) (obtaining an injunction against publication requires showing of direct, immediate, irreparable harm to national security); *Brandenburg v. Ohio*, 395 U.S. 444 (1969) (per curiam) (defining punishable incitement to violence in terms of both likelihood and imminence of harm and speaker intent).

267. This question does not squarely arise in *Bernstein* and its companion cases because the export licensing scheme, as a prepublication licensing scheme, is an unconstitutional prior restraint under *Freedman v. Maryland*, 380 U.S. 51, 58-60 (1965), and *City of Lakewood v. Plain Dealer Publishing Co.*, 486 U.S. 750 (1988).

268. The line between communicative and noncommunicative effects is unclear. See discussion of "secondary effects" in which Williams generally defines a communicative impact as "a harm that would not occur unless a message were being sent and received," but also recognizes a subcategory of harms "that do[] not depend on the content or viewpoint of the message, only on the fact that it is intended and understood as a message." Susan Williams, *Content Discrimination and the First Amendment*, 139 U. PA. L. REV. 615 n.180 (1991) (using example of heckling and distinguishing unintended interferences with speaking like loud coughing). A law that prohibits heckling aims at a speech act and at its communicative impact, but is not content-based.

269. See *Turner Broadcasting System, Inc. v. FCC*, 512 U.S. 622, 642 (1994).

This way of thinking is erroneous for two reasons. First, functionality makes little sense as an analytical concept other than as a proxy for effects or harm. First Amendment doctrine already has the tools to address the harm that may result from speech acts. It does not need a distinct functionality doctrine.<sup>270</sup>

Second, the inquiry should focus on software acts, not software. To focus on software as a thing confuses software with what people do with software. It is like confusing money with what people do with money, or sound with what people do with sound. Although misused software can cause harm and the effects of using software can be non-communicative, publishing software differs from using software. Indeed, thinking of software as a thing increases the chances of confusing agency and thus responsibility: The speaker is not the user. First Amendment doctrine requires not only careful distinctions among acts, but also among actors.<sup>271</sup> Publishing information that may be misused does not logically entail that the publisher intended the harm, and the Court has generally required a showing that the speaker did so intend.<sup>272</sup> Thinking in terms of “what software does” permits the careless attribution to the publisher of the audience’s possible misuse of software.<sup>273</sup> It is not exactly the “heckler’s veto”<sup>274</sup> or “bad tendency”<sup>275</sup> but it is close.

Finally, to the extent that functionality must fit into the rubric of “content-based” vs. “content-neutral” regulation, functionality-based regulation

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270. Nevertheless, commentators have long noted that it can be difficult to draw a line between government’s concern about a message and about the message’s consequences. “[W]hen one does not ‘like’ an idea, it is as often as not because one does not like what would happen if people agreed with it.” Geoffrey R. Stone, *Restrictions of Speech Because of its Content: The Peculiar Case of Subject-Matter Restrictions*, 54 U. CHI. L. REV. 81, 104 n.116 (1978).

271. See, e.g., *NAACP v. Claiborne Hardware Co.*, 458 U.S. 886, 916-17 (1982) (action for damages arising from boycott protesting racism) (“[T]he presence of activity protected by the First Amendment imposes restraints on the grounds that may give rise to damages liability and on the persons who may be held accountable for those damages.”).

272. See, e.g., *Brandenburg v. Ohio*, 395 U.S. 444 (1969) (defining unprotected “incitement” in terms of intent).

273. See, e.g., *Karn v. United States Dep’t of State*, 925 F. Supp. 1, 11 (noting that “proliferation of cryptographic products will make it easier for foreign intelligence targets to deny the United States Government access to information vital to national security”), *remanded* 107 F.3d 923 (D.C. Cir. 1997).

274. See *Edwards v. South Carolina*, 372 U.S. 229, 237 (1963) (finding speech protected against regulation on the basis of hostile audience reaction, the so-called heckler’s veto).

275. For a description of the old bad tendency test, see David M. Rabban, *The Emergence of Modern First Amendment Doctrine*, 50 U. CHI. L. REV. 1205, 1229-31 (1983).

is much closer to content-based than content-neutral regulation for the simple reason that the content of software is inextricable from its functionality.

a) Standard Doctrines About Effects and Causation Can Handle Any Issue of Functionality

The government argues that, even if software is “speech,” software is also functional. Therefore, *O’Brien* allows the regulation of software based on its functionality. The government’s concern with functionality concentrates on the possible harmful effects of a person’s use of the software. However, First Amendment doctrines that revolve around causation and moral agency already address the risks of harm from speech acts. As an attempt to craft a new doctrine, functionality is flawed because it ignores how harm is caused or who is responsible for it.

i) Causation and Functionality

The government’s functionality argument derives from the idea that, regardless of their expectation or intent, when Alice publishes encryption source code, she causes harm because the source code can be used by foreign persons to frustrate the gathering of intelligence overseas.<sup>276</sup> The First Amendment is concerned with causation,<sup>277</sup> but that concern is more complex than the government suggests. In general, it is foreseeable that some information, when widely disseminated, will cause harm through unlawful or dangerous misuse.<sup>278</sup> It is, however, well-settled that the foreseeability of harm from general publication is not enough to hold the speaker responsible for the resulting harm.<sup>279</sup>

The reason is fairly obvious. When information is published to everyone, it is arguably foreseeable that someone, somewhere, will misuse the information.<sup>280</sup> Thus, if a quantitative expectation of harm were all that mattered, the government could always justify any harm-based regulation

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276. See Brief for the Appellants at 33 n.13, *Bernstein v. United States Dep’t of Justice*, 176 F.3d 1132 (9th Cir. 1999) (No. 97-166861) (“Even if the person exporting the software does not intend or expect that the software will be used for purposes contrary to this country’s national security and foreign policy interests, he has no direct control over the use to which the software will be put once it has been exported, particularly if the software is made available for unrestricted downloading via the Internet.”).

277. See, e.g., *Claiborne*, 458 U.S. at 918.

278. See generally Schauer, *supra* note 130 (discussing speech-caused harms and the differences between causation in ordinary tort law and First Amendment law).

279. See *The Florida Star v. B.J.F.*, 491 U.S. 524, 540 (1989) (“Where important First Amendment interests are at stake, the mass scope of disclosure is not an acceptable surrogate for injury.”).

280. See Schauer, *supra* note 130, at 165 n.90.

of information dissemination to a mass audience. So long as we believe that the First Amendment seeks to encourage publication, this sort of quantitative approach stands the First Amendment on its head.

Accordingly, courts have generally found that the First Amendment prohibits the imposition of criminal or civil liability for distributing or publishing potentially misusable information. When viewers or readers mimicked unlawful or dangerous conduct that had been depicted or described, the courts have refused to impose any liability on the original speaker.<sup>281</sup> Similarly, the First Amendment applies when persons who followed "how-to" instructions suffered allegedly foreseeable injuries,<sup>282</sup> or when written or visual depictions alter persons' attitudes such that they are more likely to engage in criminal or dangerous behavior.<sup>283</sup>

If the usual First Amendment approach to causation and foreseeability applied to Alice, the government could not hold her responsible for publishing encryption source code merely because it was foreseeable that some recipients might cause harm by misusing it. Existing doctrine focuses primarily on the quality of the causal chain linking the speaker's conduct to the ultimate harm. For instance, Professor Nimmer has suggested that the government may restrict expressive conduct based on a governmental interest in regulating a non-communicative effect.<sup>284</sup> Yet he

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281. See, e.g., *Herceg v. Hustler Magazine, Inc.*, 814 F.2d 1017 (5th Cir. 1987) (holding that the First Amendment bars liability against magazine where reader accidentally committed suicide while attempting technique of autoerotic asphyxiation described therein), *cert. denied*, 485 U.S. 959 (1988); *Yakubowicz v. Paramount Pictures Corp.*, 536 N.E.2d 1067 (Mass. 1989) (finding that the First Amendment bars liability against producer of motion picture where viewers killed a youth while allegedly imitating the violence depicted therein).

282. See, e.g., *Smith v. Linn*, 563 A.2d 123 (Pa. Super. Ct. 1989) (finding that the First Amendment barred liability against publisher of diet book after reader died as result of following diet), *aff'd mem.*, 587 A.2d 309 (Pa. 1991); *Alm v. Van Nostrand Reinhold Co.*, 480 N.E.2d 1263 (Ill. App. Ct. 1985) (holding that the First Amendment barred liability against publisher of "how-to" book where reader had been injured while following instructions therein). The one notable exception is the line of cases involving airplane navigational charts. See *Brocklesby v. United States*, 767 F.2d 1288, 1294-95 (9th Cir. 1985).

283. See, e.g., *American Booksellers Ass'n v. Hudnut*, 771 F.2d 323, 328-29 (7th Cir. 1985) (statute permitting civil liability against producers of depictions of sexually explicit subordination of women is unconstitutional, even accepting the premises that "[m]en who see women depicted as subordinate are more likely to treat them so" and that people are likely to "act in accordance with the images and patterns" they find in such expression), *aff'd mem.*, 475 U.S. 1001 (1986); *Video Software Dealers Ass'n v. Webster*, 968 F.2d 684 (8th Cir. 1992) (invalidating on constitutional grounds state statute prohibiting the sale or rental to minors of videos "depicting violence").

284. See Nimmer, *supra* note 26, at 39.

qualified that suggestion by referring to the causal link between the speech act and the asserted interest: The conduct must materially and substantially interfere with that interest<sup>285</sup> or be likely to imminently do so.<sup>286</sup> Thus, we can categorize various verbal crimes or torts by the length of the causal chain. With acts like threats or assault, perjury, or criminal fraud, the speech act directly causes the harm. In other words, no third party must act for the harm to occur. In other cases, the speech does not inflict injury. Rather, it inspires or facilitates the receivers' wrongful acts, such as the incitement in *Brandenberg*.<sup>287</sup>

*NAACP v. Claiborne Hardware*<sup>288</sup> provides an example of the importance of a quality causal chain. At issue was the NAACP's liability to local merchants for losses caused by a politically motivated boycott.<sup>289</sup> After finding that the First Amendment protected the boycott activity but not the violence itself,<sup>290</sup> the Court focused on causation by stating that civil liability was available only for losses "proximately caused by unlawful conduct."<sup>291</sup>

Like *Claiborne Hardware*, the problem with the functionality argument lies in the fact that the causal chain is too long and too speculative. Licensing encryption software exports supposedly protects the government's interest in conducting signals intelligence abroad by preventing foreign persons from receiving and using U.S. encryption software. The government's path to the harm follows this doubtful reasoning: (1) Alice publishes her software; (2) foreign persons get and use it; (3) some of these foreign persons are targets of U.S. signals intelligence; (4) U.S. surveillance of these persons is frustrated. Alice's publication does not "directly" cause the ultimate harm of frustrating U.S. signals intelligence,

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285. *See id.* at 43 (quoting *Tinker v. Des Moines Indep. School Dist.*, 393 U.S. 503, 509 (1969)).

286. *See id.* at 44.

287. 395 U.S. 444 (1969) (per curiam).

288. 458 U.S. 886 (1982).

289. The Mississippi Supreme Court found liability on a common-law tort theory. Based on evidence that fear of reprisals caused some black citizens to withhold their patronage from respondents' businesses, the court held that the entire boycott was unlawful and affirmed petitioners' liability for all damages "resulting from the boycott" on the ground that petitioners had agreed to use force, violence, and "threats" to effectuate the boycott. *See id.* at 894-895. The record showed that there were some incidents of violence. *See id.* at 902-06.

290. *See id.* at 916-17.

291. *Id.* at 918 (citations omitted).

given the number of links in the causal chain. Moreover, the government would need considerable evidence to establish each link in the chain.<sup>292</sup>

Finally, the functionality approach is especially troubling in that it sweeps all software within its rationale. On the government's terms, software is functional. The court should thus review such regulation based on an intermediate scrutiny, whether or not the software poses any risk of harm to a government interest. In other words, the government invokes "functionality" to escape the burden of establishing a sound causal chain. Instead of having to actually show that software publication is likely to cause harm, the government only needs to rely on software's having a "bad tendency."<sup>293</sup> The First Amendment should not condone such an attempt to circumvent its policy.

## ii) Moral Agency and Intent

The Court is concerned about the quality of the causal chain that leads to the feared harm. In particular, it inquires into how the effects relate causally to the speaker's act. This seemingly consequentialist concern also includes a concern for moral agency.<sup>294</sup> The functionality approach effaces the role of moral agency by conflating the speaker's act of saying something with the audience's act of doing something.

This concern is often understood in terms of intent.<sup>295</sup> Crimes like facilitation, encouragement, and solicitation generally require a showing that the speaker had a sufficiently bad intent that we may impute responsibility

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292. Whether the government would be willing to submit evidence describing the nature and extent of its signals intelligence activities overseas is, of course, an open question.

293. See *Abrams v. United States*, 250 U.S. 616, 621 (1919) (noting that "[m]en must be held to have intended, and to be accountable for, the effects which their acts were likely to produce").

294. See *NAACP v. Claiborne*, 458 U.S. 886, 916-17 (1981) (noting that the First Amendment "imposes restraints . . . on the persons who may be held accountable"). Another expression of the concern for moral agency is the anti-paternalism principle often seen in commercial speech cases. Under this principle, commercial speakers may not be regulated for truthful, nonmisleading speech simply because listeners may act unwisely. See *Virginia Bd. of Pharmacy v. Virginia Citizens Consumer Council, Inc.*, 425 U.S. 748, 770 (1976) (rejecting "highly paternalistic" argument that consumers will misuse accurate price information).

295. See, e.g., *United States v. X-Citement Video, Inc.*, 513 U.S. 64, 73 n.3 (1994) (examining whether the defendant could be convicted for trafficking in child pornography absent knowledge that the performer was a minor and noting that "[c]riminal intent serves to separate those who understand the wrongful nature of their act from those who do not, but does not require knowledge of the precise consequences that may flow from that act once aware that the act is wrongful").

for the ultimate act to the speaker.<sup>296</sup> The courts have also imposed a scienter requirement on the arms export control regulations to save them from unconstitutionality.<sup>297</sup> As exemplified by *Claiborne*,<sup>298</sup> moral agency becomes especially important where individuals are punished or disadvantaged for being members of supposedly dangerous groups. In that context, the Court made clear that liability should not apply merely because one belongs to a group with both legal and illegal aims.<sup>299</sup> Liability for association with another should apply only if the individual being sanctioned specifically and clearly intends to further the group's illegal aims.<sup>300</sup> The flip side of this concern with moral agency and intent is that the government may regulate a speech act that has become associated with such intent<sup>301</sup> and has a certain force.<sup>302</sup> This is perfectly consistent with the speech-act approach.

### iii) Summary: The Government's Argument Is Flawed

The government's functionality argument is unnecessary and unsound. The government simply wants to prevent certain harms, but existing doctrine already addresses any potential harm caused by speaking. The government's notion of functionality conflicts with the basic principles of causation and moral agency. Functionality-based regulation of encryption

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296. See *Abrams v. United States*, 250 U.S. at 627 (Holmes, J., dissenting). That moral agency matters in an act-oriented approach to the First Amendment ought not be surprising. See generally Christina Wells, *Reinvigorating Autonomy: Freedom and Responsibility in the Supreme Court's First Amendment Jurisprudence*, 32 HARV. C.R.-C.L. L. REV. 159 (1997); David Dow, *The Moral Failure of the Clear and Present Danger Test*, 6 WM. & MARY BILL OF RTS J. 733 (1998).

297. See *United States v. Edler Indus. Inc.*, 579 F.2d 516, 519-21 (9th Cir. 1978) (noting that in order to prevent ITAR restrictions on information with both peaceful and military applications from "imped[ing] scientific research and publishing and ... international scientific exchange," defendant "must know or have reason to know that its information is intended for the prohibited use").

298. See *Claiborne*, 458 U.S. at 918-19. The Court in *Claiborne* relied heavily on older cases upholding the constitutionality of a statute criminalizing membership in group that advocates overthrow of government by violence with knowledge of and specific intent to further the illegal aims. See *Noto v. United States*, 367 U.S. 290 (1961) (reversing conviction for insufficient evidence); *Scales v. United States*, 367 U.S. 203 (1961) (finding sufficient evidence to uphold conviction for being member of Communist Party).

299. See *Claiborne*, 458 U.S. at 920.

300. See *id.* at 919-20.

301. See *Ohralik v. Ohio State Bar Ass'n*, 436 U.S. 447, 456 (1978).

302. See *Yates v. United States*, 354 U.S. 298, 320-21 (1957) (distinguishing "between advocacy of forcible overthrow as an abstract doctrine and advocacy of action to that end" and holding that mere doctrinal justification of forcible overthrow was "too remote from concrete action").

software does not even protect the government's interest, as exemplified by the regulation of non-software cryptographic communications as "technical assistance."<sup>303</sup> Simply put, the government uses software's functionality as a ploy to impute responsibility to software speakers for others' possibly harmful acts.<sup>304</sup>

#### b) Functionality and the Level of Scrutiny

Although the formulations are imprecise, an array of doctrines suggests that the government has more leeway to regulate speech on the basis of its non-communicative aspects.<sup>305</sup> Software's functionality could be a "nonspeech element"<sup>306</sup> that warrants lesser scrutiny for regulation of software speech acts. In more contemporary doctrine, in which government purpose is the "threshold consideration,"<sup>307</sup> functionality-based regulation may be content-neutral because it is not based on "communicative impact."<sup>308</sup> Alternatively, the courts may consider the effects associated with software's functionality as "secondary effects," and find any regulation aimed at secondary effects justified without reference to content.<sup>309</sup>

Commentators have criticized these doctrines because the Court seems to have shifted from a catholic view of the dangers of content-based and effect-focused discrimination to a narrower view focused mainly on government purpose.<sup>310</sup> Professor Stone, on the other hand, has argued that

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303. 15 C.F.R. § 744.9 (1996).

304. See *Thomas v. Collins*, 323 U.S. 516, 547 (1945) (Jackson, J., concurring) (noting that "[m]odern inroads on [First Amendment] rights come from associating the speaking with some other factor which the state may regulate so as to bring the whole within official control").

305. See Geoffrey Stone, *Content-Neutral Restrictions*, 54 U. CHI. L. REV. 46, 48-51 (1987) (identifying seven different standards of review that lead to three levels of scrutiny for content-neutral regulations).

306. See, e.g., *R.A.V. v. City of St. Paul*, 505 U.S. 377, 386 (1992) (finding a "noisy sound truck" to be a nonspeech element similar to the characterization of fighting words).

307. See *Madsen v. Women's Health Center, Inc.*, 512 U.S. 753, 763 (1994). But see *Minneapolis Star & Tribune Co. v. Minnesota Comm'r of Revenue*, 460 U.S. 575, 592 (1983) (stating that "[i]llicit legislative intent is not the sine qua non of a violation of the First Amendment"); accord *Simon & Schuster v. New York State Crime Victims Bd.*, 502 U.S. 105, 117 (1991).

308. *Ward v. Rock Against Racism*, 491 U.S. 781, 791 (1989) (stating that it is "justified without reference to the content of the regulated speech"). The Court often uses an alternative formulation—"whether the government has adopted a regulation of speech because of disagreement with the message it conveys"—but this seems quite different. *Id.* at 791.

309. See *Renton v. Playtime Theatres, Inc.*, 475 U.S. 41, 48 (1986).

310. See, e.g., *Williams*, *supra* note 268, at 617-18 (finding that a narrow focus on content-based discrimination concentrated on government purpose ignores other types of

content-based discrimination is largely concerned with improper government motivation.<sup>311</sup>

Speech act analysis differs a bit from these views. First, in the software setting, functionality-based regulation is essentially content-based regulation. Second, these various “noncommunicative effects” doctrines pose serious questions about causation and moral agency. Third, concentrating on software speech acts, the distinction between communicative and noncommunicative effects only justifies intermediate scrutiny if it is possible to distinguish them from each other in the first place.<sup>312</sup> Because software is always “functional,” regulation of software for its functionality proves too much.

### i) Functionality and the Notion of Content

The government may argue that all software is functional and that functionality-based regulation is not content-based regulation. If the government were right, then such regulation of software would not be subject

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discrimination resulting in “systematic underprotection of speech and serious doctrinal confusion”); Keith Werhan, *The O’Briening of Free Speech Methodology*, 19 ARIZ. ST. L.J. 635, 649-58 (1988) (criticizing Court’s use of O’Brien balancing for direct as opposed to incidental content-neutral restrictions); David S. Day, *The Incidental Regulation of Free Speech*, 42 U. MIAMI L. REV. 491, 529-30 (1988) (concluding that O’Brien doctrine is a failure and raises danger that Court will review more content-based restrictions under intermediate scrutiny). On the other hand, some commentators argue that intermediate scrutiny is internally incoherent. *See, e.g.*, Larry Alexander, *Trouble on Track Two: Incidental Regulations of Speech and Free Speech Theory*, 44 HASTINGS L.J. 921 (1993) (arguing that intermediate scrutiny requires courts to value speech, which is inconsistent with the First Amendment).

311. *See* Stone, *supra* note 305, at 48-51 (“When a restriction is content-based, the risk of improper motivation is especially high . . .”). A recent article revives and expands on Professor Stone’s basic insight that concern for illicit government purpose underlies the general shape of First Amendment analysis. *See generally* Elena Kagan, *Private Speech, Public Purpose: The Role of Governmental Motive in First Amendment Doctrine*, 63 U. CHI. L. REV. 413, 414 (1996) (“First Amendment law, as developed by the Supreme Court over the past several decades, has as its primary, though unstated, object the discovery of improper governmental motives.”).

312. *See* Williams, *supra* note 268, at 618 (“As a general rule . . . noncommunicative effects will usually be independent of the message.”). The obvious rejoinder is that every speech act is unique and that ostensibly noncommunicative aspects of the act, like its time, place or manner are often integral to the act’s propositional meaning and illocutionary force. Williams attempts to use the concept of the “facilitative” aspects of speech acts to create distinctions within the broad category of noncommunicative aspects. In her view, for instance, regulation of either expressive or facilitative aspects of speech acts are not “indirect” or “incidental” regulation. *See id.* at 723.

to strict scrutiny. This subpart argues that functionality is or should be treated as content.<sup>313</sup>

I will begin with the distinctions drawn by the export regulations. The export regulations subject to licensing many technologically-defined categories of items, including hardware, software, and information.<sup>314</sup> In general, however, software and information may be made “publicly available” and thus rendered “not subject to the EAR.”<sup>315</sup> Only two exceptions to the “public availability” exemption exist. First, the EAR does not accord the same treatment to encryption software as it does to other software.<sup>316</sup> Only encryption software requires a license for publication, while all other software subject to export controls does not need such a license. Second, the regulations control cryptographic information differently from other information. For example, providing technical assistance to a foreign person about encryption requires a license.<sup>317</sup>

The regulatory structure demonstrates two things. First, software’s functionality is not an undifferentiated whole. Although the government argues that all software is functional, it excludes only encryption software from public availability on the basis of its functionality. Second, the government is not only targeting the functionality of encryption software. If technical assistance about cryptography that only involves information poses the feared harm, then the government is concerned about effects of cryptographic information that are unrelated to software’s functionality.<sup>318</sup>

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313. My use of the term “content” here includes other bases for discrimination that the Court has found to trigger strict scrutiny, such as discriminating among speakers and media or format. Medium-based discrimination doesn’t always trigger strict scrutiny, but it can. *See id.* at 620.

314. *See generally* 15 C.F.R. § 774 (1996) (setting forth categories of items subject to EAR).

315. 15 C.F.R. § 734.3 (1996).

316. 15 C.F.R. § 774 (1996) (“Encryption software is controlled because of its functional capacity, and not because of any informational value of such software; such software is not accorded the same treatment under the EAR as other ‘software’ . . . . Encryption software controlled for EI reasons under this entry remains subject to the EAR even when made publicly available in accordance with part 734 of the EAR . . . .”).

317. *See* 15 C.F.R. § 744.9(a) (1996). No comparable restriction exists for other information subject to the EAR.

318. *See City of Ladue v. Gilleo*, 512 U.S. 43, 52 (1994) (“Exemptions from an otherwise legitimate regulation of a medium of speech may be noteworthy for a reason quite apart from the risks of viewpoint and content discrimination. They may diminish the credibility of the government’s rationale for restricting speech in the first place.”). The government might argue that the act of communicating information intending to assist someone in writing encryption software conveys capacity as much as conveying the software itself. But this argument undermines the entire functionality premise: the gov-

In short, the EAR initially subjects much software and information to its control, but releases most of it upon publication.

The EAR scheme is thus a more complex version of the situation in *Police Department of Chicago v. Mosley*,<sup>319</sup> where an ordinance banned all peaceful picketing near schools except peaceful school-related labor picketing.<sup>320</sup> Instead of a broad restriction with a narrow exemption, the EAR scheme is a broad restriction with broad “public availability” exemptions. Yet, it has a narrow exception to these broad exemptions. Therefore, the EAR impermissibly targets cryptography as “subject-matter.”<sup>321</sup> The EAR permits computer scientists and programmers to publish algorithms in source code form in any subject, unless the algorithms are cryptographic.<sup>322</sup>

Subject-matter restrictions lie in a gray area between content-based and content-neutral restrictions.<sup>323</sup> At least three distinct themes underlie the general prohibition against content-based discrimination: a preference for more speech,<sup>324</sup> improper government motives,<sup>325</sup> and distortion of public discourse.<sup>326</sup> One commentator has argued that subject-matter re-

ernment would have to admit that its concern is with the effects of the act, not the functionality of the thing being conveyed.

319. 408 U.S. 92 (1972).

320. *See id.* at 92.

321. *See generally* Stone, *supra* note 270. *Cf. Mosley*, 408 U.S. at 95 (“The central problem with Chicago’s ordinance is that it describes permissible picketing in terms of subject matter.”).

322. That the government regulates cryptographic technical assistance—which needn’t involve conveying a “functional” item—makes it even clearer that it targets cryptography as a subject.

323. The Court in *Mosley* “proceeded on the assumption that subject-matter restrictions are to be treated no differently than other sorts of content-based restrictions.” Stone, *supra* note 270, at 86. In later cases, the Court “had considerable difficulty . . . with restrictions that, although content-based, are defined in terms of expression about an entire subject rather than a particular viewpoint or idea.” *Id.* at 99. Matters are not much clearer today. In *City of Cincinnati v. Discovery Network, Inc.*, 507 U.S. 410 (1993), the Court easily found regulations that banned only newsracks dispensing commercial handbills to be content-based for the “commonsense” reason that “whether any particular newsrack falls within the ban is determined by the content of the publication resting inside that newsrack.” *Id.* at 429. On this reasoning, the encryption export regulations are obviously content-based.

324. This theme is clearest in cases of medium-based discrimination. *See City of Ladue v. Gilleo*, 512 U.S. 43, 55 (1994) (“Although prohibitions foreclosing entire media may be completely free of content or viewpoint discrimination . . . by eliminating a common means of speaking, such measures can suppress too much speech.”).

325. *See Williams*, *supra* note 268, at 624-28 (discussing government purpose).

326. *See City of Ladue v. Gilleo*, 512 U.S. at 60 (O’Connor, J., concurring) (“[C]ontent-based speech restrictions are especially likely to be improper attempts to

restrictions are less likely to distort discourse and to be the product of government hostility toward expressed ideas.<sup>327</sup> He distinguishes, however, between subject-matter restrictions confined to a specific issue<sup>328</sup> and those directed against broad classes of speech by cutting across a wide spectrum of issues.<sup>329</sup> The former poses a compelling case for content-based scrutiny, while the latter is much closer to genuine content-neutral restrictions.<sup>330</sup>

A limitation based on cryptographic functionality operates as a content-based restriction. First, it only affects discourse about cryptography and thus will distort a narrow range of discourse. In the science community, where knowledge and theories are tested over time, subject-matter prohibitions not only tend to privilege existing viewpoints but also strike at the heart of the scientific method itself. For cryptography, the distortive effects will be even more pronounced. Peer review of encryption source code, in this context, is particularly important because people constantly seek to defeat information security. The discipline advances through sharing knowledge about the strengths and weaknesses of existing technology. Second, the restriction's narrow scope raises the suspicion that the government is discriminating on the basis of viewpoint.<sup>331</sup> The critical question as to motive focuses on whether officials would have adopted the restriction even if the restrictions aimed at speech that the officials supported.<sup>332</sup> Here, the government less stringently regulated its preferred type of encryption, thus indicating a likelihood of official self-interest.<sup>333</sup>

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value some forms of speech over others, or are particularly susceptible to being used by the government to distort public debate.”); Stone, *supra* note 305, at 217-27.

327. See Stone, *supra* note 270, at 108 (“In general, one is more likely to be hostile to speech espousing a specific point of view than to speech about an entire subject.”).

328. See *id.* at 109.

329. See *id.* at 112.

330. See *id.*

331. Some subject-matter restrictions may in fact have content-differential effects, but the effects are likely to be spread across a wide range of issues, making an illicit government motivation unlikely. In contrast, restrictions on specific subjects are so focused that the likelihood of government preference is high. See Stone, *supra* note 270, at 81, 109-12.

332. See Geoffrey R. Stone, *Content Regulation and the First Amendment*, 25 WM. & MARY L. REV. 189, 232 (1983). Professor Stone's analysis focuses on concerns about distortion of public debate, equality, communicative impact, and illicit government motivation. He ultimately concludes that improper motivation is the most important issue. For a more recent, similar view, see generally Kagan, *supra* note 311, at 431-32 (“This inquiry tests whether the government regulated, even in part, on the basis of ideas as ideas, rather than on the basis of material harms.”).

333. See Kagan, *supra* note 311, at 428-29 (arguing that harms to government “self-interest” are not cognizable as First Amendment harms). The government expressly pre-

Finally, implementing a subject-matter restriction in a highly discretionary administrative licensing scheme enhances the risks of content and viewpoint-based discrimination inherent in such schemes.<sup>334</sup>

Once we move from functionality as a general attribute of software to cryptographic functionality itself, functionality is like content. Regulation based on cryptographic functionality poses the same risks of distorting discourse and inciting improper government motive as do content-based regulations aimed at the subject of cryptography.<sup>335</sup> This is a significant distortion of discourse compared to the distortion that might affect content-based regulation of fighting words.<sup>336</sup>

## ii) Functionality as a Non-Communicative Aspect or Effect

The government could counter by arguing that cryptographic functionality is also a non-communicative aspect or effect of software. Arguably, regulation of software speech acts—justified by reference to the harm of

ferred so-called “recoverable” encryption, which was designed to permit law enforcement officials access to the plain text of encrypted messages. Obviously, this preference can be explained in terms of functionality: Such encryption doesn’t function to frustrate government surveillance. Just as obviously, a person who believes that the government shouldn’t be able to decrypt encrypted messages easily would be less likely to write recoverable encryption software.

334. See *City of Lakewood v. Plain Dealer Publ’g Co.*, 486 U.S. 750, 759 (1988) (noting that discretionary licensing schemes make it difficult for courts to “detect[], review[], and correct[] content-based censorship”). For the encryption export regulatory scheme to work, the government “must necessarily examine the content of the message conveyed.” *Forsyth City v. The Nationalist Movement*, 505 U.S. 123, 134 (1992) (quoting *Arkansas Writer’s Project, Inc. v. Ragland*, 481 U.S. 221, 230 (1987)).

335. Indeed, functionality-based regulation of all software would seriously distort discourse not only in computer science but in every other discipline that uses software. See *Stone*, *supra* note 305, at 58 (arguing that for content-neutral regulation, the central concern is “the extent to which a challenged law actually interferes with the opportunities for free expression”). Interference with opportunities, in turn, turns on two factors: the total quantity of debate, and interference with the speech of “particular groups, individuals, or causes.” *Id.* at 59. Regulation of all software might be neutral as to content, but would “unduly constrict the opportunities for free expression.” *Id.* at 58 (footnote omitted). See also *Martin v. City of Struthers*, 319 U.S. 141, 145 (1943) (noting that though a method of speaking may be “a blind for criminal activities, [it] may also be useful [to] members of society engaged in the dissemination of ideas in accordance with the best tradition of free discussion”).

336. See *Kagan*, *supra* note 311, at 419-20 (noting that while a restriction on racist fighting words will cause some distortion of protected discourse, “the concern with skewing the deliberative process continues to ring oddly, as it might if a law prevented one side of a debate from throwing brickbats at the other . . . there is something peculiar in saying that . . . the law harms the thinking process of the community”).

using software—is subject only to intermediate scrutiny because such harm is not communicative.<sup>337</sup> The most promising doctrinal paths<sup>338</sup> to intermediate scrutiny lie in the arguments that regulation of functionality aims at either non-communicative impact or secondary effects of software acts.<sup>339</sup>

Yet, these arguments are difficult to maintain for several reasons. First, these doctrines do a poor job of handling the issues of causation and moral agency. The doctrine of secondary effects is the clearest example of slipshod thinking about causation because its value depends on clearly conceptualizing the communicative impact of speaking.<sup>340</sup> Charitably formulated, the doctrine requires merely intermediate scrutiny of regulation aimed at any non-communicative effects that arise from the speech as a physical event in the world.<sup>341</sup> Certain kinds of effects are clearly primary, not secondary, effects. A listener's reaction to what someone says is not a content-neutral secondary effect.<sup>342</sup> Similarly, harms that arise from listen-

337. See *Ward v. Rock Against Racism*, 491 U.S. 781, 791 (1989) (“A regulation that serves purposes unrelated to the content of the expression is deemed neutral . . . .”) (citation omitted).

338. I ignore the *O'Brien* scenario, which involves a very specific setting: “when ‘speech’ and ‘nonspeech’ elements are combined in the *same course of conduct*.” *United States v. O'Brien*, 391 U.S. 367, 376 (1968) (emphasis added). On the Court's analysis, burning the draft card was the very act that frustrated the government's interest in preventing the destruction and assuring the continued availability of draft cards and the harm would exist even if the card were burned in private. Because the effects flow from the act itself, and not through any other person, *O'Brien* raised no issues of causation or moral agency. See also *Cohen v. California*, 403 U.S. 15, 18 (1971) (“[t]he only ‘conduct’ which the state sought to punish is the fact of communication. Thus, we deal here with a conviction resting solely upon ‘speech’”). I also ignore doctrines that focus on a medium's own effects, as in the sign cases. See *City of Ladue v. Gilleo*, 512 U.S. 43, 48 (1994) (“Unlike oral speech, signs take up space and may obstruct views, distract motorists, displace alternative uses for land, and pose other problems that legitimately call for regulation. . . . [G]overnments may regulate the physical characteristics of signs. . . .”). The arguments about encryption software have nothing to do with medium effects.

339. If, on the other hand, the harm is attributable to the communicative content, then the regulation aims at a “primary effect” or “direct impact,” and is therefore content-based and subject to strict scrutiny. See Post, *supra* note 9, at 1265. Outside the context of sexual speech, the Court has not upheld any regulation under the secondary effects doctrine. But cases like *Boos v. Barry*, 485 U.S. 312 (1988), and *Forsyth County, Ga. v. Nationalist Movement*, 505 U.S. 123 (1992), suggest that the Court might do so. See Kagan, *supra* note 311, at 483 n.190 (1996); Williams, *supra* note 268, at 633 (predicting that “an affirmative response by a majority of the Court may not be far off”).

340. See Post, *supra* note 9, at 1266.

341. See Williams, *supra* note 268, at 630.

342. See *Forsyth County, Ga. v. Nationalist Movement*, 505 U.S. 123, 134 (1992).

ers' acting on speech are not secondary effects.<sup>343</sup> Yet, the Court has upheld statutes restricting the location of theaters purveying sexually explicit materials—in contrast to theaters showing other types of movies—on the grounds that “adult” movie theaters cause their neighborhoods to deteriorate and become a focus of crime.<sup>344</sup> It is difficult to see how these effects could have been caused by anything other than the viewers' reaction to the content of the adult movies.<sup>345</sup>

Other attempts to clarify the line between primary and secondary effects are equally opaque. In *Boos v. Barry*,<sup>346</sup> Justice O'Connor described the effects in the adult theater cases as almost unique to theaters featuring sexually explicit films<sup>347</sup> and secondary effects as regulatory targets that

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343. See *Linmark Assoc., Inc. v. Township of Willingboro*, 431 U.S. 85, 94 (1977).

344. See *Renton v. Playtime Theatres, Inc.*, 475 U.S. 41, 44 (1986) (finding that zoning ordinance designed to prevent the occurrence of harmful effects like the crime associated with adult entertainment by protecting approximately 95% of the city's area from the placement of adult movie theaters); *Young v. American Mini Theatres, Inc.*, 427 U.S. 50, 71 n. 34 (1976) (Stevens, J., plurality op.) (“It is this secondary effect which these zoning ordinances attempt to avoid, not the dissemination of ‘offensive’ speech.”).

345. See Post, *supra* note 9, at 1267. Professor Williams argues that “[a] drop in property values is . . . a noncommunicative harm” in the sense that “[e]ven if all . . . who entered the ‘adult’ theater were deaf and blind . . . the property values in the neighborhood . . . would still drop as long as the business continued to operate.” Williams, *supra* note 268, at 631. This fanciful hypothetical makes no sense, since there's no reason to expect that any deaf and blind persons would even enter the theater, and in turn no reason to believe that this could be the city's purpose. Choosing to see a movie because it is an “adult” movie is as much a “reaction” to speech as being offended by viewing it. Indeed, Williams herself concludes that the ban on solicitation in *United States v. Kokinda*, 497 U.S. 720 (1990), was not justified by the non-communicative effect of congestion and inconvenience caused by solicitation because “[i]f the solicitation took place in a language unknown to the listeners, then no one would stop to give money to the speaker.” *Id.* at 634 n.85. Obviously, deaf and blind theater patrons and linguistically incompetent potential donors are analytically identical in these examples.

346. 485 U.S. 312 (1988) (O'Connor, J., plurality op.).

347. See *Boos*, 485 U.S. at 320. In *Barnes v. Glen Theatre, Inc.*, 501 U.S. 560 (1991), Justice Souter suggested in his concurrence that it is “possible” that a “higher incidence of prostitution and sexual assault in the vicinity of adult entertainment locations results from the concentration of crowds of men predisposed to such activities, or from the simple viewing of nude bodies regardless of whether those bodies are engaged in expression or not.” In neither case “would the chain of causation run through the persuasive effect of the expressive component of nude dancing.” *Id.* at 586. But this formulation merely hypothesizes a causal chain and would force speakers to disprove it. In contrast, the Court in *Linmark* put the burden on the township to demonstrate that the effects it feared were secondary, concluding that “respondents have not demonstrated that the place or manner of the speech produces a detrimental ‘secondary effect’ on society.” *Linmark Assoc., Inc. v. Township of Willingboro*, 431 U.S. 85, 94 (1977).

“happen to be associated with that type of speech.”<sup>348</sup> Hence, the Court’s application of the secondary effects doctrine fails to analyze causation logically.<sup>349</sup>

Professor Post concludes that the Court would be better off using Professor Ely’s test: whether “the evil the state is seeking to avert is one that is independent of the message being regulated.”<sup>350</sup> A ban on noisy sound trucks is content-neutral if the government bans it because the sound is loud and without regard to meaning. According to this test, ban on heckling that is indifferent to whether the heckling supports or opposes the speaker’s viewpoint would also be content-neutral.

On this approach, regulation of only encryption software speech acts is neither clearly content-neutral nor clearly content-based. If the government frames its interest as “frustration of signals intelligence” and only encryption software threatens that interest, then the regulation appears content-neutral. This harm would not flow from a listener’s response to the speech act as a speech act. That software can be used to encrypt, however, depends on what the software says. In this sense, the harm is not independent of the message being regulated.

Professor Kagan argues that a broad reading of this secondary effects doctrine errs by allowing courts to merely examine the government motive and to accept the government’s pretextual justifications based on non-communicative harms.<sup>351</sup> She suggests that courts use the notion of communicative impact in a quasi-evidentiary role to better test regulations for improper motives.<sup>352</sup> To do so, courts can ask whether the government has tried to regulate the targeted speech acts in the absence of the asserted harm by looking for a “control group” consisting of the same speech but without the supposedly harmful feature.<sup>353</sup> Alternatively, courts can also

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348. *Boos*, 485 U.S. at 320-21 (giving examples of congestion, visual clutter, and interference with ingress and egress).

349. One critic observes: “If taken seriously, and extended to other contexts, the Court’s transmogrification . . . of an expressly content-based restriction into one that is content-neutral threatens to undermine the very foundation of the content-based/content-neutral distinction.” Stone, *supra* note 305, at 116.

350. See Post, *Recuperating*, *supra* note 9, at 1266 (quoting JOHN HART ELY, *DEMOCRACY AND DISTRUST: A THEORY OF JUDICIAL REVIEW* 111 (1980)).

351. See Kagan, *supra* note 311, at 486 (“[T]he government almost always can proffer a justification based on [noncommunicative] harm.”).

352. See *id.* at 487.

353. See *id.* at 488-89.

inquire as to whether the government has regulated non-speech acts that relate to the government interest in the same way.<sup>354</sup>

Applied to encryption software speech acts, however, this approach also yields unclear results. The encryption restrictions probably fail Kagan's "control group" test because, unlike encryption software, other software can be made publicly available.<sup>355</sup> Printed encryption source code may count as a "control group" of the identical speech that is not regulated at all.<sup>356</sup> The EAR does not fail Kagan's second test at first glance because it regulates all encryption exports whether or not the export is a speech act.<sup>357</sup> However, it fails that test when it is properly applied<sup>358</sup> because the regulations do not control non-encryption exports of software or technology if the export would make the software or technology "publicly available."<sup>359</sup> The problem with Kagan's approach lies in its assumption that speech acts' non-communicative aspects can be severed from their communicative aspects into a "control group."<sup>360</sup> This approach can not cope with software speech acts precisely because the non-communicative functionality of a type of software necessarily attaches to any software of that type.

Even if we ignore the secondary effects doctrine, the problem of moral agency infects the non-communicative impact doctrine. The allegedly harmful effects of publishing software are non-communicative in the sense that they occur regardless of whether any particular recipient understands the act as a speech act or whether the actor intended to speak. Harms from the use of software resemble the harm of littering that may attend leafletting.<sup>361</sup> Littering is unrelated to the propositional content of the leafletter's

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354. See *id.* at 489 ("[I]n *Simon & Schuster*, the Court asked why the statute covered only the profits criminals gained from expressive activity, when the profits gained from nonexpressive activity also could have compensated victims of crime.").

355. 15 C.F.R. § 734.3 (1996).

356. One might argue that publishing printed source code isn't identical to publishing source code in electronic form, or that the harms from the latter are significantly greater than from the former.

357. In particular, the encryption regulations cover hardware. See *Bernstein IV*, 176 F.3d 1132, 1149 (9th Cir. 1999) (Nelson, J., dissenting) ("the EAR regulates the export of encryption technology generally, whether it is software or hardware").

358. It is properly applied if we look at the EAR's treatment of all exports, not only encryption exports.

359. 15 C.F.R. § 734.3 (1996).

360. See Kagan, *supra* note 311, at 489 n.202 ("[I]f a noncommunicative aspect of speech attaches to all speech of a certain content, then the control group I am positing in secondary effects cases will not exist.").

361. See, e.g., *Schneider v. State (Town of Irvington)*, 308 U.S. 147, 162 (1939) (holding that the state's legitimate interest in keeping streets free of litter "insufficient to

speech act. From the perspective of moral agency, however, the speaker is restrained because of the potential acts of others.<sup>362</sup> Persons other than the speaker cause the non-communicative impact. Similarly, functionality-based software harm does not arise merely from the speech act itself.

The Court has been wary of restrictions alleged to turn on non-speech aspects of an act but which directly affect one's ability to speak.<sup>363</sup> In *Cohen v. California*,<sup>364</sup> the Court noted that the conviction was based on "speech" and not on any separately identifiable and non-expressive conduct.<sup>365</sup> When Alice publishes her software, there is also no separately identifiable conduct, whether she publishes it on paper or on the Internet. If Alice's software has a non-communicative aspect by virtue of its functionality, that aspect flows purely from her choice to speak in a language that people can execute on a computer. That choice facilitates rigorous communication within the community of programmers, and cannot be regulated without effectively repressing her ability to express herself.

Equally important, software's non-communicative effects cannot be isolated from its communicative effects. Software is associated with these effects because it is written in a language that a person can execute on a computer. It is impossible to publish or communicate software without facilitating these effects. Thus, functionality-based regulation of software speech acts necessarily regulates speaking in programming languages. Neither the secondary effects doctrine nor the notion of non-communicative impact can logically encompass effects that cannot be regulated without regulating the speech itself.

In short, the government seeks to regulate software publication because of the non-communicative effects of the audience members' potential acts. The First Amendment demands that every effort be made to

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justify . . . prohibit[ing] a person rightfully on a public street from handing out literature to one willing to receive it," but no objection to punishing recipients "who actually throw papers on the street").

362. The heckler's veto cases raise a similar issue. See Kagan, *supra* note 311, at 461 ("In the typical case, a speaker expresses certain ideas, an audience makes known its displeasure, and police officers, fearful of public disturbance, arrest the speaker.").

363. See, e.g., *Schneider v. State* (Town of Irvington), 308 U.S. 147, 162 (1939); *Cohen v. California*, 403 U.S. 15 (1971).

364. 403 U.S. 15 (1971) (overturning conviction for disorderly conduct based on wearing jacket bearing words "Fuck the Draft" in courthouse).

365. See *Cohen*, 403 U.S. at 18 (finding that the conviction rested "solely upon 'speech,' not upon any separately identifiable conduct which allegedly was intended by Cohen to be perceived by others as expressive of particular views but which, on its face, does not necessarily convey any message and hence arguably could be regulated without effectively repressing Cohen's ability to express himself").

avoid regulating publication on this basis.<sup>366</sup> That software has a non-communicative aspect should not lower the level of scrutiny for software speech acts. Courts should consider speech acts as a whole because the Court has rejected attempts to subdivide them into their “component parts.”<sup>367</sup> Accordingly, regulating publication of encryption software for its cryptographic functionality must be tested under standard strict scrutiny.

## V. CONCLUSION

Software poses no special First Amendment problems if we resist the impulse to treat speech as a thing. Most of the problems that seem to plague First Amendment coverage of software become tractable once we focus on software acts instead of software *per se*. Some software acts are speech acts, while others are not. *Bernstein* presents a case of a speech act covered by the First Amendment. Professor Bernstein’s intended publication of his software is a speech act because it is one within the speech sub-community of computer science.

In the realm of software acts that are speech acts, standard First Amendment doctrine provides the tools needed to cope with the risks of harm that might be caused by someone’s use of software. By contrast, the government’s proffered “functionality” doctrine ignores traditional concerns about causation and moral agency by not distinguishing the acts of the speaker and the hearer.

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366. 44 *Liquormart, Inc. v. Rhode Island*, 517 U.S. 484, 512 (1996) (“[T]he First Amendment makes clear that the Constitution presumes that attempts to regulate speech are more dangerous than attempts to regulate conduct”); see *Williams*, *supra* note 268, at 641.

367. See *Riley v. National Federation of the Blind of N.C., Inc.*, 487 U.S. 781, 796 (1988) (“[W]here . . . the component parts of a single speech are inextricably intertwined, we cannot parcel out the speech, applying one test to one phrase and another test to another phrase. . . . we refuse[] to separate the component parts of charitable solicitation from the fully protected whole.”).

## ENCRYPTION SOURCE CODE AND THE FIRST AMENDMENT

By Robert Post<sup>†</sup>

### ABSTRACT

The First Amendment does not cover all speech acts. It instead extends constitutional protection to media for the communication of ideas, which are forms of social interaction that realize First Amendment values. The constitutional question, therefore, is whether particular uses of encryption source code are embedded within such media. It is insufficient to distinguish, as do current federal regulations, the publication of encryption source code in electronic form from its publication in written form. Instead it is necessary to focus on the social contexts within which encryption source code is used, whether in electronic or written form. From a constitutional perspective, it is one thing to use source code to convey ideas to an audience, and it is quite another to use source code to run a computer. The article suggests how each of these situations might be constitutionally analyzed.

Source code is a high level computer language typically used by programmers to compose computer software.<sup>1</sup> Federal regulations prohibit the unlicensed export of computer software, including source code, designed to encrypt messages.<sup>2</sup> To post encryption source code to the Internet is in most circumstances to “export” it under the terms of the regulations.<sup>3</sup> Federal regulations do not seek to prohibit the unlicensed export of “a printed book or other printed material setting forth encryption source code,” but

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1. See *Bernstein v. United States Dep’t of Justice*, 176 F.3d 1132, 1140 (9th Cir. 1999), *withdrawn pending en banc reh’g*, 192 F.3d 1308 (9th Cir. 1999), *appeal dismissed without prejudice and remanded*, No. 97-16686 (9th Cir. April 11, 2000) [hereinafter *Bernstein IV*].

2. See *Bernstein v. United States Dep’t of State*, 974 F. Supp. 1288, 1294-96 (N.D. Cal. 1997) [hereinafter *Bernstein I*]. To encrypt a message is to make it incomprehensible to someone who does not have the encryption code. Encryption code applies to messages that are sent in digital form. See ANDREW L. SHAPIRO, *THE CONTROL REVOLUTION* 73 (1999) (“Encryption tools . . . are the locks and keys of the digital age.”).

3. See *Junger v. Daley*, 8 F. Supp. 2d 708, 713 (N.D. Ohio 1998), *rev’d and remanded*, No. 98-4045, 2000 U.S. App. LEXIS 6161 (6th Cir. April 4, 2000) (“Almost any posting of software on the Internet is an export.”).

they do extend to “encryption source code in electronic form or media (e.g., computer diskette or CD ROM).”<sup>4</sup>

Daniel J. Bernstein, a professor of mathematics, statistics, and computer science, composed an encryption program called Snuffle in source code.<sup>5</sup> He wished to “present his work on Snuffle within the academic and scientific communities.”<sup>6</sup> Bernstein brought suit challenging the federal regulations as a prior restraint on his ability to speak. The *Bernstein* case raises the fascinating and controversial question of whether computer programs written in source code can be a form of expression for purposes of the First Amendment. Lee Tien’s rich and complex article substantially contributes to our understanding of this question.<sup>7</sup>

Tien’s distinction between “coverage” and “protection,” for example, is exactly right.<sup>8</sup> To conclude that the First Amendment “covers” conduct, like the export of encryption source code, is to assert that the constitutionality of the conduct’s regulation must be determined by reference to First Amendment doctrine and analysis. To conclude that the conduct is “protected” by the First Amendment, on the other hand, is to assert that the regulation of the conduct is unconstitutional. The question of First Amendment coverage goes to the threshold issue of the kind of analysis that should be brought to bear in evaluating the constitutionality of state regulations; the question of First Amendment protection goes to the ultimate judgments that we ought to reach in a particular case.

The threshold question posed by the *Bernstein* case is whether federal regulation of encryption source code is to be assessed under the doctrines of the First Amendment. This is a question of coverage, and it shall be my focus in this brief comment. *Bernstein* answered this question in the affirmative, holding that the constitutionality of the federal regulations was to be determined by First Amendment principles. A closely analogous case, however, has seemingly reached the contrary conclusion.<sup>9</sup>

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4. 15 C.F.R. § 734.3 (1999), note to paras. (B)(2) and (B)(3).

5. See *Bernstein IV*, 176 F.3d at 1135-36.

6. *Id.* at 1136.

7. Lee Tien, *Publishing Software as a Speech Act*, 15 BERKELEY TECH. L.J. 629 (2000).

8. See Tien, *supra* note 7, at n.10. Tien draws this distinction from Frederick Schauer, *Categories and the First Amendment: A Play in Three Acts*, 34 VAND. L. REV. 265, 267 (1981).

9. See *Junger v. Daley*, 8 F. Supp. 2d 708, 708 (N.D. Ohio 1998), *rev'd and remanded*, No. 98-4045, 2000 U.S. App. LEXIS 6161 (6th Cir. Apr. 4, 2000). As this article was going to press, however, the District Court Opinion in *Junger* was reversed by the Sixth Circuit. *Junger v. Daley*, No. 98-4045, 2000 U.S. App. LEXIS 6161 (6th Cir. Apr. 4, 2000). In the *Junger* case, Peter Junger, a law professor teaching courses on computer

In his article, Tien argues that First Amendment coverage should presumptively extend to all speech acts, by which he means all acts of communication in which a speaker intends “to produce understanding in a hearer by resort to or in virtue of the conventional meaning of what the speaker says.”<sup>10</sup> Thus for Tien the question of whether the publication of encryption code ought to be covered by the First Amendment depends upon whether publishing source code is a speech act.<sup>11</sup>

For reasons I have articulated elsewhere, I believe that the premise of Tien’s argument is untenable.<sup>12</sup> There are many forms of speech acts that the First Amendment does not cover. Product warnings are clearly speech acts according to Tien’s definition, for example, and yet they are universally regulated in ways that are not covered by the First Amendment.<sup>13</sup> Contracts are certainly speech acts, and yet contract law proceeds without the interference of First Amendment analysis. The general point is that social life largely occurs through language; social life is thus filled—one might even say composed of—interactions that meet Tien’s definition of speech acts. A First Amendment that covered all these aspects of social life would be nothing like the First Amendment which we currently possess. The presence of a speech act is therefore not sufficient to justify First Amendment coverage.<sup>14</sup>

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law, challenged the federal export regulations as violating his First Amendment right to post encryption programs to his web site in order to use them as teaching materials. *See Junger*, 8 F. Supp. 2d at 714. The federal government had specifically allowed Junger to publish encryption programs in his textbook, *COMPUTERS AND THE LAW*. *See id.* The District Court in *Junger* appeared to hold that because encryption source code in electronic form was “inherently functional . . . indistinguishable from dedicated computer hardware that does encryption,” *id.* at 716, the electronic source code was not covered by the First Amendment. The holding is ambiguous, however, because the Court spoke in terms of First Amendment “protection,” *id.* at 716-18, and it in fact purported to apply various First Amendment doctrines.

10. Tien, *supra* note 7, at 637 n.29. Tien seems to accept the possibility of “defining out” certain kinds of speech acts, like fighting words, from First Amendment coverage.

11. This is essentially the position of the Sixth Circuit decision reversing the District Court opinion in *Junger*. *See Junger*, 2000 U.S. App. LEXIS 6161. The Court holds that “[b]ecause computer source code is an expressive means for the exchange of information and ideas about computer programming, we hold that it is protected by the First Amendment.” *Id.* at \*10.

12. For the full development of the analysis set forth in this paragraph see Robert Post, *Recuperating First Amendment Doctrine*, 47 STAN. L. REV. 1249 (1995).

13. For a typical case, see, for example, *Hahn v. Sterling Drug, Inc.*, 805 F.2d 1480 (11th Cir. 1986).

14. I should also note that the presence of a speech act is also not *necessary* to justify First Amendment coverage. Campaign expenditures, for example, do not meet Tien’s definition of a speech act, and yet they are covered by the First Amendment. *See Buckley*

First Amendment coverage is sometimes triggered by *what* a legal rule regulates, and sometimes it is triggered by *why* a legal rule seeks to regulate.<sup>15</sup> These inquiries are logically and practically independent of each other, and in this comment I shall focus exclusively on the first. I shall address the question whether the regulation of encryption source code ought to be subject to First Amendment scrutiny, but I shall not discuss whether the purpose of the federal regulations at issue in *Bernstein* would independently warrant First Amendment coverage.

If the presence of a speech act is not a sufficient condition for First Amendment coverage, how are we to specify the class of actions that does trigger First Amendment analysis? The view I have defended elsewhere is that First Amendment coverage is triggered by those forms of social interaction that realize First Amendment values.<sup>16</sup> If we believe that the function of the First Amendment is to protect a marketplace of ideas, we will extend First Amendment coverage to those forms of social interaction that constitute such a marketplace. If we believe that the function of the First Amendment is to protect the communications necessary for democratic self-determination, we will extend First Amendment coverage to social interactions that instantiate the value of self-government.

From this perspective, Tien is fundamentally misguided to believe that he can explain First Amendment coverage “without appealing to a grand theoretical framework of First Amendment values.”<sup>17</sup> If First Amendment coverage does not extend to all speech acts, then such a framework is at a minimum necessary in order to provide the criteria by which to select the subset of speech acts that merit constitutional attention.

Actually the situation is more complicated than this, because First Amendment coverage is not limited to speech acts. It extends to forms of interaction that realize First Amendment values. In work published elsewhere I have used the term “medium” to designate such forms of interaction.<sup>18</sup> The Court has held that “motion pictures are a significant medium for the communication of ideas,”<sup>19</sup> for example, which signifies that film, considered as a genre, serves First Amendment values.

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v. Valeo, 424 U.S. 1 (1976). In general, First Amendment coverage can be triggered by certain justifications for government regulations, whether or not those regulations are addressed to speech acts. See Post, *supra* note 12, at 1255-60.

15. See Post, *supra* note 12, at 1255-60.

16. See *id.* at 1254-55.

17. Tien, *supra* note 7, at 636.

18. See Post, *supra* note 12, at 1250-57.

19. *Joseph Burstyn, Inc. v. Wilson*, 343 U.S. 495, 501 (1952).

The genre of the cinema, however, encompasses far more than speech acts. It includes materials, like celluloid; functional machines, like projectors; buildings, like movie houses; social organizations, like studios; and so forth. If the state were to prohibit the use of projectors without a license, First Amendment coverage would undoubtedly be triggered. This is not because projectors constitute speech acts, but because they are integral to the forms of interaction that comprise the genre of the cinema. The licensing of projectors would have important effects on that genre, effects that would be quite pertinent to the very First Amendment values that lead us to protect motion pictures in the first place. That is why First Amendment coverage would likely extend to a law requiring projectors to be licensed.

First Amendment coverage, therefore, depends upon how the object of regulation is integrated into First Amendment media. Although a state may without First Amendment scrutiny prohibit public nudity, a First Amendment question would surely be raised if a state were to prohibit nudity within the cinema.<sup>20</sup> It would even raise a First Amendment question if a state were to attempt to apply a general prohibition of nudity to motion pictures.<sup>21</sup> First Amendment coverage, in other words, does not attach to nudity considered as an isolated kind of conduct, but rather to the relationship between nudity and the forms of social interaction that the First Amendment seeks to protect.

Some judges and commentators, however, have sought to determine whether the First Amendment covers encryption source code by deciding whether such code, viewed as an isolated thing, is “inherently a functional device.”<sup>22</sup> But if the analysis I have suggested is correct, Tien is certainly right to conclude that one cannot “answer the coverage question by looking at software as a thing.”<sup>23</sup> Although projectors are unambiguously a functional thing, the First Amendment might well cover their regulation

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20. See, e.g., *Erznoznik v. City of Jacksonville*, 422 U.S. 205 (1975).

21. See *Post*, *supra* note 12, at 1259 (discussing *Barnes v. Glenn Theatre, Inc.*, 501 U.S. 560 (1991)); cf. *Cohen v. California*, 403 U.S. 15 (1971) (holding that California cannot prohibit the wearing of a jacket bearing an obscenity in an effort to remove the word from the public vocabulary).

22. *Bernstein IV*, 176 F.3d 1132, 1148 (9th Cir. 1999) (Nelson, J., dissenting); see also *Junger v. Daley*, 8 F. Supp. 2d 708, 716 (N.D. Ohio 1998), *rev'd and remanded*, No. 98-4045, 2000 U.S. App. LEXIS 6161 (6th Cir. April 4, 2000); Patrick Ian Ross, *Bernstein v. United States Department of State*, 13 BERKELEY TECH. L.J. 405, 410-15 (1998); John P. Collins, Jr., Note, *Speaking in Code*, 106 YALE L.J. 2691, 2696 (1997). But see *Think Nguyen, Cryptography, Export Controls, and the First Amendment in Bernstein v. United States Department of State*, 10 HARV. J.L. & TECH. 667, 677-78 (1997).

23. Tien, *supra* note 7, at 688.

because of the potential impact on motion pictures. The correct focus of constitutional inquiry is, therefore, as Tien properly asserts, "how software is used in an act."<sup>24</sup> The coverage question depends upon how the licensing of encryption source code affects First Amendment media.

It is clear that the federal regulations at issue in *Bernstein* attempt roughly to acknowledge this point by distinguishing between encryption source code in "a printed book or other printed material setting forth encryption source code," and "encryption source code in electronic form or media (e.g., computer diskette or CD ROM)."<sup>25</sup> The regulations do not require a license for reproducing source code in printed material.<sup>26</sup> This exception would be incomprehensible if preventing disclosure of the information contained in encryption source code were the only concern of the regulations. Evidently the regulations were also concerned with protecting First Amendment values.

We can identify one source of these values by attending to Tien's conclusion that "a computer program in source code form is a procedure written in a programming language."<sup>27</sup> Authors routinely write books and articles in which they communicate procedures to each other. Examples might be articles that explain the procedures necessary for medical diagnoses, or books that explain the procedures necessary for experiments in the physical sciences. Because we regard books and articles as a medium for the communication of ideas, such writings are unambiguously covered by the First Amendment.

For purposes of the First Amendment, the language in which books and articles are written is without importance. So long as books and articles communicate ideas to others, it makes no difference whether they are written in French, or in mathematical symbols, or in computer source code. Just as the First Amendment would cover a law requiring authors to obtain a license before publishing in an article the mathematical equations describing nuclear fusion, so would it cover regulations requiring a license before printing in an article the source code for an encryption program.

Some analysis roughly like this must explain why federal regulations permit encryption source code to be published without interference in book form. Why, then, do the regulations forbid the unlicensed publication of the identical source code in "electronic form or media (e.g., computer

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24. Tien, *supra* note 7, at 691.

25. 15 C.F.R. § 734.3 (1999), note to paras. (B)(2) and (B)(3).

26. Hence Peter Junger was able without interference to publish encryption software in his textbook. See *Junger v. Daley*, F. Supp. 2d 708, 714 (N.D. Ohio 1998), *rev'd and remanded*, No. 98-4045, 2000 U.S. App. LEXIS 6161 (6th Cir. April 4, 2000).

27. Tien, *supra* note 7, at 667.

diskette or CD ROM)”? The federal government defended this distinction by arguing that when source code is published in electronic form, it does not implicate First Amendment concerns. In *Bernstein*, the federal government contended that source code in electronic form is a form of software “used to control directly the operation of a computer without conveying information to the user. In the government’s view, by targeting this unique functional aspect of source code, rather than the content of the ideas that may be expressed therein, the export regulations manage to skirt entirely the concerns of the First Amendment.”<sup>28</sup>

The government’s argument, however, can not be correct. Publishing software in print is covered by the First Amendment because it forms part of public discourse and debate. We know that this same discourse and debate can occur over the Internet and in electronic form.<sup>29</sup> So long as the publication of encryption source code forms part of this public discourse and debate, it will be covered by the First Amendment, whether it is set forth in a printed article or in an online discussion. The government’s analysis leads directly to the absurd conclusion that an article about encryption code that would unambiguously be covered by the First Amendment when published in *Scientific American*, would somehow lose that coverage when scanned and posted to the Internet.

It may be the case, of course, that there are stronger justifications for prohibiting the publication of encryption code in electronic form than in printed form, a question about which I intimate no view. I observe only that this question goes to the issue of First Amendment *protection*; it is relevant to whether or not electronically reproduced encryption software may be regulated when analyzed under applicable First Amendment doctrines. It does not go to the question of First Amendment *coverage*.<sup>30</sup>

The decisive question for coverage is whether or not the publication of the source code forms part of a First Amendment medium, and this question can be affirmatively answered even if the publication of the source code is in electronic form. For purposes of First Amendment coverage, it

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28. *Bernstein IV*, 176 F.3d 1132, 1141-42 (9th Cir. 1999).

29. See *Reno v. American Civil Liberties Union*, 521 U.S. 844 (1997) (holding that the Communications Decency Act of 1996 was a constitutionally impermissible content based restriction on First Amendment speech).

30. This point is made by the Sixth Circuit decision in *Junger*, 2000 U.S. App. LEXIS 6161, at \*10-11 (“The functional capabilities of source code, and particularly those of encryption source code, should be considered when analyzing the governmental interest in regulating the exchange of this form of speech. . . . We recognize that national security interests can outweigh the interests of protected speech and require the regulation of speech.”)

makes no difference whether an author wishes to discuss an encryption program written in source code in an article published in hard copy, or in an article electronically distributed through the Internet.

Suppose, however, that a person does not wish to discuss an encryption program written in source code, but to use an encryption program. We might imagine a consumer who buys a disk containing encryption software, intending to insert the disk into his computer to employ the software to encrypt his messages. In this situation, the content of the source code is not a subject of discussion or debate.<sup>31</sup> The consumer does not know what the source code says; the code speaks directly to the consumer's computer.

The author of encryption software who distributes encryption source code to consumers to be used in this fashion is therefore not participating in public dialogue or debate. For this reason, regulation of encryption software in such contexts would seem to raise very different constitutional questions than any we have so far discussed. Such regulation appears, on its face, no different than the regulation of hardware in computers.

No doubt this is the paradigmatic situation that the government had in mind when it argued that the publication of encryption source code in electronic form was "used to control directly the operation of a computer without conveying information to the user."<sup>32</sup> The difficulty with the government's position, however, is that for encryption source code to function in this way, it is a necessary but not sufficient condition for it to be written in electronic, rather than printed form. To know whether encryption source code forms part of a dialogue between humans or instead serves as instructions to computers, we must know more than that it is written in electronic form; we must also know the social circumstances of its sale and application.

For purposes of First Amendment coverage, therefore, the relevant distinction is not between encryption source code published in electronic as opposed to printed form, but rather between encryption source code that is itself part of public dialogue and encryption source code that is meant merely to be used. This latter distinction is surely messier—more difficult to formulate and enforce—than that presently contained in federal regulations. But it is the only constitutionally defensible distinction.

Unfortunately the distinction does not completely settle the question of First Amendment coverage. This is because encryption software can affect

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31. Most likely, of course, the disk would be written in object code, not source code. See Mark A. Lemley and Eugene Volokh, *Freedom of Speech and Injunctions in Intellectual Property Cases*, 48 DUKE L.J. 147, 236-37 (1998).

32. *Bernstein IV*, 176 F.3d at 1142.

First Amendment media in various different ways. If encryption source code is itself a subject of discussion within a First Amendment medium, First Amendment coverage clearly ought to apply to attempts to regulate the publication of the code. That is why the Court in *Bernstein* was assuredly correct to hold that in the circumstances of the case the validity of the federal regulations had to be determined by reference to applicable First Amendment principles.<sup>33</sup> But even if encryption source code is not itself a subject of public discussion, its regulation might nevertheless affect public discussion in ways that ought to trigger First Amendment coverage.

To see how this might be so, recall our earlier discussion of movie projectors. Such projectors form no part of the speech content of movies. But a law forbidding the screening of films without a licensed projector would probably be covered by the First Amendment. We would be concerned about the law's potential impact on the medium of movies, in exactly the same way that we would be concerned about the potential impact on the press of a law that required all books to be printed on presses that were licensed by the state.<sup>34</sup>

The First Amendment concerns that immediately spring to mind in these examples are those of viewpoint discrimination. We know that certain kinds of licensing schemes can be used to distort the ideas expressed through the media of film or books. Because we wish ideas to be freely and fully expressed through these media, we are alert to scrutinize licensing schemes under First Amendment standards to ensure that they do not compromise this constitutional value. The licensing scheme challenged in *Bernstein*, applied to the public discussion at issue in that case, raises analogous constitutional concerns.

State regulation, however, can compromise First Amendment media in ways that do not involve viewpoint discrimination. An obvious instance might be a law that prohibits newsprint in order to save trees. Newsprint is a material necessary for the publication of most newspapers. Although a law proscribing newsprint would be viewpoint (and content) neutral, it

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33. Even the dissenting opinion of T.G. Nelson conceded that "Bernstein may very well have a claim under an as-applied First Amendment analysis." *Id.* at 1149. It is for this same reason that the District Court in *Junger* was almost certainly incorrect to hold that the First Amendment did not apply to the circumstances of that case. *See Junger v. Daley*, F. Supp. 2d 708 (N.D. Ohio 1998), *rev'd and remanded*, No. 98-4045, 2000 U.S. App. LEXIS 6161 (6th Cir. April 4, 2000).

34. *See* THOMAS I. EMERSON, *THE SYSTEM OF FREEDOM OF EXPRESSION* 504 (1970) (noting that prior restraint originated in part in opposition to laws forbidding books to be printed except by printing presses licensed by the state); *see also Talley v. California*, 362 U.S. 60, 64 (1960) (discussing effects of press licensing law).

would carry the potential for so significantly affecting the First Amendment medium of newspapers that we would certainly review it under First Amendment principles. We would want to assure ourselves that it would not compromise the constitutional value we attribute to newspapers.

Such review, including the threshold question of whether to engage in such review (which is the coverage question), will always rest upon a constitutional sociology by which we specify the social aspects of the medium that carry constitutional significance. This sociology can often prove difficult and puzzling, especially when it involves new and evolving technologies.

Consider, for example, a viewpoint (and content) neutral law that prohibits CD players. We know that music is a First Amendment medium.<sup>35</sup> CD players are machines that do not form part of the content of that medium, and yet today most music is distributed and heard through the technology of compact disks. Prohibiting CD players would materially disrupt the pattern of social relationships that comprise the contemporary medium of music. The First Amendment question would be whether this disruption threatens to undermine the constitutional values that have led us to classify music as a First Amendment medium. In such circumstances, the extension of First Amendment coverage would signify that we find this a sufficiently close or important question as to require us to decide it under First Amendment principles.

An analogous argument might be made to justify extending First Amendment coverage to encryption software. Even when such software functions purely as a "machine"<sup>36</sup> to make digital messages secret, we must ask whether its regulation might compromise the constitutional values we attribute to particular First Amendment media. The empirical and normative aspects of such an inquiry are, to say the least, formidable. First, we would have to assess the effects of federal regulation of encryption source code on the production and use of encryption software. Second, we would have to specify the impact of these effects on the various First Amendment media that employ encryption software. Finally we would have to face the normative question of whether this impact would raise sufficient constitutional concerns as to merit First Amendment coverage.

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35. See *Ward v. Rock Against Racism*, 491 U.S. 781, 790 (1989).

36. See Pamela Samuelson et al., *A Manifesto Concerning the Legal Protection of Computer Programs*, 94 COLUM. L. REV. 2308, 2320-24 (1994); see also Ross, *supra* note 22, at 410-11; Lemley & Volokh, *supra* note 31, at 236.

Tien offers the valuable suggestion that encryption software might be conceived as providing the equivalent of envelopes which protect the privacy of underlying digital messages.<sup>37</sup> In some circumstances, a law that strips speech of privacy would certainly merit First Amendment coverage. Consider, for example, a regulation prohibiting mail from using envelopes and requiring that the contents of all letters be made legible to mail handlers. I have no doubt that courts would scrutinize such a law under relevant First Amendment doctrine. This is because the chill on participating in a First Amendment medium that comes from exposure is a well-recognized First Amendment interest.<sup>38</sup> Laws prohibiting anonymous political leaflets have thus been struck down because of their potential impact on speakers.<sup>39</sup>

Encryption software is a way of preventing an analogous chill within digital media. It is probable that First Amendment coverage would extend to a law requiring a live operator to monitor all phone conversations.<sup>40</sup> We might imagine an analogous argument for First Amendment coverage of federal regulations of encryption source code *if* the world were such that digital phone conversations were routinely monitored, and *if* the effect of the regulations were essentially to deprive us of the ability to avoid such eavesdropping. It is not difficult to think up analogous arguments about communication over the Internet.

It is far beyond the ambition of this brief comment to make or to evaluate any such arguments. Digital First Amendment media, like the Internet, are so new and have such labile patterns of social interaction, that it seems to me enormously difficult to acquire reliable normative or descriptive traction on the relevant questions. My point in raising this line of inquiry is not to suggest a final resolution of the problem, but instead to indicate that it will be necessary to pursue this line of inquiry if we ever aspire to a more complete understanding of the issue of First Amendment coverage of federal regulation of encryption source code.

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37. See Tien, *supra* note 7, at 673.

38. See NAACP v. Alabama ex rel. Patterson, 357 U.S. 449, 460-64 (1958).

39. See McIntyre v. Ohio Elections Comm'n, 514 U.S. 334 (1995); see also *Talley*, 362 U.S. at 60.

40. See generally *Sable Communications of California v. FCC*, 492 U.S. 115 (1989) (applying strict scrutiny under the First Amendment to a state law prohibiting certain kinds of sexual telephone conversation).



ESSAY

JUDICIAL HYPERACTIVITY: THE FEDERAL  
CIRCUIT'S DISCOMFORT WITH ITS APPELLATE  
ROLE

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ABSTRACT

The authors identify a phenomenon in Federal Circuit decision-making that might fairly be termed “judicial hyperactivity.” Judicial hyperactivity describes what happens when the court from time to time loses track of the important distinction between trial and appellate roles and engages in a form of decision-making at odds with traditional notions of appellate review. The authors explain how to recognize judicial hyperactivity and discuss several recent examples of the practice, including instances where Federal Circuit panels have apparently taken up the roles normally assigned to patent examiners, to advocates and to judicial fact-finders. The authors argue that, although the court may view judicial hyperactivity as efficient or expedient in a particular case, the practice should be avoided because it will ultimately have a pernicious effect, undermining confidence in the judiciary and the predictability of the judicial process.

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## I. INTRODUCTION

The United States Court of Appeals for the Federal Circuit is an intermediate federal appellate court, not a trial court.<sup>1</sup> Charged by statute with reviewing decisions of lower courts and administrative agencies,<sup>2</sup> it has no original jurisdiction. Unfortunately, the court from time to time appears to lose track of the important distinction between trial and appellate roles and engages in what might be termed “judicial hyperactivity”—a form of decision-making at odds with traditional notions of appellate review. In this article, we explain how to recognize judicial hyperactivity and discuss several recent examples of the practice. We argue that, although the court may view judicial hyperactivity as efficient or expedient in a particular case, the practice will ultimately have a pernicious effect, undermining confidence in the judiciary and the predictability of the judicial process.

As an initial matter, we should hasten to distinguish “judicial hyperactivity” from its better known sibling, “judicial activism.” The latter term refers to a tribunal going beyond the substantive statutory or common law to reach ideologically-motivated outcomes (whether to engage in a bit of social engineering or to give shape to a radical new jurisprudence). Readers familiar with this more traditional usage will recognize that the very term “judicial activism” is drenched in political overtones. The New Dealers reviled the conservative majority of the Supreme Court for its judicial activism in striking down liberal New Deal legislation in the 1930s.<sup>3</sup> Today, the phrase is likely to be used both by conservatives in attacking liberal judges<sup>4</sup> and—more and more—by liberals attacking conservative judges.<sup>5</sup> These pejorative uses of the term often carry an implied dis-

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1. The Federal Circuit is an intermediate appellate court in that it reviews decisions of trial courts and administrative agencies, and its decisions are subject to review by the United States Supreme Court. *See* 28 U.S.C. §§ 1254, 1295 (1994).

2. The Federal Circuit’s jurisdiction is defined by statute. *See* 28 U.S.C. § 1295 (1994).

3. *See, e.g.*, HENRY J. ABRAHAM, *JUSTICES AND PRESIDENTS* 208-11 (3d ed. 1992).

4. *See, e.g.*, ROBERT H. BORK, *SLOUCHING TOWARDS GOMORRAH: MODERN LIBERALISM AND AMERICAN DECLINE* 115 (1996) (“[T]he Court is certain to be activist on the cultural left well into the next century.”).

5. *See, e.g.*, David F. Pike, *Court Redefined Judicial Activism Again This Term*, L.A. DAILY J., July 1, 1999, at 1; David G. Savage, *New Conservative Activism Sweeps*

agreement with the outcome of the allegedly judicial activist decisions. Critics of a more purist bent, however, may employ the term to criticize the court's policy focus itself, decrying the court's "activism" in usurping the legislature's role in setting policy without regard to the particular policy outcomes.<sup>6</sup>

While judicial hyperactivity does not necessarily aim to reshape the substantive law in ways some view as improper, it does share with its more politicized sibling a fundamental focus on the proper role of the judiciary. In identifying judicial hyperactivity, however, our focus is not on the rules that govern society, but on those that direct the decision-making process itself. Unlike critics who level the charge of "judicial activism" when they believe that a court has improperly usurped the policy-making role of the legislature, we are concerned with what happens when an intermediate appellate court usurps elements of the decision-making process that are supposed to be the province of the lower courts, administrative bodies, or even litigants.

The line between "statutory interpretation" or common law legal evolution and policy-driven judicial activism may at times be a hard one to draw. Thus, the charge of "judicial activism" is often a highly subjective one. The line between proper appellate review and improper judicial hyperactivity, by contrast, is considerably clearer and more easily adminis-

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*the Federal Courts Law: GOP-appointed Jurists Back States' Power; Strike Rules on Clean Air, Youth Smoking, Rape Victims' Right to Sue*, L.A. TIMES, June 22, 1999, at A1.

6. Such criticism can come from within the court itself. "It is policy choices that lead to departure from precedent, into the judicial activism that weighs against legal stability," observed Federal Circuit Judge Pauline Newman, warning against "policy-driven activism whereby the application of the law will not be known until the Federal Circuit hears the case." Pauline Newman, *The Federal Circuit, Judicial Stability or Judicial Activism?*, 42 AM. U. L. REV. 683, 688 (1993).

Nor, certainly, is the charge of judicial hyperactivity saved for the Federal Circuit alone. Professor Erwin Chemerinsky has observed a similar sort of procedural overreaching—what he calls "the new judicial activism"—in recent decisions of the United States Supreme Court. See Erwin Chemerinsky, *The New Judicial Activism*, CAL. LAW., February 2000, at 25, 26. Professor Chemerinsky points to the recent decisions in *Kolstad v. American Dental Association*, 527 U.S. 526 (1999), and *Reno v. Arab-American Anti-Discrimination Committee*, 525 U.S. 471 (1999), as examples of the Supreme Court stepping out of its traditional appellate role to decide questions as to which certiorari had not been granted, and which had neither been addressed by the lower courts in deciding the case, nor briefed or argued by the parties. This, according to Professor Chemerinsky, amounts to "flouting the basic elements of the appellate process for no apparent good reason by reaching out to decide major legal issues that have not been ruled upon by the lower courts." Chemerinsky, *supra*, at 25. Professor Chemerinsky's observations underscore the fact that the Federal Circuit is by no means alone in the practice of judicial hyperactivity.

tered. The proper role of an appellate court is to decide appeals from other tribunals, either lower courts or administrative agencies.<sup>7</sup> In deciding those appeals, the appellate court usually should consider only the evidence before the lower court or administrative agency.<sup>8</sup> The appellate court should not find facts; instead, it should review the fact-finding of the lower tribunal.<sup>9</sup> The appellate court should decide the appeal based on the decision below and on the arguments presented by the parties. It is usually easy enough to see when a court has gone beyond the factual record presented to the trier of fact below and the issues briefed by the litigants before it to engage in fact-finding, evidentiary weighing, and advocacy of its own.

Judicial hyperactivity is not as rare as it is unfortunate. The Federal Circuit is a court of specialized and limited jurisdiction.<sup>10</sup> Not surprisingly, obvious opportunities for judicial *activism* present themselves compara-

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7. "[T]he function of an appellate court is to correct errors committed at trial." *Key Pharm. v. Hercon Lab. Corp.*, 161 F.3d 709, 715 (Fed. Cir. 1999). A second function is "to articulate and interpret legal rules that the lower courts must apply." Maureen McGirr, Note, *Panduit Corp. v. Dennison Mfg. Co.: De Novo Review and the Federal Circuit's Application of the Clearly Erroneous Standard*, 36 AM. U. L. REV. 963, 963 n.3 (1987); see also Edward H. Cooper, *Civil Rule 52(a): Rationing and Rationalizing the Resources of Appellate Review*, 63 NOTRE DAME L. REV. 645, 649 (1988) ("[T]he federal courts of appeals serve two functions: the correction of error in individual cases and the development of the law in ways that will guide future conduct and future litigation."). These functions are not independent. "The declarative, legislative function of appellate courts can only be rightly exercised as a by-product of their more mundane corrective function." J. Dickson Phillips, Jr., *The Appellate Review Function: Scope of Review*, LAW & CONTEMP. PROBS., Spring 1984, at 1, 6.

8. "As the statute requires, our court decides on the record." Howard T. Markey, *Trademarks on Appeal—A View From the Bench*, 66 TRADEMARK REP. 279, 282 (1976).

9. See Cooper, *supra* note 7, at 657 ("[T]rial courts are primarily responsible for sifting the evidence and finding the facts, while appellate courts are primarily responsible for developing the law.").

10. The Federal Circuit was established in 1982, in part in an effort by Congress to foster uniformity in the application of the law of patents. See S. REP. NO. 97-275, at 5 (1981), *reprinted in* 1982 U.S.C.C.A.N. 11, 15. Congress created the United States Court of Appeals for the Federal Circuit by enacting the Federal Courts Improvement Act of 1982, Pub. L. No. 97-164, 96 Stat. 25 (1982). The Act effectively merged two existing Article III courts, the Court of Claims and the Court of Customs and Patent Appeals, expanding their mandate to give the new court exclusive appellate jurisdiction over most cases involving patent issues, as well as a host of other subjects. See 4 DONALD S. CHISUM, PATENTS: A TREATISE ON THE LAW OF PATENTABILITY, VALIDITY, AND INFRINGEMENT §11.06[3][e] (1999). The record of the time reflects three reasons motivating the creation of the new court: (1) relief of the regional circuit courts' appellate workload; (2) the hope that the new court would bring about greater uniformity in the development and application of the patent law; and (3) more effective use of existing federal judicial resources. See *id.* § 11.06[3][e][i].

tively rarely on the docket of Federal Circuit patent cases.<sup>11</sup> But the same specialized jurisdiction that helps insulate the judges of the Federal Circuit from the temptation to engage in judicial activism may motivate them to indulge in judicial hyperactivity. The familiarity and expertise of the Federal Circuit judges with issues common to the court's specialized jurisdiction may lead them more readily to usurp the fact-finding role.<sup>12</sup> Almost since its inception, the Federal Circuit has been dogged with criticism for straying from the path carefully delineated for appellate tribunals.<sup>13</sup> Disappointed litigants and commentators alike have criticized the court for fact-finding and other forms of hyperactive judging.<sup>14</sup> Increasingly, the bar is expressing concern over the court's decision-making procedures and its apparent willingness to take over the roles of patent examiner, advocate

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11. Until recently the court has not had a body of decisions large enough to provide a basis for a statistically significant analysis of its rulings. We would expect in the not too distant future to see empirical studies that will be able to assess the court's rulings and either confirm or deny the rather pervasive impression that the court is ideologically disposed to be "pro-patentee." For one interesting view of how "the numbers" play out, see ROBERT L. HARMON, *PATENTS AND THE FEDERAL CIRCUIT* app. 973-81 (4th ed. 1998). Mr. Harmon has collected some raw data on the reversal rate for patent cases in the Federal Circuit. For the period he analyzed, he found that an accused infringer who loses in the trial court had a one in seven chance of prevailing on appeal. By contrast, the patent holder had a nearly one in four chance of winning in the Federal Circuit what it could not win in the trial court. As Mr. Harmon observes: "an accused infringer had better win below [in the trial court]. And even then, it is not out of the woods." *Id.* at 980.

12. In *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 40 (1997), the Supreme Court noted the Federal Circuit's "special expertise" in patent law when it left to the Federal Circuit's "sound judgment in this area" the task of refining the formulation of the test for applying the doctrine of equivalents. In *Dickinson v. Zurko*, 527 U.S. 150, 155 (1999), the Supreme Court recognized that the Federal Circuit's experience extended beyond pure questions of patent law and procedure, and explicitly recognized the "import[ant] . . . fact that, when a Federal Circuit judge reviews PTO fact-finding, he or she often will examine that finding through the lens of patent-related experience—and properly so, for the Federal Circuit is a specialized court." According to the Supreme Court, in reviewing PTO determinations, this "comparative expertise" allows the Federal Circuit "better to understand the basis for the PTO's finding of fact" and "may play a more important role in assuring proper review" of those determinations. *Id.*

13. See, e.g., Douglas A. Strawbridge et al., *A Review of Recent Decisions of the United States Court of Appeals for the Federal Circuit: Area Summary: Patent Law Developments in the United States Court of Appeals for the Federal Circuit 1986*, 36 AM. U. L. REV. 861, 875 (1987); McGirr, *supra* note 7, at 967, 980-81; Edward V. Filardi & Robert C. Scheinfeld, *Appellate Review of Patent Bench Trials: Is the CAFC Following Rule 52(a)?*, in CURRENT DEVELOPMENTS IN PATENT LAW 1985, at 9, 14 & n.3 (PLI Patents, Copyrights, Trademarks, and Literary Property Course Handbook Series No. 213, 1985). See also *infra*, notes 72-73, and accompanying text.

14. See, e.g., Strawbridge et al., *supra* note 13, at 875 ("The Federal Circuit has had considerable difficulty adjusting to its role as a court of appeals under Rule 52(a).").

and trier of fact.<sup>15</sup> As we will show, from time to time the Federal Circuit has, with legitimate cause, expanded the scope of its jurisdiction consciously and explicitly. The expansion we discuss in this article, however, is of a far less overt (if perhaps not less deliberate) sort. Bearing in mind that not all expansion of Federal Circuit jurisdiction is necessarily judicial hyperactivity, we turn now to examine each of the concerns noted above.

## II. THE FEDERAL CIRCUIT AS PATENT EXAMINER

The Federal Circuit's recent opinion in *In re Cortright*<sup>16</sup> has fueled anew the bar's concern over the Federal Circuit's penchant for stepping out of its appellate role. The case came to the court as a garden-variety appeal by a patent applicant from the decision of the Board of Patent Appeals and Interferences ("Board"). The Board had affirmed a patent examiner's rejection of patent claims directed to a method of treating baldness by rubbing the scalp with "Bag Balm," a product used by dairy farmers to soften cow udders.<sup>17</sup> The Board had concluded that the patent application did not enable the claimed invention because the treatment was not shown to "restore hair growth," as specified in the claims.<sup>18</sup> On appeal, the Federal Circuit reversed the Board's decision, holding that the Board had incorrectly interpreted the claim limitation "restore hair growth" to require that the treatment return the user's hair to its original state.<sup>19</sup> The court

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15. The evidence for this assertion is largely anecdotal. Practitioners, being mindful of the fact that, in any given case, judicial hyperactivity will likely benefit one side or the other, are understandably reticent to voice strong criticisms of the court. Commentators have noted, however, the general tendency on the part of the Federal Circuit to take for itself the role of final arbiter of issues that, at least at one time, were fairly considered the province of the trial court and jury. For example, Ted D. Lee and Michelle Evans observe that, in applying the substantial evidence standard:

when the Federal Circuit believes the jury verdict was correct, it simply holds that the substantial evidence test was met. On the other hand, when the Federal Circuit believes the jury verdict was wrong, it substitutes its opinion for that of the jury and simply states that the substantial evidence test was not met.

Ted D. Lee & Michelle Evans, *The Charade: Trying a Patent Case to All "Three" Juries*, 8 TEX. INTELL. PROP. L.J. 1, 14 (1999).

16. 165 F.3d 1353 (Fed. Cir. 1999).

17. *See id.* at 1355. The Federal Circuit's opinion noted seven other patents identifying "more mundane materials" used for the same purpose, including Dead Sea mud; emu oil; potato peelings and lantana leaves; vitamin D3 and aloe; a salve of garlic powder, brewer's yeast, grapefruit juice, acetic acid, and kelp; salves of sage, nettles, and aloe; and a salve of pine extract and bamboo extract or Japanese apricot. *See id.* at 1357 & n.1.

18. *See id.* at 1355.

19. *See id.* at 1359.

ruled that the Board had erred in failing to interpret the claim limitation as one of ordinary skill in the art would have done.<sup>20</sup>

But here's the rub: to establish how one of ordinary skill in the art would interpret the "restore hair growth" limitation, the court looked to the use of that term in three patents that were not cited or considered by the patent examiner, Board, Patent and Trademark Office ("PTO") Solicitor, or patent applicant.<sup>21</sup> Apparently, the court conducted its own patent and literature search in order to identify publications that supported its interpretation of the claim limitation.<sup>22</sup> Patent and literature searching, needless to say, is usually the province of the applicant or the patent examiner, not an appellate court.

The reaction to *Cortright* was a mix of bemusement and concern. One publication, in a wry understatement, labeled the *Cortright* opinion a "surprising appellate court approach to claim construction."<sup>23</sup> The less sanguine—among whom, no doubt, one could find much of the PTO's staff and the patent bar—were slack-jawed over the obvious implication of the *Cortright* opinion: "that a court is as free to examine previous patents in construing claims as it is to examine court opinions in construing statutes."<sup>24</sup>

In response to the panel decision in *Cortright*, the PTO Solicitor filed a petition for panel rehearing. The Solicitor offered a number of grounds for reconsideration. First, noting that the panel had considered a total of thirteen patents and two newspaper articles that were not before the Board, he argued that the panel decision violated the statute requiring the court to review the Board's decisions "on the record before the Patent and Trademark Office."<sup>25</sup> Second, in a related argument, the Solicitor noted that the panel decision was contrary to numerous cases in which the Federal Circuit and its predecessor, the Court of Customs and Patent Appeals, had refused to consider patents not considered by the Board, even when urged to do so by one of the parties.<sup>26</sup> Third, and more fundamentally, the Solici-

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20. *See id.*

21. Petition for Rehearing for Appellee Commissioner of Patents and Trademarks at 2-3, *In re Cortright*, 165 F.3d 1353 (Fed. Cir. 1999) (No. 98-1258), *reh'g denied*, No. 98-1258, 1999 U.S. App. LEXIS 9001 (Fed. Cir. Apr. 20, 1999).

22. The court's opinion does not mention whether the court conducted its own search, but the "prior art" on which the court relied, some of which was apparently not prior art, is not identified in the Board's opinion or the briefs of the parties.

23. *PTCJ Comment*, 57 Pat. Trademark & Copyright J. (BNA) 286 (1999).

24. *Id.*

25. Petition for Rehearing at 3-4 (citing 35 U.S.C. § 144 (1994)).

26. *See id.* at 4-5 (citing *Gechter v. Davidson*, 116 F.3d 1454, 1457 (Fed. Cir. 1997) (dictum); *In re Nielson*, 816 F.2d 1567, 1571 (Fed. Cir. 1987) (dictum); *In re Margolis*,

tor relied upon "the well-established general rule prohibiting an appellate court's reliance on materials outside the record."<sup>27</sup> "Simply put," the Solicitor argued, "an appellate tribunal cannot so fundamentally change the record on appeal to reverse an administrative agency."<sup>28</sup>

The Solicitor's brief acknowledged that the rule against going outside of the record made in the lower court or other tribunal is not absolute, but argued that neither of the two recognized exceptions to the general rule applied in this case. The first exception allows an appellate court to take judicial notice of materials outside the record under Federal Rule of Evidence 201.<sup>29</sup> "Judicial notice is an evidentiary procedure for recognizing without proof the existence and truth of certain *facts* which are regarded as a matter of common knowledge or which could be instantly and unquestionably demonstrated."<sup>30</sup> The Federal Circuit has often taken judicial notice of law,<sup>31</sup> publicly available documents,<sup>32</sup> dictionary and other refer-

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785 F.2d 1029, 1031 (Fed. Cir. 1986) (dictum); *In re Moore*, 409 F.2d 585, 589 n.7 (CCPA 1969); *In re Land*, 402 F.2d 801, 804-05 & n.3 (CCPA 1968); *In re Phillips*, 315 F.2d 943, 945 (CCPA 1963)). The Federal Circuit's adherence to stare decisis is considered in Matthew F. Weil & William C. Rooklidge, *Stare Un-Decisis: The Sometimes Rough Treatment of Precedent in Federal Circuit Decision-Making*, 80 J. PAT. & TRADEMARK OFF. SOC'Y 791 (1998).

27. Petition for Rehearing at 6 (citing *Boone v. Chiles*, 35 U.S. (10 Pet.) 177, 208 (1836); *Coplin v. United States*, 761 F.2d 688, 691 (Fed. Cir. 1985)).

28. *Id.* at 5.

29. Rule 201 allows a court to take judicial notice of adjudicative facts that are not subject to reasonable dispute because they are either generally known or "capable of accurate and ready resort to sources whose accuracy cannot be reasonably questioned." FED. R. EVID. 201(a)-(b). *See, e.g., Massachusetts v. Westcott*, 431 U.S. 322, 323 n.2 (1977) (taking judicial notice of a fact not subject to reasonable dispute and readily verifiable after giving the parties an opportunity to comment and agree that such notice was proper). Judicial notice may be taken at any stage of the proceeding, including during appeal. *See* FED. R. EVID. 201(f). Most often, facts are judicially noticed for the first time on appeal in order to avoid reversal. *See* 21 CHARLES ALAN WRIGHT & KENNETH W. GRAHAM, JR., FEDERAL PRACTICE & PROCEDURE § 5110 (1977). Noticing facts for the first time on appeal to support reversal occurs in cases that "doubtless involve factors such as those that move courts to label a ruling below as 'plain error' so that it can be considered on appeal even though no objection was made at trial." *Id.*

30. *Tuxedo Monopoly, Inc. v. General Mills Fun Group, Inc.*, 648 F.2d 1335, 1339 (C.C.P.A. 1981).

31. *See, e.g., Bronson v. United States*, 46 F.3d 1573, 1581 (Fed. Cir. 1995) (change in the bankruptcy law).

32. *See, e.g., Genentech, Inc. v. United States Int'l Trade Comm'n*, 122 F.3d 1409, 1417 n.7 (Fed. Cir. 1997) (court orders); *Ginsberg v. Austin*, 968 F.2d 1198, 1201 (Fed. Cir. 1992) (General Services Administration handbook); *Dodd v. Tennessee Valley Auth.*, 770 F.2d 1038, 1039 n.1 (Fed. Cir. 1985) (TVA report filed with President and Congress).

ence work definitions,<sup>33</sup> and facts.<sup>34</sup> But, the Solicitor argued, the judicial notice exception did not apply in *Cortright* for several reasons: the panel nowhere said that it was taking judicial notice of the extra-record patents and articles;<sup>35</sup> the court has in the past refused to take judicial notice of patents raised for the first time on appeal;<sup>36</sup> judicial notice would extend only to undisputed information about the patents and articles, not to the disputed meaning of a claim term;<sup>37</sup> and the PTO was not given an opportunity “to be heard as to the propriety of taking judicial notice and the tenor of the matter noticed” as required by Rule 201(e).<sup>38</sup>

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33. See, e.g., *Marquardt Co. v. United States*, 822 F.2d 1573, 1578 (Fed. Cir. 1987) (accounting text’s distinction between acquiring and acquired corporations); *Stewart-Warner Corp. v. United States*, 748 F.2d 663, 669 & n.17 (Fed. Cir. 1984) (dictionary definition of “bicycle”); *Kimberly-Clark Corp. v. Johnson & Johnson*, 745 F.2d 1437, 1447 & n.3 (Fed. Cir. 1984) (dictionary definition of “pressure sensitive adhesive”).

34. See, e.g., *Pyles v. Merit Sys. Protection Bd.*, 45 F.3d 411, 415 (Fed. Cir. 1995) (noting that loss of intellectual faculties denominated “dementia” is due to progressive organic brain diseases); *Sears Roebuck & Co. v. United States*, 22 F.3d 1082, 1087 n.8 (Fed. Cir. 1994) (noting that television cameras existed before broadcasting systems); *Standard Havens Prods., Inc. v. Gencor Indus., Inc.*, 897 F.2d 511, 514 n.3 (Fed. Cir. 1990) (noting the “adjudicative fact” of a first office action); *Beardmore v. Department of Agric.*, 761 F.2d 677, 679 (Fed. Cir. 1985) (noting distances between cities from an American Automobile Association map).

35. Petition for Rehearing for Appellee Commissioner of Patents and Trademarks at 7, *In re Cortright*, 165 F.3d 1353 (Fed. Cir. 1999) (No. 98-1258), *reh’g denied*, No. 98-1258, 1999 U.S. App. LEXIS 9001 (Fed. Cir. Apr. 20, 1999). Although Rule 201 does not require courts to state expressly when they take judicial notice of the extra-record facts, it is plainly preferable that a court do so. See FED. R. EVID. 201(e) advisory committee’s note (“No formal scheme of giving notice is provided. An adversely affected party may . . . have no . . . notice at all. The likelihood of [such a failure of notice] is enhanced by the frequent failure to recognize judicial notice as such.”). A statement by the court in this case that it was taking judicial notice would have lent at least a modicum of procedural decorum to what appears, without it, to be unconstrained fact-finding.

36. See Petition for Rehearing at 7-8 (citing *Holmes v. Kelly*, 586 F.2d 234, 237 n.6 (C.C.P.A. 1978) (refusing to take judicial notice of a patent submitted by a party for the first time on appeal because Court charged by 35 U.S.C. § 144 with reviewing Board decisions on the evidence before the PTO); *Gellert v. Wanberg*, 495 F.2d 779, 782 (C.C.P.A. 1974) (refusing to take judicial notice of a patent because it was not of record and not considered by the Board); *In re Patrick*, 189 F.2d 614, 616 (C.C.P.A. 1951) (refusing to take judicial notice of a patent even though it was listed in a petition for reconsideration of a Board decision because it was not supplied to the Board)).

37. See *id.* at 8 (citing *Hoganas AB v. Dresser Indus.*, 9 F.3d 948, 954 n.27 (Fed. Cir. 1993) (taking judicial notice of a related patent and, in particular, of the references cited on the face page of the patent, in order to establish that a particular reference was before the examiner who examined the patent)).

38. *Id.* at 8 (quoting FED. R. EVID. 201(e)). The most powerful of these arguments seems to be this last argument, to which appellant did not respond. See Answer for Ap-

The second exception allows an appellate court to rely on extra-record materials "in the interests of justice."<sup>39</sup> But, as the Solicitor argued in *Cortright*, this exception applies only in extraordinary cases that involve misrepresentation, wrongdoing or omission, facts not involved in *Cortright*.<sup>40</sup> Although the patent applicant argued that the "interests of justice" were implicated,<sup>41</sup> it was undisputed that the applicant had not cited or argued these patents or articles to the examiner, Board or Federal Circuit. Nor did the applicant suggest the existence of misrepresentation, wrongdoing or omission, or any other reason why the extra-record materials should be considered "in the interests of justice."<sup>42</sup>

This is not to say that no argument could be made for the Federal court's hyperactivity in *Cortright*. The court reached out to the extra-record materials in order to arrive at a patent claim construction. Because the public will rely on the court's claim construction, there is arguably a public interest in ensuring that the construction be correct. The defect in this argument is that if the Federal Circuit had allowed the rejection of the claims to stand, the applicant would have been forced to return to the PTO to negotiate claim language on which he and the PTO could agree.<sup>43</sup>

In any event, the *Cortright* panel denied rehearing without issuing an opinion.<sup>44</sup> Consequently, the PTO and bar are left to wonder why the court

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pellant *Cortright* to Appellee Petition for Rehearing at 7-9, *In re Cortright*, 165 F.3d 1353 (Fed. Cir. 1999) (No. 98-1258), *reh'g denied*, No. 98-1258, 1999 U.S. App. LEXIS 9001 (Fed. Cir. Apr. 20, 1999). The PTO was, however, given an opportunity to be heard when the panel denied its petition for rehearing.

39. See, e.g., *Dakota Indus. Inc. v. Dakota Sportswear, Inc.*, 988 F.2d 61, 63 (8th Cir. 1993); *United States v. Hope*, 906 F.2d 254, 260 n.1 (7th Cir. 1990). See also *Colonial Penn Ins. Co. v. Coil*, 887 F.2d 1236, 1239 (4th Cir. 1989) (taking judicial notice of extra-record information that was "relevant to a just and fair decision").

40. See Petition for Rehearing at 8-9 (citing *Dakota Indus., Inc. v. Dakota Sportswear, Inc.*, 988 F.2d 61, 63-64 (8th Cir. 1993); *Dickerson v. Alabama*, 667 F.2d 1364, 1367-68 (11th Cir. 1982); *Erkins v. Bryan*, 663 F.2d 1048, 1052 n.1 (11th Cir. 1981)).

41. See Answer for Appellant at 9-10.

42. The appellant provided no specific analysis of her claim that the action of the court fell within the "interests of justice" exception. Rather, citing a number of cases for the general proposition that an appellate court may take judicial notice, the appellant merely stated, in a conclusory fashion, "[w]hat the Panel did with respect to the interpretation of the word 'restore' here, clearly was within the exception of the 'interests of justice.'" *Id.* at 9.

43. Between the date of the Federal Circuit's decision and its mandate, the applicant can file a continuing application under 35 U.S.C. § 120 and then prosecute that application. See 35 U.S.C. § 120 (1994); 37 C.F.R. § 1.197 (1999). In addition, she may make certain limited amendments, but not as of right. See 37 C.F.R. § 1.116(c) (1999).

44. See *In re Cortright*, No. 98-1258, 1999 U.S. App. LEXIS 9001 (Fed. Cir. Apr. 20, 1999) (nonprecedential).

did what it did, and to what extent the Federal Circuit now feels free, *sua sponte*, to consider not only new issues arising out of facts in the record of the proceedings below (but never briefed by either side), but also materials outside the record altogether, as it did in *Cortright*.<sup>45</sup> Given the large number of sources to which the court could in theory turn for new evidence, only one thing is now certain: to find out whether the Federal Circuit will undertake the effort to create a new record on appeal in any specific case, one must pursue an appeal.

### III. THE FEDERAL CIRCUIT AS ADVOCATE

As a general rule, an appellate court will not consider an argument for the first time on appeal.<sup>46</sup> The Federal Circuit has been as eloquent as any court in articulating the rule and describing its basis:

A party's argument should not be a moving target. The argument at the trial and appellate level should be consistent, thereby ensuring a clear presentation of the issue to be resolved, an adequate opportunity for response and evidentiary development by the opposing party, and a record reviewable by the appellate court that is properly crystallized around and responsive to the asserted argument.<sup>47</sup>

This rule arises from concerns for fundamental fairness long recognized by the United States Supreme Court.<sup>48</sup> Refusing to consider new arguments on appeal ensures that "parties may have the opportunity to offer all the evidence they believe relevant to the issues . . . [and] in order that litigants may not be surprised on appeal by final decision there of issues upon which they have had no opportunity to introduce evidence."<sup>49</sup>

The Federal Circuit has also emphasized that appellate courts normally limit themselves to issues that the parties have preserved below and raised on appeal.<sup>50</sup> Application of this rule "frees trial courts to focus on the factual and legal issues the parties identify as being in dispute, without hav-

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45. The court's pointed silence on the point raises the hope that this particular foray into judicial hyperactivity is an anomaly and not the beginning of a new trend.

46. See *Finnigan Corp. v. United States Int'l Trade Comm'n*, 180 F.3d 1354, 1363 (Fed. Cir. 1999).

47. *Id.* (citing *Sage Prods., Inc. v. Devon Indus., Inc.*, 126 F.3d 1420, 1426 (Fed. Cir. 1997)).

48. See *Hormel v. Helvering*, 312 U.S. 552, 556 (1941).

49. *Johns Hopkins Univ. v. CellPro, Inc.*, 152 F.3d 1342, 1362 (Fed. Cir. 1998) (quoting *Hormel v. Helvering*, 312 U.S. 552, 556 (1941)) (alteration in original).

50. See *Seal-Flex, Inc. v. Athletic Track & Court Constr.*, 172 F.3d 836, 852 (Fed. Cir. 1999) (Bryson & Newman, JJ., concurring).

ing to worry that a misstep on an issue not disputed or objected to by the parties will result in a reversal.”<sup>51</sup> This rule also lets “appellate courts focus on issues that the trial courts have expressly ruled on and that the parties have briefed on appeal, rather than having to venture opinions regarding issues that have never been briefed, argued, or even adverted to in the course of the proceedings.”<sup>52</sup>

The Federal Circuit, however, has recently given short shrift to the general rule against considering arguments for the first time on appeal, instead grounding an increasing number of its dispositions on arguments raised by a party for the first time on appeal or, sometimes, arguments not made on appeal by either party. For example, in one recent case, *Rodime PLC v. Seagate Technology, Inc.*,<sup>53</sup> the Federal Circuit reversed a grant of summary judgment of patent noninfringement because the district court had erred in concluding that the patent claim limitation at issue was a “means-plus-function” limitation governed by 35 U.S.C. § 112 ¶ 6.<sup>54</sup> Significantly, neither the patentee nor the accused infringer argued to the Federal Circuit that the subject limitation was anything other than a means plus function limitation. Sua sponte, the Federal Circuit reversed the district court on an issue that no one raised on appeal.<sup>55</sup>

The Federal Circuit explained its action by noting that:

Before the district court, Rodime argued that the “positioning means” element did not invoke § 112, ¶ 6. . . . On appeal, how-

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51. *Id.*

52. *Id.*

53. 174 F.3d 1294 (Fed. Cir. 1999), *cert. denied*, 120 S.Ct. 933 (2000). The Federal Circuit denied Seagate’s petition for rehearing and declined Seagate’s suggestion for rehearing en banc. *See Rodime PLC v. Seagate Tech., Inc.*, No. 98-1076, 1999 U.S. App. LEXIS 14193 (Fed. Cir. June 3, 1999). Seagate filed a petition for certiorari arguing, *inter alia*, that the Federal Circuit erred in reviewing the district court’s claim construction de novo, without deference to the district court’s findings. Seagate’s criticism of the Federal Circuit’s de novo review is bolstered by the fact that the parties did not argue the issue on appeal, and the court presumably did not have before it the expert testimony on which the district court based its claim construction. Without that testimony the Federal Circuit may have had difficulty in viewing the claim terms as one of ordinary skill in the art would view them.

54. *See Rodime*, 174 F.3d at 1303.

55. For the court to rely on an argument not raised by either party to support a reversal (such as in *Rodime*) or a dissent from an affirmance (*see, e.g., Ritchie v. Simpson*, 170 F.3d 1092, 1099-1100 (Fed. Cir. 1999) (Newman, J., dissenting)) makes less sense than doing so to support affirmance. *See WRIGHT & GRAHAM, JR., supra* note 29 (arguing that “[w]here the issue of judicial notice is raised for the first time on appeal, the appellate court is faced with a conflict . . . . This dilemma disappears . . . when judicial notice is raised for the purpose of affirming the decision below.”).

ever, *Rodime* appears to have conceded this threshold issue. . . . That conversion, however, does not relieve this court of its responsibility to interpret the claims as a matter of law.

To be sure, the Federal Circuit is not bound by the parties' stipulations of law.<sup>56</sup> And, of course, the court does have the power to consider new arguments on appeal.<sup>57</sup> But it has stated repeatedly that it is reluctant to do so, and that it will do so only in certain narrowly defined circumstances, such as "when necessary to avoid manifest injustice,"<sup>58</sup> when the issue is one of pure law<sup>59</sup> (as contrasted with claim construction, for example, which is a question of law based on underlying factual findings), or when the argument goes to jurisdiction.<sup>60</sup>

As with *Cortright*, the Federal Circuit's hyperactivity in *Rodime* could arguably find justification in the importance of claim construction—an issue of law—to the public at large. The Federal Circuit's claim construction would likely follow the patent and be relied on by the public. The importance of this public notice function indubitably gave rise to the Federal Circuit's sense of "responsibility to interpret the claims as a matter of law."<sup>61</sup>

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56. See *Technicon Instr. Corp. v. Alpkem Corp.*, 866 F.2d 417, 421-22 (Fed. Cir. 1989).

57. The Supreme Court has recognized that "[t]here may be exceptional cases or particular circumstances which will prompt a reviewing or appellate court, where injustice might otherwise result, to consider questions of law which were neither pressed nor passed upon by the court or administrative agency below." *Hormel v. Helvering*, 312 U.S. 552, 557 (1941). The Supreme Court has announced no general rule, stating instead that "[t]he matter of what questions may be taken up and resolved for the first time on appeal is one left primarily to the discretion of the courts of appeals, to be exercised on the facts of individual cases." *Singleton v. Wulff*, 428 U.S. 106, 121 (1976). Last term, the Supreme Court twice decided issues that had not been briefed by the parties or argued before the Court. *Pike*, *supra* note 5, at 5, and *Chemerinsky*, *supra* note 6, at 25-26, describe how in *Reno v. American-Arab Anti-Discrimination Committee*, 525 U.S. 471 (1999), the Court decided an issue that it announced it would not consider when it took the case, and in *Kolstad v. American Dental Association*, 527 U.S. 526 (1999), the Court decided an issue that was not among the questions presented in the case and was neither briefed nor argued.

58. *Braun, Inc. v. Dynamics Corp.*, 975 F.2d 815, 821 n.12 (Fed. Cir. 1992) (dictum).

59. See *Bellotti v. Baird*, 428 U.S. 132, 143-44 n.10 (1976).

60. See *Minnesota Chippewa Tribe v. United States*, 768 F.2d 338, 341 (Fed. Cir. 1985).

61. As to such apparent importance, however, courts have at their disposal special procedures for requesting additional briefing and even expediting consideration of important and pressing matters. See *Chemerinsky*, *supra* note 6, at 26. The Federal Circuit is no exception to this rule.

This "responsibility," however, is apparently not absolute. In a similar case that pre-dated *Rodime*, the Federal Circuit noted that neither party had raised a particular claim construction issue but refrained from addressing that issue other than to note: "Because that question was not presented, and because the claimed invention as argued would have been obvious at the time it was made to those skilled in the art, we need not and do not decide the question here."<sup>62</sup> In another pre-*Rodime* opinion, this one *per curiam*, the court noted that "where, as here, the parties agree to a particular construction of the claims which is adopted by the district court, and neither party disputes that construction on appeal, this court declines to raise an issue sua sponte which the parties have not presented on appeal."<sup>63</sup> In a concurrence, however, one panel member opined that because claim construction is an issue of law the court has an obligation to review it.<sup>64</sup> In another concurrence to the same opinion, the other two panel members rejected this assertion.<sup>65</sup> Likewise, in a similar case that post-dated *Rodime*,<sup>66</sup> the court noted its concern with the claim construction but stated that "where, as here, the parties agree to a claim construction that is adopted by the district court, and neither party disputes that construction on appeal, we decline to raise an issue sua sponte that the parties have not presented."<sup>67</sup>

Now the bar is left to wonder why and when the court will consider arguments raised for the first time on appeal and arguments not made by

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62. *Medtronic, Inc. v. Cardiac Pacemakers, Inc.*, 721 F.2d 1563, 1582 (Fed. Cir. 1983). *Accord* *Dawn Equipment Co. v. Kentucky Farms, Inc.*, 140 F.3d 1009, 1015 n.2 (Fed. Cir. 1998) ("[B]ecause neither party addresses the point, we shall assume that it is legally proper to apply the doctrine of equivalents to a claim drafted in means-plus-function form.").

63. *Seal-Flex, Inc. v. Athletic Track & Court Constr.*, 172 F.3d 836, 842 (Fed. Cir. 1999) (*per curiam*).

64. *See id.* at 847 (Rader, J., concurring).

65. *See id.* at 851-52 (Bryson & Newman, JJ., concurring) ("We have no duty, with respect to claim construction or any other nonjurisdictional legal issue, to address questions the parties have not preserved for appeal and have not presented as grounds for challenging or supporting the judgment of the trial court.").

66. *WMS Gaming, Inc. v. International Game Tech.*, 184 F.3d 1339 (Fed. Cir. 1999).

67. *Id.* at 1348 n.2. In *WMS Gaming*, the district court had accepted a stipulation by the parties regarding the claim construction. *See id.* The Federal Circuit, however, is not bound by such stipulations. *See Technicon Instr. Corp. v. Alpkem Corp.*, 866 F.2d 417, 421-22 (Fed. Cir. 1989).

either party but concocted by the court itself. Once again, the only way to find out is to take an appeal.<sup>68</sup>

#### IV. THE FEDERAL CIRCUIT AS FACT-FINDER

As an appellate court, the Federal Circuit's role is not to hear evidence *de novo*.<sup>69</sup> Fairness to the litigants weighs against reconsideration of the facts at the appellate level.<sup>70</sup> Appellate fact-finding would undermine the lower tribunal's legitimacy, increase the number of appeals by encouraging litigants to retry cases at the appellate level, and needlessly reallocate judicial authority.<sup>71</sup>

Not long after it was first constituted, the Federal Circuit was criticized for fact-finding. That criticism came both from the bar<sup>72</sup> and from within the court itself.<sup>73</sup> In response to these complaints, the Supreme Court sent a case back to the Federal Circuit, publicly questioning whether the panel had engaged in impermissible fact-finding.<sup>74</sup>

Petitioner contends that the Federal Circuit ignored Federal Rule of Civil Procedure 52(a) in substituting its view of factual issues for that of the District Court. . . . Petitioner's claims are not insubstantial. . . . The Federal Circuit . . . did not mention Rule 52(a), did not explicitly apply the clearly-erroneous standard to any of the District Court's findings on obviousness, and did not explain why, if it was of that view, Rule 52(a) had no applicability to this issue.<sup>75</sup>

Chastened by this public rebuke, the Federal Circuit studiously avoided at least overt fact-finding for years. It would appear, however, that

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68. Ironically, Judge Rader, the author of the *Rodime* opinion and *Seal-Flex* concurrence, has argued that the Federal Circuit's lack of deference to trial courts will increase litigation, discourage settlement, and promote uncertainty. See *Cybor Corp. v. FAS Tech., Inc.*, 138 F.3d 1448, 1476 (Fed. Cir. 1998) (Rader, J., dissenting).

69. See *Zenith Radio Corp. v. Hazeltine Research, Inc.*, 395 U.S. 100, 123 (1969) (“[A]ppellate courts must constantly have in mind that their function is not to decide factual issues *de novo*.”).

70. See *Anderson v. City of Bessemer City*, 470 U.S. 564, 575 (1985).

71. See FED. R. CIV. P. 52(a) advisory committee's note on 1985 Amendment.

72. See, e.g., Strawbridge et al., *supra* note 13, at 875 (“The Federal Circuit has had considerable difficulty adjusting to its role as a court of appeals under Rule 52(a).”); McGirr, *supra* note 7, at 967, 980-81; Filardi & Scheinfeld, *supra* note 13, at 14 n.3.

73. See, e.g., *RCA Corp. v. Applied Digital Data Sys., Inc.*, 730 F.2d 1440, 1449 (Fed. Cir. 1984) (Kashiwa, J., dissenting); *Jones v. Hardy*, 727 F.2d 1524, 1534-35 (Fed. Cir. 1984) (Kashiwa, J., dissenting).

74. *Dennison Mfg. Co. v. Panduit Corp.*, 475 U.S. 809, 811 (1986).

75. *Id.* at 810-11.

the court might now be backsliding,<sup>76</sup> most often by reaching out to make factual findings as an alternative to remanding a case to be considered anew in the district court. As we will discuss, this is problematic enough when the court engages in fact-finding on the basis of arguments presented and considered below and urged again by one of the parties on appeal. We shall also explore a particularly troubling case in which the Federal Circuit not only engaged in fact-finding but did so pursuant to a claim construction never urged by either party to the appeal.

### A. The Temptation to Find Facts Rather than Remand

While this article does not purport to offer a comprehensive review of all instances of judicial hyperactivity in the Federal Circuit, the cases we have reviewed suggest that the Federal Circuit is particularly tempted to engage in appellate fact-finding when deciding whether to remand after a reversal of a trial court's decision, and when reviewing a grant of summary judgment where there was no cross motion for summary judgment. We shall consider these two situations in turn.

#### 1. *Remand for new findings*

While the occasional dissent charges the panel majority with appellate fact-finding in other contexts,<sup>77</sup> fact-finding is particularly dangerous when the court relies on its own findings of fact to avoid remand. If an appellate court determines that the lower tribunal failed to make a necessary finding or sets aside the lower tribunal's fact-findings, then the appellate court generally should remand to the lower tribunal to make the necessary findings.<sup>78</sup> It is not the role of the appellate court to make factual findings on its own.<sup>79</sup>

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76. Even the federal government has recently accused the Federal Circuit of appellate fact-finding. *See, e.g., Hughes Aircraft Co. v. United States*, 140 F.3d 1470, 1474 n.3 (Fed. Cir. 1998) (refusing to consider government's allegations of appellate fact-finding because Supreme Court's remand was limited).

77. *See, e.g., K-2 Corp. v. Salomon S.A.*, 191 F.3d 1356, 1371 (Fed. Cir. 1999) (Rader, J., dissenting) (majority affirmed the decision below); *Metric Constructors, Inc. v. Goldin*, No. 95-1078, 1995 U.S. App. LEXIS 30300, at \*23 (Fed. Cir. Oct. 20, 1995) (nonprecedential) (Nies, J., dissenting) (majority reversed and remanded); *Malta v. Schulmerich Carillons, Inc.*, 952 F.2d 1320, 1343 (Fed. Cir. 1991) (Newman, J., dissenting) (majority affirmed the decision below).

78. *See Icicle Seafoods, Inc. v. Worthington*, 475 U.S. 709, 713-14 (1986) ("If the Court of Appeals believed that the District Court failed to make findings of fact essential to a proper resolution of the legal question, it should have remanded to the District Court to make those findings."); *Pullman-Standard v. Swint*, 456 U.S. 273, 291 ("When an appellate court discerns that a district court has failed to make a finding because of an erroneous view of the law, the usual rule is that there should be a remand for further proceed-

There is one exception—or, more precisely, one refinement—to the general rule favoring remand: remand is not necessary in cases where “the record permits only one resolution of the factual issue.”<sup>80</sup> Strictly speaking, this determination is not fact-finding at all. Courts may decide cases as a matter of law where the undisputed facts admit of only one conclusion.<sup>81</sup> In arriving at such a conclusion, the court—be it a trial court or an appellate court—is not engaged in fact-finding.<sup>82</sup>

Picking up on this “exception,” the Federal Circuit has suggested on several occasions that it is free to decide a case, instead of remanding, where the record is clear and the facts uncontradicted.<sup>83</sup> Even where the evidence is disputed, the Federal Circuit feels free to decide the case when

ings to permit the trial court to make the missing findings.”); *DeMarco v. United States*, 415 U.S. 449, 450 n.1 (1974) (“[Fact-finding] is the basic responsibility of district courts, rather than appellate courts, and . . . the Court of Appeals should not have resolved in the first instance this factual dispute which had not been considered by the District Court.”). If, on the other hand, the lower tribunal’s fact-findings were unassailable but the proper rule of law was misapplied to those findings, the appellate court may reverse. See *Icicle Seafoods*, 475 U.S. at 714.

79. See *Icicle Seafoods*, 475 U.S. at 714. As a consequence, in a case where the Federal Circuit rejected the district court’s basis for dismissing a declaratory judgment action seeking a declaration of patent noninfringement, the court remanded for findings on the plaintiff’s objectively “reasonable apprehension” of suit, even though the declarations on that issue were before the Federal Circuit. *International Med. Prosthetics Research Assoc., Inc. v. Gore Enter. Holdings, Inc.*, 787 F.2d 572, 577 (Fed. Cir. 1986).

80. *Pullman-Standard*, 456 U.S. at 292 (dictum); *Ralls v. United States*, 52 F.3d 223, 1226 (9th Cir. 1995). But see Stuart Minor Benjamin, *Stepping into the Same River Twice: Rapidly Changing Facts and the Appellate Process*, 78 TEX. L. REV. 269, 334 (1999) (arguing that rapidly changing facts can justify appellate fact-finding).

81. Examples include summary judgment pursuant to Federal Rule of Civil Procedure 56 and judgment as a matter of law pursuant to Federal Rule of Civil Procedure 50. The assessment of the sufficiency of the evidence to support a jury verdict or bench judgment is labeled a question of law, although it is necessarily a fact-based task. See Eric Schnapper, *Judges Against Juries—Appellate Review of Federal Civil Jury Verdicts*, 1989 WIS. L. REV. 237, 299 (1989).

82. See *Cable Elec. Prods., Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1020 (Fed. Cir. 1985) (“To engage in fact finding [in connection with a summary judgment motion] would be not only inappropriate, but would per se imply the impropriety of the grant.”). As the Court has observed:

[t]o affirm a grant of summary judgment, an appellate court must accordingly determine that the record demonstrates an absence of any actual dispute as to factual inferences which would have a material impact on the entitlement of the summary judgment movant to judgment as a matter of law . . . . For summary judgment, fact-finding is an inappropriate exercise, at either the appellate or the district court level.

*Lemelson v. TRW, Inc.*, 760 F.2d 1254, 1260 (Fed. Cir. 1985).

83. See, e.g., *Jones v. Hardy*, 727 F.2d 1524, 1531-32 (Fed. Cir. 1984).

“the court could only make one finding of fact or decide the fact in only one way.”<sup>84</sup> But whether the record is clear and whether a fact could be decided in only one way are often subjects of dispute, and the “clear record” exception to remand “leaves much room for abuse.”<sup>85</sup> The Federal Circuit’s interpretation of what findings are clear on the record, some fear, could expand and contract at the court’s whim.<sup>86</sup>

The Federal Circuit is particularly tempted to avoid remand in cases where it rejects the lower tribunal’s foundational decision on claim interpretation or literal infringement. For example, in *Pall Corp. v. Hemasure, Inc.*,<sup>87</sup> the court reversed the district court’s grant of summary judgment of literal infringement and, even though the district court had not reached the issue, went on to enter judgment of noninfringement, in effect granting the defendant’s cross-motion for summary judgment.<sup>88</sup> Because there was no dispute as to the structure of the accused device, and because the parties argued infringement under the doctrine of equivalents on summary judgment, the Federal Circuit resolved the issue, finding no infringement under the doctrine of equivalents.<sup>89</sup> This resolution was not unreasonable under these limited circumstances. This willingness to address issues on which the lower tribunal has not passed, however, can quickly go too far.

For example, in one early case the Federal Circuit avoided remand because “the record is relatively short and the legal and factual issues are uncomplicated and not difficult to resolve.”<sup>90</sup> Clearly, this goes too far and reeks of impermissible fact-finding. That a factual issue is uncomplicated or not difficult to resolve does not mean that that issue could be decided in only one way.

In a more recent case,<sup>91</sup> which the court remanded for a finding on infringement after reversing the district court’s claim interpretation, Judge

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84. *SmithKline Diagnostics, Inc. v. Helena Lab. Corp.*, 859 F.2d 878, 886 n.4 (Fed. Cir. 1988).

85. *McGirr*, *supra* note 7, at 980.

86. *See id.*

87. 181 F.3d 1305 (Fed. Cir. 1999).

88. *See id.* at 1306.

89. *See id.* at 1312. This was not a case like *MEHL/Biophile International Corp. v. Milgraum*, 192 F.3d 1362 (Fed. Cir. 1999), where the Federal Circuit rejected the district court’s basis for grant of summary judgment but nevertheless *affirmed* the judgment on another ground that was briefed by the parties on summary judgment below but not decided by the district court.

90. *Baginsky v. United States*, 697 F.2d 1070, 1074 (Fed. Cir.), *cert. denied*, 464 U.S. 981 (1983).

91. *Smiths Indus. Med. Sys., Inc. v. Vital Signs, Inc.*, 183 F.3d 1347 (Fed. Cir. 1999).

Lourie dissented, arguing that under the proper claim interpretation, the accused device “clearly” did *not* meet the disputed claim limitation, either literally or under the doctrine of equivalents.<sup>92</sup> But even if the technical subject matter were, as Judge Lourie stated, “readily understandable,”<sup>93</sup> the factual finding of infringement is best made in the first instance by the trial court because at least one of the litigants might well disagree with the appellate court’s “understanding” of the facts, regardless of how “readily understandable” the technical subject matter.<sup>94</sup>

## 2. *Sua sponte grant of summary judgment*

Appellate courts are also tempted to exhibit judicial hyperactivity when reviewing a grant of summary judgment where there was no cross motion for summary judgment. Reversal of the grant of summary judgment should be accompanied by a remand for the district court to proceed with the case. Sometimes, however, an appellate court comes to believe that its reversal of the grant of summary judgment warrants more than a mere remand. Judicial hyperactivity results when that belief is translated into action.

The Federal Circuit has engaged in such hyperactivity. For instance, in *Chiuminatta Concrete Concepts, Inc. v. Cardinal Industries, Inc.*,<sup>95</sup> the Federal Circuit considered a district court’s grant of summary judgment of literal infringement, along with the patentee’s argument that even if the Federal Circuit disagreed with the grant of summary judgment of literal infringement, it could still affirm the judgment on the ground of infringement under the doctrine of equivalents.<sup>96</sup> The Federal Circuit did disagree with the district court on literal infringement and was willing to consider the doctrine of equivalents even though the district court had not reached it, but the court did not agree that the evidence on summary judgment

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92. *Id.* at 1360 (Lourie, J., dissenting).

93. *Id.* at 1359.

94. The potential for disagreement looms large because “left to their own devices, a large number of appellate judges simply cannot resist acting like super-jurors, reviewing and revising civil verdicts to assure that the result is precisely the verdict they would have returned had they been in the jury box.” Schnapper, *supra* note 81, at 354. Fortunately, the notion that the Federal Circuit can decide the infringement issue for itself where the subject matter is “readily understandable” has so far remained confined to a dissenting opinion.

95. 145 F.3d 1303 (Fed. Cir. 1998).

96. The patentee was correct in its assertion that the Federal Circuit may affirm a judgment by relying on grounds briefed on summary judgment but not reached by the district court. *See MEHL/Biophile Int’l Corp. v. Milgraum*, 192 F.3d 1362, 1366 (Fed. Cir. 1999).

showed infringement under the doctrine of equivalents.<sup>97</sup> Rather than simply reversing the district court's grant of summary judgment, however, the Federal Circuit went on to direct the district court to enter summary judgment of noninfringement.<sup>98</sup> This result was surprising for several reasons, not the least of which was that the accused infringer had never even moved for summary judgment of noninfringement.

The *Chiuminata* opinion justified the Federal Circuit's sua sponte grant of summary judgment by citing a Ninth Circuit case for the proposition that "a court may sua sponte grant summary judgment to the nonmoving party where the moving party cannot prove its case on the undisputed facts."<sup>99</sup> The problem with the Federal Circuit's reliance on this precedent is two-fold. First, the Ninth Circuit was addressing a sua sponte grant of summary judgment by a trial court, not an appellate court. The Ninth Circuit authority does not support an appellate court's sua sponte grant of summary judgment.

Second, even as to the trial court's ability to grant summary judgment sua sponte, the Federal Circuit grossly mischaracterized Ninth Circuit law. Under Ninth Circuit law, a trial court may grant summary judgment sua sponte against a nonmoving party only if that party was "given reasonable notice that the sufficiency of his or her claim will be in issue."<sup>100</sup> "Reasonable notice implies adequate time to develop the facts on which the litigant will depend to oppose summary judgment."<sup>101</sup> On appeal, however, the record is—or should be—fixed by the record that was before the district court.<sup>102</sup> Unless the appellate court is willing to take on the entirely improper role of receiving from the moving party additional evidence to oppose summary judgment, the moving party cannot be afforded the required notice. A court should grant summary judgment sua sponte only if it has

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97. See *Chiuminata*, 145 F.3d at 1310-11.

98. See *id.* at 1311.

99. *Id.* (citing *Cool Fuel, Inc. v. Connett*, 685 F.2d 309, 311 (9th Cir. 1982)).

100. *O'Keefe v. Van Boening*, 82 F.3d 322, 324 (9th Cir. 1996) (holding that consideration of a supplemental submission on a motion for reconsideration afforded the moving party fair notice of sua sponte summary judgment); see also *Buckingham v. United States*, 998 F.2d 735, 742 (9th Cir. 1982) (reversing sua sponte grant of summary judgment and remanding for further proceedings where adversely affected party was not given adequate notice).

101. *O'Keefe*, 82 F.3d at 324; see also *Portsmouth Square, Inc. v. Shareholders Protective Comm.*, 770 F.2d 866, 869 (9th Cir. 1985) (holding that plaintiff had full opportunity to develop the facts in support of its case because its discovery was complete at the time of the pretrial proceedings).

102. See generally *supra* Part I.

given the moving party reasonable notice and an opportunity to submit evidence to oppose the grant. An appellate court simply cannot do that.

It is easy to understand the Federal Circuit's motivation to grant summary judgment *sua sponte* in *Chiuminatta*. By explaining that the determination of no literal infringement precluded a finding of infringement under the doctrine of equivalents, the Federal Circuit saved the trial court the effort of determining that result for itself.<sup>103</sup> The *Chiuminatta* patentee had argued for summary judgment of infringement under the doctrine of equivalents and, the Federal Circuit decided, failed to present evidence on which a reasonable jury could find for it on that issue. The patentee had its one bite at the apple; fairness—it might be said—dictates that it not be given another.

Appealing as this argument may be, however, the Federal Circuit should not be able to grant summary judgment *sua sponte* where the trial court could not. Because the Federal Circuit cannot to give meaningful notice to the movant, its *sua sponte* grant of summary judgment will strike the movant as at least unfair and possibly as a denial of due process.<sup>104</sup> The availability of that outcome will spur disappointed nonmovants to appeal, seeking the grant of a summary judgment for which they never asked. As a result, appeals will increase while confidence in the court decreases.

## **B. *Exxon v. Lubrizol*: the Federal Circuit Succumbs to a Double Temptation**

The damage of appellate fact-finding increases as the Federal Circuit, appearing increasingly comfortable with its *de facto* role as the final arbiter of patent law and procedure, becomes more willing to adopt claim constructions that were not advocated by the parties or adopted by the trial court. An example of this form of judicial hyperactivity is *Exxon Chemical*

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103. The *Chiuminatta* panel declined to decide whether equivalence under 35 U.S.C. § 112 ¶ 6, is a question of fact or law. See *Chiuminatta*, 145 F.3d at 1309 (noting that the issue had been left open in *Markman v. Westview Instruments*, 52 F.3d 967, 977 n.8 (Fed. Cir. 1995) (en banc), *aff'd*, 517 U.S. 370 (1996)).

104. In this regard, the appellate posture is entirely different from review of a trial court's decision to grant or deny a motion for judgment as a matter of law after a jury trial, as in *Dawn Equipment Co. v. Kentucky Farms, Inc.*, 140 F.3d 1009, 1014-18 (Fed. Cir. 1998). In that situation, the appellee has been afforded every opportunity to submit its evidence on the issue. Nevertheless, one commentator suggests that "[w]here an appellate court identifies a defect in the evidence which was not perceived by the trial judge, it should leave to the trial court the choice between judgment *n.o.v.* and a new trial, unless special circumstances make such a remand clearly inappropriate." Schnapper, *supra* note 81, at 310.

*Patents v. Lubrizol Corp.*,<sup>105</sup> where the Federal Circuit rejected the trial court's interpretation of the patent claims, as well as those of both parties.<sup>106</sup> Accordingly, the Federal Circuit vacated the trial court's judgment in favor of the patentee. The court went on to state that "[w]hen we determine on appeal, as a matter of law, that a trial judge has misinterpreted a patent claim, we independently construe the claim to determine its correct meaning, and then determine if the facts presented at trial can support the appealed judgment."<sup>107</sup>

The Federal Circuit explained that if the facts presented at trial cannot support the judgment under the Federal Circuit's claim construction, "we reverse the judgment below without remand for a second trial on the correct law."<sup>108</sup> That is what the court did, relying on *Boyle v. United Technologies Corp.*,<sup>109</sup> a case in which the Supreme Court held that a circuit court could reverse without remand if the evidence presented at trial would not support the jury verdict for the plaintiff under the properly formulated defense.<sup>110</sup> The *Boyle* Court considered it irrelevant that the defendant had not objected to a jury instruction that supported the verdict and that the circuit court had adopted the formulation of the defense for the first time in that very case.<sup>111</sup> The Court remanded to ensure that the circuit court had not improperly assessed on its own whether the defense had been established but had properly decided that no reasonable jury could, under the properly formulated defense and the facts presented, have found for the plaintiff.<sup>112</sup> The *Boyle* holding, therefore, supports the Federal Circuit's reversal without remand in *Exxon*.

The troubling aspect of the Federal Circuit's opinion is the threshold determination to adopt a claim construction advanced by neither of the parties at trial.<sup>113</sup> As the dissent in *Exxon* argued, "[b]y advocating a different interpretation of the claim sua sponte, the majority required *Exxon* to litigate during trial not only its opponent's position but also the unknowable position of the appellate court."<sup>114</sup> Consequently, argued the

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105. 64 F.3d 1553 (Fed. Cir. 1995).

106. See *id.* at 1556. Interpretation of patent claims is an issue of law. See *Markman v. Westview Instruments*, 52 F.3d 967, 979 (Fed. Cir. 1995), *aff'd*, 517 U.S. 370 (1996).

107. *Exxon Chem. Patents*, 64 F.3d at 1560.

108. *Id.*

109. 487 U.S. 500 (1988).

110. See *id.* at 513.

111. See *id.* at 513-14.

112. See *id.* at 514.

113. See generally *supra* Part II.

114. *Exxon Chem. Patents v. Lubrizol Corp.*, 64 F.3d 1553, 1569 (Fed. Cir. 1995) (Nies, J., dissenting).

dissent, the defendant won on a claim interpretation that it could never have raised on appeal because that interpretation was not argued in the motions for judgment as a matter of law.<sup>115</sup> Further, by applying its own interpretation to the facts, the Federal Circuit intruded on the role of the jury. As one commentator suggests, “[I]f the [Federal Circuit] persists in applying its own interpretation of the claims to the facts without a new trial, there truly is no remaining purpose for a jury in this process.”<sup>116</sup>

Of course, the extent to which the *Exxon* court’s claim construction differed from those of the parties was the subject of disagreement, with the panel majority asserting that its interpretation was “but a slight variance from that urged” by one of the parties.<sup>117</sup> The further the position adopted by the Federal Circuit from those advanced by the parties at trial, the more incongruous reversal without remand seems.<sup>118</sup> The more willing the Federal Circuit is to hold that no reasonable jury could find facts to support the Federal Circuit’s claim construction—without ever giving a jury (reasonable or not) a chance to do so—the more the court appears to assume the jury’s fact-finding role. Indeed, some Federal Circuit opinions read almost like trial court opinions, weighing conflicting evidence as if the court were a “super-juror,” with only a nod to the standard that no reasonable jury could find one way or the other.<sup>119</sup>

The Federal Circuit’s temptation to resolve cases instead of sending them back to the trial court for factual findings is understandable. Resolution by the appellate court avoids “unnecessary remand, for the perfunctory task of making fact-findings that are clear on the record.”<sup>120</sup> Other-

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115. *See id.* at 1568. The majority held the appellant’s motion for judgment as a matter of law adequate. *See id.* at 1561 n.6.

116. Gregory D. Leibold, *In Juries We Do Not Trust: Appellate Review of Patent Infringement Litigation*, 67 U. COLO. L. REV. 623, 670 (1996). Nor, one might add, is there much need for JMOL motions.

117. *Exxon Chem. Patents*, 64 F.3d at 1560. The defendant interpreted the claim at issue to read only on “end product compositions.” *Id.* at 1558. The Federal Circuit held that the claimed recipe ingredients must be present in the accused products “at some time,” but not necessarily in the end product. *Id.*

118. Likewise, when the Federal Circuit adopts a new procedural rule not applied by the trial court, remand would seem appropriate. *But see Lear Siegler v. Sealy Mattress Co.*, 873 F.2d 1422 (Fed. Cir. 1989) (reversing without remand after adopting a rule restricting the way in which patentees must prove infringement under the doctrine of equivalents in jury cases); *Malta v. Schulmerich Carillons, Inc.* 952 F.2d 1320 (Fed. Cir. 1991) (applying the *Lear-Siegler* rule to a *pre-Lear-Siegler* jury verdict and reversing without remanding).

119. *See, e.g., Dawn Equip. Co. v. Kentucky Farms, Inc.*, 140 F.3d 1009, 1014-17 (Fed. Cir. 1998).

120. McGirr, *supra* note 7, at 981.

wise, "protracted litigation and unnecessary delay and expense would occur."<sup>121</sup>

Although judicial economy is both a laudable goal and a powerful argument, appellate fact-finding will lead to more protracted litigation, not less. If the Federal Circuit were free to find its own facts in considering arguments not raised or resolved below, the appellant would be encouraged to "shotgun" its appeal—that is, to raise as many issues as it possibly can in the space allowed, hoping that at least one will appeal to a hyperactivist panel. Encouraging this "scattershot" approach would reward belated legal creativity at the expense of the appellee, whose job should be nothing more than defending the decision reached below. Opening the door to new arguments on appeal ensures that neither party would be able to predict the facts, arguments or issues that would form the basis for the appellate court's decision. Inevitably, this uncertainty would result in an increase in appeals, an effect directly opposite to the judicial economy that motivates Federal Circuit fact-finding.<sup>122</sup>

## V. THE EXPANDING ROLE OF THE FEDERAL CIRCUIT

As we have shown, the Federal Circuit is exhibiting symptoms of judicial hyperactivity. Nevertheless, it would be unfair (and incorrect) to suggest that the Federal Circuit alone is responsible for its judicial hyperactivity, or that every case in which the court's jurisdiction is expanded necessarily presents a case of judicial hyperactivity.

Part of the responsibility rests on the Supreme Court. For example, by confirming that claim construction is an issue of law for the court to decide, the Supreme Court's ruling in *Markman v. Westview Instruments*<sup>123</sup> plainly hastened the Federal Circuit's move toward greater involvement as an appellate tribunal in the sorts of de novo review that have tempted the court to take on the role of advocate. In the first year or so after the *Markman* decision, it appeared that the Federal Circuit was reversing and remanding to the lower courts over a third of the claim constructions it reviewed.<sup>124</sup> While some observers have attributed this high rate of reversals

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121. *SmithKline Diagnostics, Inc. v. Helena Lab. Corp.*, 859 F.2d 878, 886 n.4 (Fed. Cir. 1988).

122. *See Malta*, 952 F.2d at 1332 (Newman, J., dissenting) ("[B]roadening appellate review . . . impairs the confidence of litigants and the public in the decisions of the trial courts, and it multiplies the number of appeals." (citing Charles Alan Wright, *The Doubtful Omniscience of Appellate Courts*, 41 MINN. L. REV. 751, 779 (1957))).

123. 517 U.S. 370, 372 (1996).

124. *See Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1476 n.4 (Fed. Cir. 1998) (en banc) (Rader, J., dissenting) (noting that 47 of 126, or 37.3%, of Federal Circuit deci-

to district court judges' unfamiliarity with complex technical issues and their apparent unwillingness to properly construe patent claims,<sup>125</sup> others have criticized the Federal Circuit's close review under the de novo standard as a "constitutionally troubling" effort to limit the role of juries in patent cases.<sup>126</sup>

To be sure, "[c]haracterization of an issue of law application as fact or law for purposes of identifying a formalized standard of review depends on the perceived need for review, not on the actual status of the issue."<sup>127</sup> In other words:

findings of fact may be defined as the class of decisions we choose to leave to the trier of fact subject only to limited review, while conclusions of law are the class of decisions which reviewers chose [sic] to make for themselves without deference to the judgment of the trial forum.<sup>128</sup>

Because the Federal Circuit's labeling of issues as fact or law is the exercise of its appellate judicial power, albeit in a way that some would criticize, these decisions do not raise concerns of judicial hyperactivity unless the Federal Circuit declares something a question of fact, then resolves the factual dispute instead of remanding for fact-finding below. Judicial expansion involving only the labeling of issues is therefore beyond the scope of this article.

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sions reviewing the issue of claim construction were reversed between the date *Markman* was decided (April 5, 1995) and November 24, 1997).

125. See Robert N. Young, *Judge Versus Jury On The Scales Of Justice: 35 U.S.C. § 112, ¶ 6 "Equivalents" In The Balance*, 32 J. MARSHALL L. REV. 833, 857 (1999), and sources cited therein, including Margaret Cronin Fisk, *Confusion Follows '96 Landmark Patent Case: "Markman" Decision Didn't Turn Out As Most Predicted*, NAT'L L.J., June 15, 1998, at A1 (noting that some district court judges construe patent claims narrowly to make summary judgment proper, effectively dumping the problem of claim construction on the Federal Circuit through appellate review); Philip J. McCabe & P. McCoy Smith, *Courts Order "Markman" Hearings Early In Cases: Such Hearings Often Precipitate A Party's Request For Summary Judgment or a Settlement Order*, NAT'L L.J., Oct. 19, 1998, at C42 (noting that judges are pushing claim construction to an earlier time in the case to achieve quicker disposition).

126. Leibold, *supra* note 116, at 625. See generally *id.* On the other hand, the Court's labeling the obviousness issue as a question of law has been applauded as an appropriate way to achieve national uniformity in patent cases. See Cooper, *supra* note 7, at 668. Needless to say, the bar is not of one mind regarding the Federal Circuit's treatment of jury verdicts in patent cases.

127. Cooper, *supra* note 7, at 660.

128. Carrington, *The Power of District Judges and the Responsibility of Courts of Appeals*, 3 GA. L. REV. 507, 518 (1969).

Also beyond the scope of this article is the extent of review of fact-finding that the court engages in under the Rule 52(a) clearly erroneous standard of review,<sup>129</sup> which by its nature is subject to adaptation “to the shifting needs of different cases, different laws, and different times.”<sup>130</sup> We pause only to note that the Federal Circuit’s expertise in patent law weighs heavily on the level of review of factual findings under Rule 52(a). We are certainly not the first to recognize that “[d]ifferent kinds of fact-finding choices give rise to more or less penetrating review according to the relative capacities of district courts and appellate courts in many dimensions.”<sup>131</sup> It is beyond dispute that the judges of the Federal Circuit often can bring to bear special technical expertise that makes their review of factual findings “more” rather than “less penetrating.” Indeed, the notion that Rule 52(a) actually forces appellate courts to defer to the district court’s fact-finding, or that the Seventh Amendment forces appellate courts to defer to jury fact-finding, may be considerably inflated.<sup>132</sup>

Moreover, while we might agree with those who have seen a creeping tendency in Federal Circuit cases to expand the scope of the court’s substantive and procedural jurisdiction,<sup>133</sup> that too is not the sort of activism that fits neatly within the rubric of cases we have discussed here. The precise contours of the substantive and procedural laws to be applied by the court will depend upon the circuit out of which the appeal arises, and the line between issues that “arise under the patent laws” and those that do not

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129. See FED. R. CIV. PROC. 52(a) (“Findings of fact . . . shall not be set aside unless clearly erroneous.”).

130. Cooper, *supra* note 7, at 670.

131. *Id.* at 646.

132. See generally Schnapper, *supra* note 81.

133. The Federal Circuit derives its special jurisdiction from 28 U.S.C. § 1295, which reads, in part, “The United States Court of Appeals for the Federal Circuit shall have exclusive jurisdiction . . . of an appeal from a final decision of a district court . . . if the jurisdiction of the court was based, in whole or in part, on section 1338 of this title.” 28 U.S.C. § 1295 (1994). Section 1338, in turn, gives the district courts original jurisdiction of actions “arising under any Act of Congress relating to patents.” 28 U.S.C. § 1338 (1994). Thus, in deciding the cases before it, the Federal Circuit applies a hybrid of Federal Circuit and regional circuit law. On substantive questions “arising under the patent laws,” the Federal Circuit follows its own law; on procedural matters and substantive questions not central to its own patent jurisprudence, it is supposed to follow the law of the circuit of the district court from which the appeal was taken. See *Panduit Corp. v. All States Plastic Mfg. Co.*, 744 F.2d 1564, 1574 (Fed. Cir. 1984) (ruling as a matter of law that procedural issues not unique to patent claims shall be decided according to law of regional circuit). See, e.g., *Manildra Milling Corp. v. Ogilvie Mills, Inc.* 76 F.3d 1178, 1181 (Fed. Cir. 1996) (Federal Circuit law governs determination of when party is “prevailing” for purposes of cost award, but regional circuit law governs the district court’s exercise of discretion).

can be hard to administer.<sup>134</sup> This urge to expand the scope of subject matter areas to which the court applies its own law, rather than regional law, is not an example of judicial hyperactivity as we perceive it. Formal reallocation of the decision-making authority from the regional circuit courts to the Federal Circuit, although of concern to many, is more akin to traditional judicial activism.

## VI. CONCLUSION

The United States Court of Appeals for the Federal Circuit is an intermediate appellate court, not a trial court or an administrative agency. It has no business conducting patent searches or otherwise examining patent applications. Its judges are not appointed to create new arguments raised by neither of the parties in order to justify reversing a lower court or an administrative agency. It is not the Federal Circuit's job to find facts. To the extent it engages in these activities, the Federal Circuit dramatically reduces certainty and predictability in patent appeals.<sup>135</sup> This in turn will cause the number of appeals to continue to increase as disappointed litigants are encouraged to roll the dice<sup>136</sup> in hope that the Federal Circuit will conduct its own patent search or examine the patent application

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134. See John Donofrio & Edward Donovan, *Christianson v. Colt Industries Operating Corp.: The Application Of Federal Question Precedent To Federal Circuit Jurisdiction Decisions*, 45 AM. U. L. REV. 1835, 1837 (1996) ("It is not always clear whether a district court's jurisdiction is based on an 'Act of Congress relating to patents,' and consequently the issue of whether an action should be appealed to the Federal Circuit or the regional circuit court is often murky."). From time to time, Federal Circuit opinions will announce the addition of new issues to the list of those "arising under" the patent law, as the Federal Circuit sweeps more and more issues within the scope of its own jurisdiction. These can be issues as diverse as antitrust liability for conduct in procuring or enforcing a patent, see *Nobelpharma AB v. Implant Innovations, Inc.*, 141 F.3d 1059 (Fed. Cir. 1998); preemption of state contract law by federal patent law, see *Power Lift, Inc. v. Weatherford Nipple-up Sys., Inc.*, 871 F.2d 1082 (Fed. Cir. 1989); the reviewability on appeal of jury findings in a patent trial, see *Biodex Corp. v. Loredan Biomedical, Inc.*, 946 F.2d 850 (Fed. Cir. 1991); and the burdens and standards of proof on laches and estoppel, see *A.C. Aukerman Co. v. R.L. Chaides Const. Co.*, 960 F.2d 1020 (Fed. Cir. 1992) (en banc).

135. The need for "a tolerable degree of confidence and certainty," particularly in view of the perpetually high cost of patent litigation has long been recognized. See H. & C. HOWSON, *AMERICAN PATENT SYSTEM* 43 (1872). And the cost of patent litigation has skyrocketed recently, with the *median* patent case costing up to \$2.5 million through appeal. See *AMERICAN INTELL. PROP. L. ASS'N, REPORT OF ECONOMIC SURVEY* 72 (1999).

136. In *The Devil's Dictionary*, Ambrose Bierce defines "appeal" as: "In law, to put the dice into the box for another throw." AMBROSE BIERCE, *THE DEVIL'S DICTIONARY* 14 (1911).

afresh, think up some new arguments that had not occurred to counsel, or find facts not found by the lower tribunal.

In connection with its patent jurisprudence, the Federal Circuit is—most deservedly—a highly respected court, performing a difficult task in a very important arena of the law. The unique and specialized jurisdiction and expertise of the Federal Circuit, however, may be one of the factors contributing to the court's hyperactivist tendencies. Other contributing factors may include the public interest in claim construction and the desire for judicial economy. Understandable though the temptation in particular cases may be, fact-finding, creating new records on appeal, and raising new arguments increase unpredictability and uncertainty, erode confidence in the courts, and ultimately encourage more unmeritorious appeals. It is for this reason that the Federal Circuit, like any other appellate court, should strive to confine its decision-making procedures to those traditionally associated with an appellate court, and leave patent searching, innovative advocacy and fact-finding to others.

# EXIT, VOICE, AND VALUES ON THE NET

By Dawn C. Nunziato<sup>†</sup>

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### I. INTRODUCTION

In *Code and Other Laws of Cyberspace*,<sup>1</sup> Professor Lawrence Lessig gives us a masterful analysis of the future of life and law in cyberspace. Lessig predicts that the Internet will be fundamentally transformed from an unregulable place into a place of unprecedented regulability. According to Lessig, the Net of the near future will be regulated primarily by the software or “code” written by commercial entities such as America Online (“AOL”) and IBM. This code will embody certain value choices—choices in favor of censorship or freedom of expression, for example. When the government exercises the power to regulate and embodies values within its laws, this power, of course, is held in check by the Constitution. No similar checks exist, however, on commercial entities’ power to embody (or reject) important values within their code. While the government cannot—consistent with the First Amendment—censor “indecent” speech on the Net, Internet service providers such as AOL can do so insulated from constitutional challenge. As commercial entities increasingly exercise the power to regulate conduct on the Net, does the code that enables such regulation stand in need of a constitution? How will our important values be translated and embodied in cyberspace, if the code writers and, there-

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1. LAWRENCE LESSIG, *CODE AND OTHER LAWS OF CYBERSPACE* (1999).

fore, the lawmakers are insulated from the checks on the power to regulate that are imposed by the Constitution?

One answer, provided by the Net libertarians, is that the power of commercial actors in cyberspace need not be checked by the Constitution because the market will accurately reflect the aggregate of our preferences in response to our individual acts of exit. If AOL does not respect freedom of expression (however that is appropriately defined) and if free expression is important to us, we will “vote” with our mice and choose another Internet service provider. Lessig expresses skepticism about the Net libertarian model, in which cyberspace is constructed on the model of the market, and contends that if we allow cyberspace to be constructed on such a model, important collective values will be sacrificed.

In Part I of this essay, I describe Lessig’s claims about the nature of Net regulation. I then set forth the Net libertarian responses to these claims in Part II, focusing on the issue of whether a cyberspace constructed on the model of the market would incorporate one important collective value—the protection of unpopular speech against majority tyranny. In Part III, I analyze the preference-expressing mechanisms of exit and voice and examine the role of exit in both the libertarian utopian framework articulated by Robert Nozick and in the Net libertarian model. I consider the potential dangers that a model based on exit poses to the First Amendment value of protecting unpopular speech, and observe that the sufficiency of the exit model in protecting this important collective value is a function of the features and characteristics of the particular marketplace for speech under consideration. I conclude that Lessig has not shown that, given the present characteristics of the cybermarket, important collective values are endangered, nor that governmental (or other forms of) intervention to protect such values is warranted. Furthermore, I argue that a model of cyberspace that incorporates the preference-expressing mechanism of *voice*, which Lessig apparently favors, would not necessarily bring about a cyberspace that better reflects our important collective values—unless the meta-value of “deliberation” were somehow built into the expression of voice. I contend, however, that Lessig has not shown that governmental (or other types of) intervention to impose the meta-value of deliberation into the expression of voice is warranted.

In Part IV, I return to the consideration of a cyberspace constructed on the model of the market and examine Lessig’s claim that the government will be powerless to intervene if the characteristics of the cybermarket were no longer conducive to reflecting our important values. I argue that the state action doctrine does not prohibit courts from acting in circumstances where private regulation has threatened important collective values

such as the protection of free expression. On the contrary, in interpreting the state action doctrine in circumstances where private parties have threatened free speech rights, courts have balanced the competing rights and interests at stake, examined the relevant features of the markets involved, and considered whether alternative meaningful avenues of expression remained available.

## II. THE CYBERWORLD ACCORDING TO LESSIG

Lessig's description of the future of regulation on the Net is essentially as follows:

Previously, we thought of the Internet as an unregulated and unregulable place.<sup>2</sup> What we failed to understand was that the Net's unregulability was a product of conscious choice made by the Net's early architects, who designed the architecture of the Net to make it an essentially unregulable place.<sup>3</sup> The architects of the Net rendered the Net essentially unregulable by designing its fundamental protocols to be ignorant about the identity of the authors, senders, and recipients of information made available on the Internet.<sup>4</sup> But, just as the Net could be (and was initially) designed and constructed to be an unregulable place, so too it could be designed and constructed to be a highly regulable place: "whether the Net is unregulable depends, and it depends upon its architecture."<sup>5</sup>

Regulation on the Net is distinct from the types of regulation we have heretofore known because it is effected through the Net's *code* or *architecture*. Of the four modalities of regulating behavior—law, social norms, the market, and code or architecture<sup>6</sup>—the latter is the most foolproof and effective form of regulation. Code is a uniquely effective form of regulation in that its constraints are self-executing and are imposed contemporaneous with the behavior being regulated.<sup>7</sup> Furthermore, regulation via code allows behavior to be regulated by whoever is in charge of writing

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2. See *id.* at 24 ("There's a meme about cyberspace that marks natives from its first generation . . . . [I]f cyberspace exists, so first generation thinking goes, government's power over behavior out there is limited. In its essence, cyberspace is a space of no control.").

3. See *id.* at 33.

4. See *id.* at 32-33. ("The Internet is built on a simple suite of protocols—the basic TCP/IP suite. . . . These protocols . . . reveal nothing about the user of the Internet, and very little about the data being exchanged. . . . This minimalism in design is intentional, [reflecting in part] a political decision about disabling control . . . .").

5. *Id.* at 25.

6. See *id.* at 235.

7. See *id.* at 236-37.

the code. Even though the architects of the Net designed the foundational architecture of the Net to make regulation difficult,<sup>8</sup> layers of code—architectures of identification and credentials for users and architectures that label data—can be added on top of this foundation to enable an unprecedented level and type of regulation.<sup>9</sup> Commerce can implement such regulation by adding layers of software of control in the application space of the Internet on top of the TCP/IP substratum,<sup>10</sup> including architectures that enable control regarding users and architectures that enable control regarding Net content. Moreover, even if it turns out that Commerce cannot bring about the greater regulability of the Net by itself, Commerce can and will do so with the help of Government. In short, Commerce has the incentive to layer code on top of the Net's substratum that will enable identification of individuals and categorization of data, which in turn will transform the Net from an unregulable place to an extremely regulable place: "The 'nature' of the Net might once have been its unregulability; that 'nature' is about to flip."<sup>11</sup>

The code by which the Net increasingly will be regulated—and regulated largely by Commerce—embodies values. The AOLs and IBMs of the world will be increasingly responsible for writing the code of the Net, which means that such commercial entities will be increasingly responsible for regulating the Internet. As such, the values embodied in the code of the Net will increasingly be chosen by Commerce—and driven by Commerce's interests.<sup>12</sup>

Consider some of the values that are embodied in the architecture or code of AOL, the world's largest online service provider. Certain forms and forums of expression are regulated by AOL—not by laws or norms, but by AOL's code itself.<sup>13</sup> First, AOL imposes certain limits on both the substance of its members' expression and the forums its members can use to express themselves.<sup>14</sup> AOL's code, for example, imposes limits on the number of people with whom one can chat. While the president of AOL

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8. *See id.* at 27-29. Given the Internet as it existed, say, in 1995, there was "no simple way either to know who someone is or to classify data [and therefore there was] no simple way to make access to data depend on who the user is and on the data he or she wants to access. In a word, there is no simple way to *zone cyberspace*." *Id.* at 28.

9. *See id.* at 27-29.

10. *See id.* at 32-42.

11. *Id.* at 25.

12. *See id.* at 83.

13. *See id.* at 67.

14. Some of AOL's constraints are imposed via code, while others are imposed by norms. It is likely, however, that all or substantially all of such constraints will be imposed via code in the near future. *See id.* at 71.

can and does write letters to all AOL members, AOL members can never chat with more than twenty-three people.<sup>15</sup> In AOL space, there is no place where everyone can gather at one time, nor is there a place that everyone must, sooner or later, pass through.<sup>16</sup> As a result, AOL's code embodies values that are not readily conducive to the ideal of the public forum, an ideal that undergirds our First Amendment right to free speech.<sup>17</sup> Second, AOL also restricts the content of its members' speech as well as the viewpoints they may express—whether such speech occurs within AOL-space proper or anywhere else on the Net.<sup>18</sup> It prohibits, for example, “crude” sexual references<sup>19</sup> and “crude conversations about sex,”<sup>20</sup> as well as the expression of viewpoints about illegal drug use that imply such use is acceptable.<sup>21</sup> AOL-space in this way embodies certain speech-regarding values that are chosen and implemented by AOL via its code.

The speech-regarding values described above that are embodied in AOL-space are in conflict with the speech-regarding values embodied in the First Amendment. The First Amendment protects the expression of a diversity of viewpoints about drug use as well as the expression of “crude” sexual speech—at least against censorship by the government.<sup>22</sup> The architecture of real space is constructed in conformance with the ideal of public forums.<sup>23</sup> In contrast, “AOL is a different normative world; it can create this different world because it is in control of the architecture of that world.”<sup>24</sup> As a member of AOL, “[y]ou enter AOL and you *find* it to be a certain universe. This space is constituted by its code. . . . You live life in AOL subject to its terms; if you do not like them, you go elsewhere.”<sup>25</sup>

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15. *See id.* at 68.

16. *See id.*

17. Throughout this essay, I confine my discussion to the values “we” share (or don’t share) as United States citizens living in a constitutional democracy. Although one of the most fascinating features of the Net is its accessibility throughout the world—to people from many different cultural and political regimes—for simplicity’s sake, I focus (as Lessig essentially does) on the issues faced by U.S. citizens in translating and transforming our constitutional values in the context of the Internet.

18. LESSIG, *supra* note 1, at 252-53 n.14.

19. *See id.*

20. *Id.*; *see also* James Egelhof, *Guide Policies: Vulgarly Guidelines* (visited April 22, 2000) (<http://www.aolsucks.org/censor/guide/vulgguid.html>) (providing a guide to “vulgar” words prohibited by AOL).

21. *See* LESSIG, *supra* note 1, at 252-53 n.14.

22. *See, e.g.,* ACLU v. Reno, 521 U.S. 844 (1997).

23. *See* LESSIG, *supra* note 1, at 69.

24. *Id.* at 70.

25. *Id.*

Through its code, AOL has the ability to create a vast online normative community in which it has an extraordinary regulatory power—the power to embody and enforce certain fundamental values and to regulate members' behavior in accordance with these values.

If AOL does not like a certain behavior, . . . it can regulate that behavior by changing its architecture. If AOL is trying to control indecent language, it can write routines that monitor [and filter] language usage; . . . if there is stalking or harassing or threatening behavior, AOL can block the connection between any two individuals.<sup>26</sup>

Just as AOL implements certain speech-regarding values in its cyberplace via code, so too will other commercial entities embody (or reject) other important values in their code, such as privacy, access, and equality.<sup>27</sup>

The ultimate question Lessig puts to us is whether the shift in the power to regulate from Government to Commerce should go unchecked: "If we let the invisible hand work unimpeded . . . choices [about values] will be made according to the set of interests that are expressed by commerce on the Net."<sup>28</sup> We must consider whether we can trust this market, and in particular, whether we can trust this market when doing so means entrusting it to embody (or reject) important values, such as free speech, privacy, access, and equality: "Effective regulation then shifts from lawmakers to code writers. The question for us is whether this shift should be unchecked."<sup>29</sup>

### III. THE NET LIBERTARIAN RESPONSE

The overarching question posed by Lessig is whether the shift in the power to regulate from Government to Commerce should go unchecked. In response to this overarching question, the Net libertarian answers that Commerce's power to regulate on the Net is *already* sufficiently held in check—by users' or customers' power of "exit." According to the Net libertarian, the power held by a Net business's customers or a cybercommunity's members to leave one cyberplace and join another imposes a sufficient check upon the power of Commerce.<sup>30</sup> Because Commerce's power

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26. *Id.* at 71.

27. See *id.* at 122-85, for Lessig's discussion of the translation of intellectual property, privacy, and free speech values by private market actors in the cybermarketplace.

28. *Id.* at 83.

29. *Id.* at 207.

30. See, e.g., David Post, *What Larry Doesn't Get: A Libertarian Response to Code and Other Laws of Cyberspace*, 52 STAN. L. REV. (forthcoming 2000).

on the Net is sufficiently held in check, the Net libertarian continues, the Government has no legitimate role to play in further constraining Commerce's power on the Net.<sup>31</sup>

To explore this libertarian response, consider once again the speech-regarding values that AOL embodies in its code. Recall that AOL restricts the forms of expression that individuals can use while on the Net and restricts (among other things) what AOL considers to be inappropriate speech about sex and unsalutary viewpoints about drugs.<sup>32</sup> What, if anything, should be done about the fact that the speech-regarding values AOL embodies in its code are in tension with those embodied in the First Amendment? The libertarian response is that if AOL members find that the speech-regarding values embodied in AOL's code are inconsistent with their own, they can always vote with their mice, leave AOL, and become members of an online community that better suits their preferences.<sup>33</sup> In this way, AOL's power to embody values in its code is already held in check by the power that AOL members have to switch to another Internet service provider ("ISP") and/or by the possibility that a competitor to AOL will respond with an alternative that better suits exiting AOL members' preferences.

On the Net libertarian's reading, institutions on the Net should be conceptualized in what Lessig labels as the "consumer" model:<sup>34</sup>

If we don't like a particular cyber community, we can move—far more easily, in fact, than we can in real space. Because exit is so cheap, we should use exit as our ballot. . . . [On this model,] [t]he world of cyberspace would become a virtual menu, and if you don't like one selection, you simply pick something else.<sup>35</sup>

Lessig, however, finds the Net libertarian model to be unacceptable—at least with respect to certain types of Net communities—because he believes that exit is an *inappropriate* preference-expressing mechanism with respect to such communities. He suggests that while exit may be an appropriate preference-expressing mechanism within the economic realm, it is ill-suited to the task of community-building (and further, democracy-

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31. *See id.*

32. *See supra* text accompanying notes 19-21.

33. As Lessig paraphrases the Net libertarian response, "[AOL's] management can change the code to bring about a particular end [e.g., to filter out inappropriate comments about sex or drugs], but if that end is too far removed from what most members think the space is about, they may simply leave." *See LESSIG, supra* note 1, at 83.

34. *See id.* at 201.

35. *Id.*

building), because it is incapable of eliciting and expressing certain of our important collective values:

There is . . . a more fundamental criticism [of the Net libertarian's consumer model]. Even if we could construct cyberspace on the model of the market—so that we relate to spaces in cyberspace the way we relate to toothpaste in real space—we should not want to do it. An important and long-standing tradition argues that beyond their role as consumers humans need to increase the contexts where they are members. Both as a matter of justice and as a matter of human flourishing, we need these parts of our lives where we have control over the architectures under which we live.

In at least some ways then, we should relate to cyberspace as members rather than as customers.<sup>36</sup>

. . . .

Most of us . . . believe that there are collective values that ought to regulate private action. We are also committed to the idea that collective values should regulate the emerging technical world.<sup>37</sup>

. . . .

. . . [G]overnment is necessary to help establish the conditions necessary for liberty to exist. This is because *there are collective values that, acting as individuals, we will not realize*.<sup>38</sup>

#### IV. EXIT, VOICE, AND COLLECTIVE VALUES IN CYBERSPACE

What might it mean for us to relate to cyberspace as “members rather than as customers”?<sup>39</sup> Is there a meaningful (or further, a necessary) alternative to the Net libertarian/consumer model, a model in which we do not “relate to spaces in cyberspace the way we relate to toothpaste in real space”?<sup>40</sup> Are there collective values that will not be realized in a cybermarket that responds solely to our individual preferences expressed via the mechanism of exit? In this Part, I explore the Net libertarian/consumer model and its underlying preference-expressing mechanism of exit, which Lessig dismisses as incapable of bringing about a cyberspace reflective of

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36. *Id.* at 203.

37. *Id.* at 219.

38. *Id.* at 209 (emphasis added).

39. LESSIG, *supra* note 1, at 203.

40. *Id.*

our important collective values. In particular, I consider how well the Net libertarian/consumer model might reflect one important collective value: the First Amendment protection of unpopular or minority speech against majority tyranny. I focus on this value because it presents a potential difficulty for a model that responds (merely) to the aggregate of our individual preferences. I then consider whether a model premised upon *voice* instead of exit would better serve collective values. I conclude that the Net libertarian's claim that individuals' power of exit will necessarily serve as a sufficient check on the power of the market regardless of the characteristics of the market is unjustified, because the exit model is *potentially* inconsistent with (at least) our First Amendment commitment to protecting minority speech. I conclude further that Lessig's claim that a cyberspace governed by the exit model will fail to embody important collective values and will present circumstances justifying intervention to protect such values also stands in need of further support.

#### A. The Role of Exit in the (Net) Libertarian Model

To better understand the role of exit in the Net libertarian/consumer model, it will be helpful to consider the characteristics of the preference-expressing mechanisms of "exit" and "voice." As outlined by Albert Hirschman in his influential work *Exit, Voice, and Loyalty*,<sup>41</sup> "exit" and "voice" are the two primary mechanisms by which individuals express their dissatisfaction with organizations, whether economic organizations like businesses, or political and communal organizations like school boards and political parties.<sup>42</sup> The exit option, in which an individual simply stops buying a business's products or services or stops participating in an organization with which she is dissatisfied, is characteristic of and most typically employed in the economic realm. Exit is an indirect, impersonal, and non-participatory mechanism for expressing one's dissatisfaction. With exit, improvement of the exited organization comes about, if at all, courtesy of the invisible hand, and any such improvement does not redound to the benefit of the exiting consumer.<sup>43</sup> For example, if a consumer does not like the new and improved Colgate, she can exercise her exit option, switch to Crest, and leave it to Colgate-Palmolive to figure out why she left. In order for the preference-expressing mechanism of exit to be meaningfully exercised, the exiting individual must have an alternative

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41. ALBERT HIRSCHMAN, *EXIT, VOICE, AND LOYALTY: RESPONSES TO DECLINE IN FIRMS, ORGANIZATIONS, AND STATES* (1970).

42. *See id.* at 3-5.

43. *See id.* at 16.

institution to which to transfer her business or membership; exit can only be employed where there are at least two possible competing alternatives.

While the preference-expressing mechanism of exit is characteristic of the economic realm, the mechanism of voice is characteristic of the political and communal realm.<sup>44</sup> With the preference-expressing mechanism of voice, an individual expresses her dissatisfaction from within an organization. As between exit and voice, voice is the more direct, responsive, and participatory method of expressing one's dissatisfaction with an organization, which one expresses while remaining within the organization.<sup>45</sup> Any resulting improvements in the organization benefit the dissatisfied member as well as her fellow members. If I am dissatisfied with the public schools in my area, for example, I can exercise my option of voice and become involved in and lobby the school board to bring about desired changes in the school (instead of exiting and transferring my children to a private school). Voice is most typically employed where exit is difficult or impossible to exercise, where alternative organizations are limited or non-existent, or where an individual has substantial investment in or commitment to a particular organization. Thus, in comparison to exit, voice is the more direct and participatory method of providing feedback, and expressing one's preferences and values, to an organization. Individuals make the decision whether to exercise exit or voice based on a number of factors, including the likelihood that the organization with which one is dissatisfied will respond to one's voice, how much one has invested in or is committed to the organization, and—importantly—whether viable alternative organizations exist.

Consider how exit is employed as a preference-expressing mechanism in the cybermarketplace. The Internet allows for the creation of a wide variety of value-sets or rule-sets, which offer users the option of choosing among such sets according to their preferences. By exercising their option of entering one value-set and exiting another, users thereby express their preferences vis-à-vis such value-sets. As David Post and David Johnson describe the role of exit in the Net libertarian model:

The separation of subsidiary "territories" or spheres of activity within Cyberspace . . . allow[s] for the development of distinct rule sets and for the divergence of those rule sets over time. . . . Content or conduct acceptable in one "area" of the Net may be banned in another. . . .

. . . .

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44. *See id.* at 15-16.

45. *See id.* at 16-20.

... [As compared to real space, in cyberspace] any given user has a more accessible exit option, in terms of moving from one virtual environment's rule set to another's . . . .<sup>46</sup>

For example, if AOL prohibits certain forms of speech, and if an individual is opposed to such prohibitions, she can vote with her mouse, leave AOL, and choose another ISP with a value-set better reflective of her own.

The competition among value-sets or rule-sets in the Net libertarian model is similar to that set forth in the libertarian utopian framework articulated by Robert Nozick in *Anarchy, State, and Utopia*. Within the libertarian utopian framework, individuals have the freedom to join together to form communities of common value-sets and to exit from communities that no longer reflect their value-sets. Nozick articulates two components of the libertarian utopian framework: (1) a "wide and diverse range of communities," with a corresponding wide range of value-sets adopted by such communities;<sup>47</sup> and (2) a great liberty to choose among this wide range of communities<sup>48</sup> (and, what follows, ease of exiting one community and entering (or if necessary creating) another that better accords with an individual's value choices). Within the libertarian utopian framework, government intervention into communities' value-sets is unjustified because individuals can be trusted to act in their best interest in exercising their freedom to choose which communities to join and, accordingly, which values to live by.<sup>49</sup>

Consistent with the libertarian utopian framework articulated by Nozick, the Net libertarian argues that in an unregulated cybermarketplace, different market actors will produce a wide and divergent range of code-sets, embodying different value choices (some consistent with the First Amendment, for example, others not), offering users the freedom to choose which value-set or code-set best accords with their preferences and values. If the speech-regarding values embodied in the First Amendment are truly important to an individual, then, according to the Net libertarian, she will not suffer any curtailment of such values—whether by private or public actors—and will vote with her mouse to express her preferences regarding such values. In short, the Net libertarian claim is that a market on the Internet that aggregates our individual preferences in response to individual acts of exit will be sufficient to reflect our important values.

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46. David R. Johnson & David G. Post, *Law And Borders—The Rise of Law in Cyberspace*, 48 STAN. L. REV. 1367, 1396-99 (1996) (emphasis added).

47. ROBERT NOZICK, *ANARCHY, STATE, AND UTOPIA* 307 (1974).

48. See *id.* (stating that within the libertarian utopian framework, "alternative visions of the good can be individually or jointly pursued").

49. See generally *id.* at 297-334.

Although not always explicitly articulated, the premises of the Net libertarian claim are essentially those that undergird the libertarian utopian framework: (1) a wide and divergent range of value-sets will flourish on the Internet; and (2) exit from one value-set to another will be sufficiently easy to exercise.

### B. Exit, Individual Preferences, and Collective Values

If we accept that the Net libertarian premises obtain on the Internet—which Lessig apparently does not<sup>50</sup>—we may go on to consider whether there are certain collective values that will not be embodied in a cybermarket that merely reflects the aggregate of our individual preferences. For example, consider how well a market premised upon the mechanism of exit will respect the commitment embodied in the First Amendment to protect unpopular or minority speech from majority tyranny.<sup>51</sup> Suppose that only a small portion, say five percent, of the relevant population favors the protection of a certain form of speech (be it “crude” sexual expression, speech advocating illegal drug use, graphic depictions of abortion procedures, etc.). Suppose further that the First Amendment embodies the collective value of protecting the expression of such minority speech, even against the majority’s unwillingness to protect such speech. What can be said about how well a cybermarket that (merely) aggregates our

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50. Lessig apparently contends that neither of these premises obtain on the Net. He disagrees with the premise that a wide and diverse range of code-sets or value-sets will be available on the Net, and this disagreement undergirds in substantial part his distrust of the mechanism of exit as a check on commercial entities’ power to regulate. Rather, he asserts—unconvincingly, to my mind—that “[w]hat we will see . . . is the emergence of a fairly unified regulation through code. . . . [T]here will be a push toward convergence on a uniform set of rules. . . . [For example,] not a diverse set of policies governing privacy, but a single set of rules . . .” LESSIG, *supra* note 1, at 206. Furthermore, Lessig claims that, for an important set of cyberspace institutions, exit is more difficult to exercise than in real space. He considers the case of MUDs (Multi-User Dungeons or Multi-User Domains), virtual online text-based worlds where individuals spend months building their characters within a community and develop and invest social capital in that community. He claims that when you leave one virtual community and go to another, “no assets are transferable [and] . . . you must start over again. . . . Paradoxically, then, we might say that it is harder to change communities in cyberspace than it is in real space. . . . Communities in cyberspace, then, may in the short run have more power over their citizens than real-space communities do.” *Id.* at 202. And, he contends that because it is more difficult for individuals on the Net to exercise their power of exit than for individuals in real space to do so, the Net libertarian’s promise that exit will serve as a sufficient check on Commerce’s power rings hollow. *Id.*

51. I focus on the collective value of protecting minority speech because this value is among the most likely to be endangered by the Net libertarian/consumer model.

individual preferences—in response to our individual acts of exit—would protect such countermajoritarian speech-regarding values?

Cass Sunstein, among others, has examined this issue in a related context, and contends that free speech values may be endangered by an unregulated market, a system of “laissez faire and the ‘invisible hand’ for free speech . . . .”<sup>52</sup> He argues that a well-functioning system of free expression “is not intended to aggregate existing [individual] private preferences,” but rather must incorporate certain collective values, such as exposure to diverse views and deep attention to public issues, that will not necessarily be realized in an unregulated market.<sup>53</sup> Sunstein observes that,

In principle, it does seem clear that [a free market in communications] could generate a range of serious problems. . . . [If] the allocation of speech rights was decided through an ordinary pricing system, like the allocation of soap, or cars, or candy, . . . [s]uch a system would [fail to incorporate certain speech-regarding values, and for example, would] ensure that dissident speech . . . would be foreclosed.<sup>54</sup>

Sunstein suggests that such problems with an unregulated market in speech are problems “in principle” or *potential* problems, not problems that will *inevitably* flow from an unregulated speech market. Rather, Sunstein’s analysis counsels in favor of a careful consideration of the actual features and characteristics of each particular marketplace for speech in evaluating whether potential problems are likely to materialize in any given unregulated speech market. Although it is possible that an unregulated speech market might be underprotective of minority speech, it is also possible that the characteristics of such a market would obviate such dangers. Careful attention to the features and characteristics of the marketplace for speech under consideration is therefore warranted.

In considering whether an unregulated cybermarketplace for speech is likely to suffer from the problems described above, it is important to consider whether a wide and divergent range of value-sets will actually be available for individuals to choose among. It is also helpful to compare the market for speech on the Net with other markets for speech, such as the broadcast television market or the metropolitan newspaper market. In the broadcast television market, before the creation of the Corporation for Public Broadcasting and the advent of cable television, the three major

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52. CASS R. SUNSTEIN, *DEMOCRACY AND THE PROBLEM OF FREE SPEECH* at xviii (2d. ed. 1995).

53. *Id.* at 18-19.

54. *Id.* at 57-58.

networks essentially controlled speech on the airwaves. If the networks declined access to the airwaves for a certain class of speech, it could plausibly be argued that this marketplace for speech was not well-functioning.<sup>55</sup> Similarly, if a metropolitan area supported only one or two major newspapers, and those newspapers refused to allow for the expression of diverse viewpoints on issues of public import, it could plausibly be argued that such a marketplace for speech was not well-functioning.<sup>56</sup> The marketplace for speech on the Net, however, has a very different set of salient features and characteristics than these other speech markets. On the Internet, the number of market players, the diversity of market offerings, and the ease of exiting one "organization" and entering another make exit a far more meaningful and trustworthy mechanism for expressing preferences and values in cyberspace. While the limited number of market players and the limited range of value-sets in the broadcast television and metropolitan newspaper markets support the argument that exit alone cannot be trusted to bring about a speech market that reflects our important collective values—and that government intervention into such markets to protect important collective values is warranted—this argument does not carry over well to the cyber-market, given the different features and characteristics of this market.

To see this, consider, for example, the likelihood that unpopular or minority speech will find an avenue of expression in the cybermarket for speech as compared to the broadcast television market. Suppose an individual wishes to advocate the use of illegal drugs or criticize a particular abortion procedure using graphic terms or images, or to otherwise engage in unpopular/minority expression. While it is likely that such minority speech will not find an avenue for expression in an unregulated broadcast television market, can the same be said of an unregulated cybermarketplace for speech? This depends, in part, upon how many vehicles for expression can be supported in the cybermarketplace and whether the value-sets adopted by such market actors will converge on a set of majoritarian values—i.e., on whether the libertarian premises in fact obtain on the Net.<sup>57</sup> If the cybermarket were to only support five commercial ISPs with

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55. See, e.g., SUNSTEIN, *supra* note 52, at 53-92.

56. See, e.g., Jerome Barron, *Access to the Press—A New First Amendment Right*, 80 HARV. L. REV. 1641 (1967).

57. For a discussion of the (Net) libertarian premises, see *supra* text accompanying notes 46-49; for Lessig's take on whether the premises will obtain as a general matter, see *supra* note 50.

roughly equal shares of the market,<sup>58</sup> and if protection of the minority speech under consideration were supported by only five percent of the relevant market, it is likely that none of the ISPs would choose to protect such minority speech and that such a marketplace would not appropriately reflect the collective value of protecting minority speech. Of further concern is the possibility that an ISP would not only prohibit such speech within its own cyberplaces (e.g., AOL-sponsored chat rooms), but would also prohibit its members from using or accessing such speech in other cyberplaces.<sup>59</sup> If each of the commercial actors in the cybermarketplace were to embody such speech-regarding values in its code, the collective value of protecting minority speech would be endangered and some form of intervention would be warranted. But Lessig has not convincingly demonstrated that the features and characteristics of the cybermarket are or soon will be such that this important collective value, or other important collective values, will be endangered by a cybermarket that merely aggregates individual preferences. Rather, given the wide and divergent range of value-sets available in the cybermarketplace for speech, it appears that exit will remain a meaningful and viable option for individuals to exercise, that adequate avenues for minority speech will remain available, and that the collective value of protecting minority speech will not be endangered by an unregulated cybermarketplace.

### C. Voice and the Expression of Collective Values on the Net

I have argued above that a cybermarket premised upon exit as a preference-expressing mechanism is *potentially* inconsistent with the protection of important collective values, but that Lessig has not shown that such problems are likely to materialize given the features and characteristics of the cybermarketplace. In this section, I consider whether a model of cyberspace premised upon voice as a preference-expressing mechanism—a model in which “humans . . . increase the contexts where they are members”<sup>60</sup> and “relate to cyberspace as members rather than as customers”<sup>61</sup>—would be better suited to bringing about a cyberspace more reflective of our important collective values. As discussed above, using the mechanism of voice, individuals are able to contribute to the value-sets of the organizations of which they are members. Rather than simply exiting

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58. Of course, other vehicles for expression are available on the Net, but I focus my attention on commercial vehicles, since Lessig’s analysis centers on power of commercial entities to regulate via code.

59. See *supra* text accompanying note 18.

60. LESSIG, *supra* note 1, at 203.

61. *Id.*

when they disagree with an organization's values, individuals employing the option of voice work from within to attempt to reshape those values. Consider, then, whether a model of cyberspace in which individuals exercised the preference-expressing mechanism of voice—and in which institutions responded to their members' exercise of voice—would incorporate important collective values better than a model premised solely upon exit.

Let us return to the example described above in which five ISPs enjoy roughly equal shares of the market, a five percent minority is in favor of a particular type of speech, but now users express their preferences through the mechanism of voice rather than exit. Depending upon the configuration of voting blocs, a market based on the preference-expressing mechanism of voice (in the form of a majority voting rule) would also likely result in each of the five ISPs adopting value-sets that are hostile to minority speech. That is, a model in which users "increase the contexts where they are members"<sup>62</sup> and enjoy the ability to vote for and exercise some control over the values embodied by commercial actors within their code would fare no better than the exit model on this score, in that both would merely reflect the aggregate of individual preferences. A model premised upon members' exercise of their "ordinary" voice (as we might, paraphrasing Lessig,<sup>63</sup> call such an exercise of voice) would not move us any further toward the goal of building a cyberspace that embodies our important collective values. While Lessig favors a model of cyberspace in which individuals are conceptualized as "members rather than as customers,"<sup>64</sup> he at the same time expresses skepticism about the desirability of a cyberspace reflective of our "ordinary" expressions of individual preferences. On this point, Lessig claims that "[i]t has never been our ideal . . . that democracy be a perfect reflection of the present temperature of the people . . . Democracy was [intended] to be more than a string of excited utterances of the people."<sup>65</sup> And Lessig argues that, to make matters worse, technology tends to produce expressions of voice—the "flash pulse of the people"<sup>66</sup> or "a string of excited utterances of the people"<sup>67</sup>—that are particularly ill-suited to eliciting important collective values, because such technology-

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62. *Id.*

63. *See id.* at 5 (arguing that we must strive to bring about a cyberspace that protects "principles and ideals that reach beyond the compromises of ordinary politics." (emphasis in original)).

64. *Id.* at 203.

65. *Id.* at 227.

66. *Id.*

67. *Id.*

facilitated expressions of voice are likely to be hastily made and ill-informed:

As the cost of monitoring the current view of the population drops, . . . we are producing a perpetual stream of data about what “the people” think about every issue. . . . We rarely ask, however, whether perfect monitoring is a good.

*There is an important reason to be skeptical of the flash pulse of the people.* The flash pulse is questionable not because the people are uneducated or incapable of good judgment, . . . but because it is often the product of ignorance. People often have ill-informed or partially informed views that they simply repeat as judgments . . . . Technology encourages this sort of judgment.<sup>68</sup>

According to Lessig, then, a cyberspace in which organizations respond to and reflect individuals’ “ordinary” voice on the Net would be particularly unsupportive of our important collective values. Lessig contends, following Sunstein,<sup>69</sup> that we need somehow to move beyond this ordinary expression of voice, the flash pulse of the people, to a model that incorporates a more thoughtful, reflective, balanced, and deliberative voice of the people. In Sunstein’s words, the creation of a

[well-functioning system of free expression] is closely connected to the central constitutional goal of creating a *deliberative democracy*, . . . . [which] is not intended to aggregate existing private preferences. . . . Instead it is designed to have an important deliberative feature. . . . Through exposure to such information and perspectives, both collective and individual decisions can be shaped and improved.<sup>70</sup>

Similarly, Lessig proffers a model for embodying values on the Net in which individuals exercise their power of voice, but a voice formulated and expressed in a deliberative key. Lessig contends that, in expressing our voice on the Net, we need to move beyond the techniques of the “flash pulse of the people”<sup>71</sup> toward a method of eliciting important, collective, deliberative values:

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68. *Id.* at 227-28 (emphasis added).

69. See SUNSTEIN, *supra* note 52, at xi-xx.

70. *Id.* at 18-19 (emphasis added).

71. LESSIG, *supra* note 1, at 227.

There are techniques for polling that compensate for the errors of the flash poll and produce judgments that are both more considered and more stable.

An example is the “deliberative” poll devised by Professor James Fishkin. Rather than a pulse, Fishkin’s polls seek an equilibrium. [The deliberative poll] bring[s] a cross-section of people . . . [and gives them] information before the poll that helps ensure that they know something about the subject matter. . . . [Those being polled] argue about the topic at issue and exchange views about how best to resolve it. At the end, they are asked about their views, and their responses at this point form the “results” of the poll.

*The great advantage of this system is not only that information is provided but that the process is deliberative.* The results emerge out of the reasoning of citizens debating with other citizens. People are not encouraged to just cast a ballot. They give reasons for their ballot, and those reasons will or will not persuade.

. . . .

Cyberspace might make this process where reasons count more possible . . . It is possible to imagine using the architecture of the space to design deliberative forums . . . .

. . . .

We could build some of this [deliberation] back into our democracy. The more we do, the less significant the flash pulses would be. And the less significant these flash pulses are, the more we might have faith again in that part of our tradition that made us revolutionaries in 1791—the commitment to a form of government that respects deliberation, and the people . . . .<sup>72</sup>

Lessig appears to contend that voice is preferable to exit as a preference-expressing mechanism, but only if and to the extent that voice can be rendered more thoughtful, deliberative, balanced, and therefore better able to elicit important collective values. According to Lessig, even though we cannot trust a market based on exit, nor on *ordinary* voice, to reflect our important collective values, if the meta-value of deliberation were somehow built into voice, we would be more justified in trusting such a market. Because building the meta-value of deliberation into our articulation and expression of voice would be in society’s long-term best interests, the government (or some other vehicle for collective action) would be justi-

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72. *Id.* at 228-30 (emphasis added).

fied, according to Lessig, in intervening in the market to impose the conditions for deliberation in cyberspace.

In sum, Lessig argues that exit is an inappropriate method for individuals to express their preferences on the Net. But he also suggests that voice, if exercised in an ordinary and non-deliberative manner on the Net, is also insufficient to bring about the embodiment of our important collective values. He appears to contend that the only way for individuals to express preferences in a manner supportive of our important collective values is by building the meta-value of deliberation into our exercise of voice on the Net. Doing so, however, would require intervention in the market by the government or some other vehicle for collective action, which would be necessary to bring about the conditions under which true freedom will flourish. I have contended, however, that Lessig too hastily concludes that exit is an inappropriate mechanism for expressing preferences and reflecting our important values on the Net. Exit should not be dismissed out of hand as being insufficiently supportive of important collective values; rather, we must consider the features and characteristics of the particular market in which exit serves as a preference-expressing mechanism and the particular collective values to be served in order to determine whether such values are actually likely to be embodied in an unregulated market. Lessig has not convincingly demonstrated that the features and characteristics of the cybermarket are (or soon will be) such that our important collective values will be endangered by a cybermarket that merely aggregates individual preferences. Nor has he shown that governmental (or other types of) intervention in the cybermarket is warranted for the purpose of securing collective values. While government intervention might eventually be necessary if the potential of the market model to disregard certain collective values were to materialize, we are not there yet.

## V. GOVERNMENT REGULATION OF THE PRIVATE REGULATORS ON THE NET

I have argued that, given the characteristics of the cybermarketplace—including the number of market players, the diversity of market offerings, and the ease of exit—intervention to enforce the recognition of certain collective values within commercial actors' code or to instill deliberation into individuals' formation and expression of preferences is unwarranted. Yet I have also argued that an unregulated marketplace could *potentially* lead to a state of affairs in which certain important collective values—such as the protection of minority speech from majority tyranny—are not respected. When and if such a state of affairs were to obtain—as it arguably did in

the broadcast television market—would the government be able to intervene to remedy such problems? Lessig's answer is no—primarily because he believes that the state action doctrine as presently interpreted will prohibit courts from holding private actors in check by constitutional values (and because we do not trust the legislature to act on our behalf in this regard).<sup>73</sup> Lessig is ultimately quite pessimistic (if not despondent) about both the likelihood that a cyberspace premised upon the model of the market will embody our important collective values and the willingness of government to intervene to remedy such defects in the market if and when they arise. I have argued in Part III that Lessig has not made out the case that a cyberspace premised upon the model of the market will fail to embody our important collective values. In this Part, I argue that neither has he made the case that courts will refuse to intervene to check the power of private actors when and if necessary to protect our important collective values. On the contrary, doctrinal support exists for courts to impose checks on the power of private regulators where such regulation threatens important collective values.

The history of government regulation of private actors in emerging media and within new forums suggests that when there is justifiable reason for the government to distrust and insert itself into the market, action by various branches of the government will be forthcoming. Consider, for example, the government's involvement in regulating private actors' ownership and control of broadcast media. Throughout the past century, the government struggled to determine how best to structure ownership of the airwaves and how much autonomy to grant to private broadcasters in order to protect free expression in and access to this medium. In *CBS, Inc. v. Democratic National Committee*,<sup>74</sup> for example, the Supreme Court considered a challenge brought by the Democratic National Committee and an anti-war group to private broadcasters' denial of their request to purchase air time to express their anti-war views. The Court's determination of the contours of the public/private dichotomy and application of the state action doctrine in this context involved an inquiry into the characteristics of the market for speech under consideration, as well as an intricate and complex balancing of the competing First Amendment interests of private broadcasters and members of the public seeking access to the airwaves.<sup>75</sup> Instead of simply abdicating its responsibility to protect individuals' free

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73. *Id.* at 213-18.

74. 412 U.S. 94 (1973).

75. In construing the state action doctrine, the Court balanced the broadcasters' right to control the content of their programs against the public's right of access to the airwaves, and found in favor of the former. *See id.*

speech rights against regulation by private entities—as Lessig predicts of the cyberspace context<sup>76</sup>—the Court in *CBS v. Democratic National Committee* carefully considered arguments in favor of and against allowing individuals to assert a First Amendment right of access and free speech against private regulators. (Furthermore, when other branches of the government found the Court’s evaluation of these competing interests in *CBS v. Democratic National Committee* wanting, the legislature acted to secure important free speech rights against private regulators through the passage of the Federal Election Campaign Act of 1971.<sup>77</sup>)

Consider also the Court’s interpretation of the state action doctrine in the context of the denial by private “company towns”<sup>78</sup> and shopping malls<sup>79</sup> of access for purposes of expressive activities. There again, the Court balanced the free speech rights of members of the public against the property and free speech rights of private regulators. In both the company town and private shopping mall cases, the Court’s decisions were premised in part on the consideration of whether those wishing to engage in expressive activity on private property had alternative avenues of communication open to them.<sup>80</sup> Although the Court (for the time being) has determined that the property rights of private shopping mall owners outweigh members of the public’s interest in exercising their right to free expression within those malls, the balancing of interests undertaken by the Court and the importance the Court places on alternative avenues of communication suggest that courts will be sensitive to similar constitutional

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76. See LESSIG, *supra* note 1, at 218.

77. Federal Election Campaign Act of 1971, Pub. L. No. 92-225, § 101, 86 Stat. 3 (1972) (amended 1980). Several years after the decision in *CBS v. Democratic National Committee*, the Court held that the Federal Election Campaign Act of 1971 created a right of reasonable access to the airwaves for political candidates. See *CBS v. FCC*, 453 U.S. 367 (1981) (affirming the FCC’s determination that the networks had failed to provide reasonable access to political candidates under the Federal Election Campaign Act of 1971).

78. *Marsh v. Alabama*, 326 U.S. 501 (1946).

79. See *Amalgamated Food Employees v. Logan Valley Plaza*, 391 U.S. 308 (1968) (holding that state trespass law could not be applied to enjoin union picketing of supermarket in privately owned shopping center); *Lloyd Corp. v. Tanner*, 407 U.S. 551 (1972) (holding that private shopping center’s ban on handbill distribution applied to anti-war leafletters was not unconstitutional, where alternative means of communication were available); *Hudgens v. NLRB*, 424 U.S. 507 (1976) (holding that actions of picketers in front of store in private shopping center were not protected by First Amendment).

80. See, e.g., *Lloyd Corp.*, 407 U.S. at 566 (distinguishing *Logan Valley* on grounds that, in that case, denial of picketer’s rights of access to the shopping center would deprive them of all reasonable opportunity to convey their message to the shopping center patrons).

claims against private regulators in cyberspace. This is especially true if private regulators in cyberspace settle upon a uniform set<sup>81</sup> of restrictive values in their code that leave no alternative avenues of communication open for certain types of expression.

In addition to the state action doctrine as a vehicle for balancing the First Amendment rights of market actors against the First Amendment rights of the public, the government has used other mechanisms to remedy defects in markets for speech. For example, in attempting to remedy the problems arising from a market in speech driven solely by the profit motive, the government used its allocative power in the 1960s to establish the Corporation for Public Broadcasting.<sup>82</sup> In so doing, Congress attempted to introduce a voice into the broadcast market that would be more supportive of and more conducive to meaningful, deliberative, and collective self-governance.<sup>83</sup> It is quite plausible that, when and if necessary to secure adequate avenues of communication for unpopular speech on the Net, or to secure other collective values, the government would act to establish a public ISP or other public channels for expression.

In short, the government has various means available to it to ensure that the market for speech on the Net will operate in a manner that is "uninhibited, robust, and wide-open."<sup>84</sup> In applying the state action doctrine to private regulation in various mediums and forums, the Court has essentially balanced the rights of private regulators against the competing rights of individuals subject to such regulation. In undertaking this analysis, the Court has also considered whether the private regulation at issue leaves open alternative avenues of communication. The inquiry into whether alternative avenues of communication are available is substantially the same inquiry required of us in evaluating whether the exit model will suffice to reflect the important collective value of protecting minority speech on the Net.

## VI. CONCLUSION

Lessig's overarching concern is that behavior in cyberspace will be regulated by Commerce and that such regulation will be driven by Commerce's interests, not ours. He is deeply skeptical about a cyberspace constructed on the model of the market and about the market's underlying

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81. *See supra* note 50.

82. *See* Public Broadcasting Act of 1967, Pub. L. No. 90-129, 81 Stat. 365 (codified as amended at 47 U.S.C. § 396).

83. *See generally* OWEN FISS, *THE IRONY OF FREE SPEECH* 56 (1996).

84. *New York Times v. Sullivan*, 376 U.S. 254, 270 (1964).

preference-expressing mechanism of exit, because he believes that a cyberspace governed by exit will reflect, at best, the aggregate of our individual values and not our important collective values. I have argued that Lessig has not made the case that a cyberspace governed by the market mechanism of exit will fail to incorporate important collective values. The possibility certainly exists that markets governed by exit alone will fail to incorporate important collective values, such as the First Amendment value of protecting unpopular speech against majority tyranny. But whether such a possibility will materialize is a function of the features and characteristics of the particular market under consideration as well as the nature of the collective value at risk. Lessig has not shown that such a possibility is likely to materialize in the cyberspace of the near future. Lessig also claims that the government will fail to take any measures to remedy the cybermarket's (potential) failure to embody our important collective values and that the state action doctrine will render courts powerless to remedy such problems. I have argued that doctrinal support exists for courts to hold in check the power of private regulators where such regulation threatens the important collective value of protecting unpopular speech. In short, Lessig has not shown that a cyberspace governed by the market mechanism of exit will fail to incorporate important collective values, nor has he shown that if and when cyberspace does fail to incorporate such values, courts will be powerless to act to protect such values.



COMMENT

**PIRATES OF THE INFORMATION INFRASTRUCTURE:  
BLACKSTONIAN COPYRIGHT AND THE FIRST  
AMENDMENT**

*By Hannibal Travis*<sup>†</sup>

**ABSTRACT**

The author analyzes the ongoing expansion of American copyright law from the standpoint of the comparative history and philosophy of exclusive rights in lands on the one hand, and in creative expression on the other. He documents the persistence of a particularly influential mode of discourse about property rights from the English Enclosure Movement of the seventeenth and eighteenth centuries down to the Internet copyright debates of the present day. During this time, the duration and breadth of copyright have been extended to economically dubious and arguably unconstitutional lengths. At each new incursion into the intellectual commons, substantially the same dual-pronged justification has been brought to bear, combining a one-sided emphasis on certain “natural” rights with a rudimentary and poorly documented account of the “tragedy of the commons.” This unmooring of copyright from the historical limits on its scope and duration threatens to chill the flow of public domain material and transformative works onto the World Wide Web. The author argues that a searching First Amendment inquiry into the dubious origins of Blackstonian copyright, along with a more critical appraisal of its philosophical provenance, should precede implementation of “notice-and-take-down” schemes and other statutory, technological, and contractual restrictions on imitation and quotation in cyberspace and elsewhere. Absent such an inquiry, the redefinition of “piracy” to include evaluation, critique, parody, and even reproduction of public domain works will undo the advances in the accessibility and heterogeneity of information

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† J.D., 1999, Harvard Law School; B.A., 1992, Washington University. Mr. Travis will be clerking during the 2000-2001 term for the Hon. William Matthew Byrne, Jr., former Chief Judge of the U.S. District Court for the Central District of California. He would like to thank Professors Lawrence Lessig, Pamela Samuelson, and Mark Lemley for their inspiration and encouragement as earlier drafts of this comment were being written, and the editors of BTLJ for their extensive contributions and hard work during its revision. This Comment represents the views of the author only, and is not to be attributed to any client or employer of the author.

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that the advent of cyberspace communication has wrought, and that the First Amendment was explicitly intended to achieve.

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It might be said that gradually in the eighteenth century a crisis of popular illegality had occurred. . . . The transition to an intensive agriculture exercised, over the rights to use common lands, over various tolerated practices, over small accepted illegalities, a more and more restrictive pressure. Furthermore, as it was acquired in part by the bourgeoisie, now free of the feudal burdens that once weighed upon it, landed property became absolute property: all the tolerated "rights" that the peasantry had acquired or preserved (the abandonment of old obligations or the consolidation of irregular practices: the right of free pasture, wood-collecting, etc.) were now rejected by the new owners who regarded them quite simply as theft. . . .<sup>1</sup>

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1. MICHEL FOUCAULT, *DISCIPLINE AND PUNISH* 84-85 (Alan Sheridan trans., Vintage Books 1979) (1977).

God gave the [Word] to Men in Common; but since he gave it them for their benefit, and the greatest Conveniencies of Life they were capable to draw from it, it cannot be supposed he meant it should always remain common and uncultivated. He gave it to the use of the Industrious and Rational, (and *Labour* was to be *his Title* to it;) not to the Fancy or Covetousness of the Quarrelsome and Contentious.<sup>2</sup>

## I. INTRODUCTION

The legal structure is in place for wholesale censorship of Internet speech by means of overbroad copyright laws. The last few years, a number of writers and scholars have argued, have been a period of accelerating “prophetization” of cyberspace.<sup>3</sup> This trend has followed, perhaps inevitably, the oft-noted tendency towards an ever longer and more expansive copyright monopoly.<sup>4</sup> As of this writing, federal law provides severe civil and criminal penalties<sup>5</sup> for those sampling as little as a note or two of music without permission,<sup>6</sup> using a few too many of a President’s own words

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2. JOHN LOCKE, TWO TREATISES OF GOVERNMENT 309 (Peter Laslett ed., Cambridge Univ. Press 1960) (1690).

3. See, e.g., Heidi Kriz, *Open Source in Open Court*, WIRED NEWS, Apr. 26, 1999 (<<http://www.wired.com/news/news/politics/story/19253.html>) (quoting Lawrence Lessig).

4. See, e.g., Mark Lemley, *Romantic Authorship and the Rhetoric of Property*, 75 TEXAS L. REV. 873, 894 (1997).

5. Under the No Electronic Theft Act, it is a felony to “willfully” copy or distribute infringing portions of works which have an aggregate value of more than \$1,000. See 17 U.S.C. § 506(a) (Supp. IV 1998). The stiff fines and jail sentences envisioned by this act were explicitly intended to apply to those posting copyrighted materials on the Internet; it was enacted in part as a response to the holding of *United States v. LaMacchia*, 871 F. Supp. 535, 545 (D. Mass. 1994), that infringement absent intent to derive financial gain could not be criminally prosecuted. See 143 CONG. REC. H9883, H9885 (daily ed. Nov. 4, 1997) (statement of Rep. Goodlatte, author of the Act).

6. The Supreme Court held in *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994), that a song that copied a single bass riff and one line could be infringing if its authors could not prove that their version did not work “substantial harm” on the original’s “derivative market for rap music.” *Id.* at 592-93. See also *Tin Pan Apple Inc. v. Miller Brewing Co.*, 30 U.S.P.Q.2d (BNA) 1791 (S.D.N.Y. 1994) (holding that a jury could find the sounds “Hugga-Hugga” and “Brrr” in plaintiff’s song sufficiently original to warrant copyright protection, and support an infringement action against defendant who used the same sounds in his song); *Grand Upright Music, Ltd. v. Warner Bros. Records, Inc.*, 780 F. Supp. 182, 185 (S.D.N.Y. 1991) (holding that defendant’s use of three words and a sample of music from plaintiff’s song to be an infringement of plaintiff’s copyright, and referring the matter for consideration of criminal prosecution).

to publicize or criticize his or her policies,<sup>7</sup> or posting online the works of James Joyce or other authors who died as long as 70 years ago.<sup>8</sup>

Perhaps it is unsurprising that, at the dawn of an information economy and networked world, we should be facing a massive reconfiguration of public and private rights to the public domain and to fair uses.<sup>9</sup> Some intellectual property scholars characterize the current period as one in which information industry players are seeking to set the ground rules of the knowledge economy in their favor. This process has been christened a "copyright grab" by Pamela Samuelson,<sup>10</sup> and described more broadly as "an intellectual land-grab" by James Boyle<sup>11</sup> and a "creeping enclosure of the informational commons" by Peter Jaszi and Martha Woodmansee.<sup>12</sup> Is such language loose talk, or is there a genuine conceptual or tactical similarity between land grabs proper and mere recalibrations of the copyright balance?

This essay will argue that the ongoing proprietization of the copyright monopoly shares a profound resemblance to the English enclosures of common lands. As a prelude to capitalist agriculture and industry, the peoples of Europe found many of their "ancient and venerable" property rights liquidated by a rising class of merchant farmers. This process was perhaps most dramatic in England. The entitlements so appropriated by often illegal or abusive enclosures, once secured, were asserted against their prior holders and the general public as rights of perpetual duration and near-absolute scope.

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7. See *Harper & Row Publishers v. Nation Enter.*, 471 U.S. 539, 558 (1985).

8. See Plaintiff's First Amended Complaint, *Eldred v. Reno*, 74 F. Supp. 2d 1 (D.D.C. 1999) (No. 99-CV00065), available at [http://cyber.law.harvard.edu/eldredvreno/complaint\\_amd1.html](http://cyber.law.harvard.edu/eldredvreno/complaint_amd1.html). See generally Sonny Bono Copyright Term Extension Act, Pub. L. No. 105-298, 112 Stat. 2827 (1998) (codified in scattered sections of 17 U.S.C.).

9. See Peter Lyman, *The Article 2B Debate and the Sociology of the Information Age*, 13 BERKELEY TECH. L.J. 1063, 1075-1080 (1998) (describing "the flow of information" as "the central analytic concept of the network enterprise" and the threat posed by the "new economic space" of the Internet to the balance of market power between producers and consumers).

10. Pamela Samuelson, *The Copyright Grab*, WIRED, Jan. 1996, at 134.

11. James Boyle, *A Politics of Intellectual Property: Environmentalism for the Net?*, 47 DUKE L.J. 87, 94 (1997).

12. PETER JASZI & MARTHA WOODMANSEE, *THE CONSTRUCTION OF AUTHORSHIP* 11 (1994). Most recently, Yochai Benkler has written that "[w]e are in the midst of an enclosure movement in our information environment." Yochai Benkler, *Free as the Air to Common Use: First Amendment Constraints on Enclosure of the Public Domain*, 74 N.Y.U. L. REV. 354, 354 (1999).

Roughly concurrent with the English enclosures, a new community of discourse arose with regard to private and common property, or what one commentator calls "the right to exclude and the right to be included."<sup>13</sup> This discourse, which could be called the "propertarian ideology," has dominated many legislative and judicial discussions of rights in commons, and to public uses, and continues to do so. It is defined by three closely related claims: (1) that rights in the commons are not really rights, such that expropriation of common land is not really theft; (2) that use of a commons is inherently wasteful and fractious, such that monopolization becomes a moral imperative; and (3) that rights of exclusion convey only benefits, both utilitarian and economic, such that all of the costs remain on the side of inadequate rather than overgenerous property rights. According to this discourse, both the sacred rights of property and the national wealth come to weigh entirely against the continued exercise by the public of its rights in the commons.

These tenets constitute a form of "ideology" as Althusser defined the term, or a representation of "the imaginary relationship of individuals to their real conditions of existence."<sup>14</sup> It is a discourse that frequently imagines rights in and uses of commons not so much as they actually were and are, but rather in relation to the maintenance and reproduction of social power.<sup>15</sup> It is a *propertarian* ideology precisely because it does violence to the rich tradition of the commons on every point that renders total enclosure more attractive. And it reigns well nigh unchallenged over contemporary legislative and judicial analyses of the public domain, in a form substantially identical to its articulation in the classical liberal political, legal, and economic theories of John Locke, William Blackstone, and Adam Smith.

This essay is not the place to resolve the long-standing debate between enclosure "optimists" and "pessimists" as to whether the remarkable advances in the British standard of living since the seventeenth century could have been achieved without the massive social misery wrought by forcible enclosures and sweepings.<sup>16</sup> Rather, the point is that a form of thinking

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13. THOMAS A. HORNE, *PROPERTY RIGHTS AND POVERTY: POLITICAL ARGUMENT IN BRITAIN, 1605-1834*, at 7 (1990).

14. Louis Althusser, *Ideology and Ideological State Apparatuses*, in *CRITICAL THEORY SINCE 1965*, at 241 (Hazard Adams ed., 1986).

15. TERRY EAGLETON, *LITERARY THEORY: AN INTRODUCTION* 172-73 (1983).

16. See DOUGLAS HAY & NICHOLAS ROGERS, *EIGHTEENTH CENTURY ENGLISH SOCIETY* 27, 71 (1997) (noting a "marked decline in living standards" for laborers and most of the poor in the latter half of the eighteenth century, along with a "staggering increase of food prices" and a corresponding decline in the bargaining power of labor in those early days of the industrial revolution).

developed that refused to balance the economic benefit of increased productivity against the related costs of displacement, increased economic inequality and social hierarchy, impoverishment, and even famine.<sup>17</sup> This mode of discourse threatens to work analogous harms upon the economy and polity of the Internet, by devaluing the importance of a public domain through the erosion of transformative rights and other fair uses of intellectual property.

The current revolution in, and at times inversion of, established principles of copyright and free expression is thus in principle no different from the dissolution of “ancient and venerable prejudices and opinions” regarding rights in land that took place at the dawn of the age of industrial manufacturing and intensive agriculture.<sup>18</sup> Past real-world experience does not bode well for the universe of public domain materials in cyberspace, or for the right to produce transformative works commenting or expanding upon existing copyrighted expression. Contributors to the great conversation will have their postings “expropriated,” namely deleted. As a consequence, the currently existing class of independent Web publishers, of small, more or less public-interested Internet speakers, will be radically depopulated.

Once this epoch-defining expropriation takes place, the owners of large copyright holdings will vigorously assert absolute rights of exclusion from their informational “estates.” They will claim, with William Blackstone before them, that an author “has clearly a right to dispose of that identical work as he pleases, and *any* attempt to take it from him, *or vary the disposition he has made of it*, is an invasion of his right of property.”<sup>19</sup> Blackstone appears to have advocated a perpetual common-law copyright

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17. As two historians write, “famine came to stalk wartime England at the end of the [eighteenth] century in part because of the consequences of a massive restructuring of other entitlements of a large part of the population: to land, to work, and to regulated markets.” *Id.* at 83. This despite the fact that in the early stages of the enclosure movement “harvests were good, food prices were low, and England was a substantial net exporter of grain.” *Id.* at 72. Thus it was that for “the first time in almost two hundred years, the mass of the English poor appeared to be facing starvation,” *id.* at 71, as enclosure increased food prices and deprived the peasantry of the nutritional safety net comprised by common rights, including the “gleaning” of leavings after the harvest, and the “poaching” of meat and firewood. *Id.*; *see id.* at 73 (estimating that gleaning could provide a poor family with up to three months of bread). Some even argue that “in the entire period since 1500 there was never an absolute shortage of food in England that made famine inevitable.” *Id.* at 83.

18. Karl Marx & Frederick Engels, *Manifesto of the Communist Party*, in THE MARX-ENGELS READER 473, 476 (Norton & Co. 1978).

19. WILLIAM BLACKSTONE, 2 COMMENTARIES ON THE LAWS OF ENGLAND \*405-06 (emphasis added).

of unlimited exclusivity, one that even went beyond prohibiting verbatim quotation for any purpose to preventing imitation of styles or ideas. He alleged that common-law copyright extended beyond the author's expression, and as far as the "style" and "sentiments," as "the thing of value, from which the profit must arise."<sup>20</sup> "Sentiments" was the very term used by Blackstone in his famous discussion of liberty of the press to refer to political opinions themselves.<sup>21</sup> He thus analogized ideas, thoughts, and opinions with tangible objects to which title may be taken by occupancy under English common law, such as the spoils of war, "moveables" found on the earth or in the sea, and wild animals.<sup>22</sup>

Neither did Blackstone favor any temporal limits on the copyright monopoly. He argued for perpetual common-law copyright in his influential *Commentaries on the Laws of England*, as well as on behalf of the London booksellers as counsel in *Millar v. Taylor*,<sup>23</sup> and from his seat on the Court of King's Bench in *Donaldson v. Becket*.<sup>24</sup> This is unsurprising, insofar as Blackstone, perhaps more explicitly than any other jurist, grounded the exclusive rights of authors in the aforementioned analogy to "title to things personal by occupancy" as a matter of "original and natural right."<sup>25</sup> He claimed that just as an owner of land does not forfeit the exclusive right to exploit his or her estate by providing keys to a guest, so copyright holders "may give out a number of keys, by publishing a number of copies; but no man, who receives a key, has thereby a right to forge others, and sell them to other people."<sup>26</sup> Blackstonian copyright may therefore be tentatively defined as a more or less "sole and despotic dominion" over a given work, a right of "total exclusion" asserted in perpetuity against any attempt to imitate the sentiments, vary the disposition, or derive any social or economic value from a work.<sup>27</sup>

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20. MARK ROSE, *AUTHORS AND OWNERS: THE INVENTION OF COPYRIGHT* 77 (1993) (quoting *Tonson v. Collins*, 98 Eng. Rep. 181 (K.B. 1761)).

21. See 4 BLACKSTONE, *supra* note 19, at \*151-52 ("Every freeman has an undoubted right to lay what sentiments he pleases before the public: to forbid this is to destroy the freedom of the press, but if he publishes what is improper, mischievous, or illegal, he must take the consequence of his own temerity. . . . Neither is any restraint hereby laid upon freedom of thought or inquiry: liberty of private sentiment is still left; the disseminating, or making public, of bad sentiments, destructive to the ends of society, is the crime which society corrects.").

22. 2 *id.* at \*400-07.

23. 98 Eng. Rep. 201 (K.B. 1769).

24. 98 Eng. Rep. 257 (H.L. 1774) (appeal taken from Eng.).

25. 2 BLACKSTONE, *supra* note 19, at \*400, \*405.

26. ROSE, *supra* note 20, at 91 (quoting *Tonson v. Collins*, 96 Eng. Rep. 169, 188 (K.B. 1761)).

27. 2 BLACKSTONE, *supra* note 19, at \*2.

The impending regime of Blackstonian copyright will be characterized by licenses to “read, but don’t download,” to “download, but don’t print,” to “print, but don’t quote from,” or even to “quote from, but don’t criticize.” Ever more generous remedies will be available in cases of boundary disputes; perhaps most troubling is the right to conscript the providers of Internet access and Web hosting space into summary extra-legal adjudication of claimed infringements in the shadow of draconian civil and criminal penalties.

This essay analyzes the ongoing legislative and judicial efforts to transform the hitherto limited monopoly conferred by American intellectual property law into an absolute Blackstonian right to exclude the public from virtually any use, without permission, of once-copyrighted material. More particularly, it traces certain common themes through the various normative defenses of these attempts from the ancient speech and access rights of the public. In so doing, it conceives of these ongoing efforts as a multi-front enclosure of the intellectual commons, as the Information Age counterpart to the expropriation of the English commoner from his pre-industrial rights and privileges over land at the dawn of the Industrial Age.

Part II retells some of the history of the English enclosure of common lands over several centuries. It recounts how, at each incursion into the commons, the same charmed convergence of sacred rights and utilitarian progress was used to gloss over the illegalities and expropriations required for such an epic reconfiguration of public and private rights. Part III shifts over into copyright history, analyzing how “rights-talk,” conclusory incentive-based utilitarian analyses, and distorted representations of the public domain as useless wasteland, have all been deployed in the cause of revoking users’ rights to the intellectual commons. This analysis furthers the thesis, advanced by Mark Lemley, that the trend towards the ever more expansive “propertization” of the copyright monopoly is a result of the “rise of [real] property rhetoric” in intellectual property policy discussions, coupled with a “particular economic view of property rights” as the solution to the tragedy of the commons.<sup>28</sup> Although Professor Lemley argues that both rhetorical themes “emerge” from the Chicago school law and economics movement,<sup>29</sup> I hope to identify the much older and more profound sources of their influence on our legal and political culture.

Part IV describes the current theoretical and practical campaign to privatize the public’s rights both to the untrammelled use of works whose copyright has expired, and to certain non-licensed uses of works whose

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28. Lemley, *supra* note 4, at 897.

29. *See id.*

copyright remains valid. This campaign is taking place on four broad and interrelated fronts, including legislative extension of copyright term, the imposition of liability on Internet Service Providers (“ISPs”) for the activities of their patrons, the legal reinforcement of anti-circumvention technologies, and the judicial enforcement of mass-market informational licenses. Again, on each of these fronts the same lines of argument—the sanctity of property rights, the need for incentives, and the commons as precursor to desolation—are asserted in the cause of the privatization of established public rights and privileges.

The First Amendment as originally intended, I argue in Part V, compels limitations on copyright expansion, and the private censorship rights it may grant. The argument proceeds to analogize the depopulation of the English yeomanry, and its increased dependency on large landowners and industrial enterprises, to the depopulation of the class of Internet publishers independent of media corporations. More meaningful First Amendment inquiry than that customarily provided to copyright defendants is warranted before copyright expansion is permitted to make a clean sweep of so much cyberspace communication.

## II. THE ENGLISH ENCLOSURES OF COMMONS AND EXPROPRIATION OF THE YEOMANRY

Land grabs typically proceed along two broad fronts. The first is the enclosure itself, which is fairly straightforward. Those engrossing their estates expel or block out those they deem to be squatters, trespassers, nomads, or otherwise unauthorized users, and step up surveillance and punishment of small tenant farmers, foragers, firewood collectors, etc. Along the second front, those who seek to expand their dominion over the commons recharacterize existing distributions of entitlements as outright theft in any instance where these “rights” would impede the expansion of their holdings. As we shall later see, an analogous process accompanies the enclosure of intellectual commons.<sup>30</sup>

Thus the “tolerated practices” of Michel Foucault’s analysis,<sup>31</sup> claimed by the peasant as rights secured by long and bloody struggle, are re-described as illegalities. What the peasant claimed as a right is discovered to have been a crime all along. It is, first of all, a crime against individuals, violating their sacred rights of private property. Secondly, it is a crime against the public, comparable to burglary and brigandry, disrupting settled entitlements and frustrating progress and development.

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30. See discussion *infra* Parts III, VI.

31. See *supra* note 1 and accompanying text.

This section depicts several scenes out of this recurring drama. They may be divided into two parts: the enclosure and privatization of the common lands themselves, and the expropriation of the peasantry from its vital rights and privileges over privately-held lands. In each case, self-aggrandizing landowners redescribed disfavored entitlements as unproductive, as trespass, as theft; the holders of these disfavored entitlements were alienated from them; and the resulting redistribution of entitlements was declared to be absolute and eternal.

### A. The Theft of Rights

The quasi-feudal system of English agriculture during the fifteenth and sixteenth centuries was, by some accounts, characterized by a majority of free and independent farmers.<sup>32</sup> After the collapse of serfdom in the mid-fourteenth century, a new class of yeoman arose, struggling for its freedom throughout the following century. Eventually, the yeomanry successfully "acquired a substantial proprietary interest in the soil."<sup>33</sup>

The yeomanry's proprietary interest was embodied in the "copyhold," and rights in the common. The former was the small farmer's customary right to occupy some part of a feudal estate as a sort of sub-tenant. Copyhold was a sort of "inferior estate that existed within a manor held in fee simple by a lord."<sup>34</sup> The yeoman copyholder was referred to as a "customary tenant," to reflect that the source of his right was a custom that "hath been in use, time out of mind of man, that certain tenants within the same manor have used to have lands and tenements to hold to them and their heirs."<sup>35</sup>

One legal historian defines a commons as "a tract of land subject to common rights of pasture except when in crop and then necessarily fenced against stray animals."<sup>36</sup> Since each of these "free farmers" were allocated arable land of not much more than four acres of land on average, they depended heavily on "the usufruct to the common land [or right to use it

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32. See THOMAS BABINGTON (LORD) MACAULAY, 1 HISTORY OF ENGLAND 333-34 (1848-1861) ("The petty proprietors who cultivated their own fields with their own hands, and enjoyed a modest competence . . . then formed a much more important part of the nation than at present. . . . The average income of these small landlords . . . was estimated at between £60 and £70 a year. It was computed that the number of persons who tilled their own land was greater than the number of those who farmed the land of others.").

33. ROBERT C. ALLEN, ENCLOSURE AND THE YEOMAN 66 (1992).

34. Charles J. Reid, Jr., *The Seventeenth-Century Revolution in the English Land Law*, 43 CLEV. ST. L. REV. 221, 248 (1995).

35. *Id.* at 247 (citations omitted).

36. ERIC KERRIDGE, THE COMMON FIELDS OF ENGLAND 5 (1992).

without damaging it], which gave pasture to their cattle, furnished them with timber, fire-wood, turf, &c.”<sup>37</sup> The importance of the right to use communal property is often emphasized: “We must never forget that even the serf was not only the owner, if but a tribute-paying owner, of the piece of land attached to his house, but also a co-possessor of the common land.”<sup>38</sup>

By as early as 1509, one historian recounts, a “large portion of English farming . . . was performed by farmers working within an extraordinarily complex system of open fields and common rights.”<sup>39</sup> Nevertheless, the rights of the free farming peasant came under continual attack by the land-owning lords and their successors, who desired to enclose for themselves both the land tilled by customary tenants (internally) and the common lands (externally). Both rights in the commons and the customary rights of sub-tenants, mere encumbrances from the perspective of the large land-owners, took centuries to eliminate.

These were centuries marked by violent expropriation, largely ineffective legal and legislative responses to this expropriation, and occasional acts of rioting and collective resistance.<sup>40</sup> The process of violent expropriation was dubbed the “clearing of estates, i.e., the sweeping men off them.”<sup>41</sup> Typically, the “dwellings of the peasants and the cottages of the labourers were razed to the ground or doomed to decay.”<sup>42</sup>

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37. KARL MARX, CAPITAL (1867), in 50 GREAT BOOKS OF THE WESTERN WORLD: MARX 1-2, at 356 (1984). These common lands included not only so-called “communal property,” but also the large tracts of feudal lands owned by the Catholic Church, and the Crown estates.

38. *Id.* at 356 n.1.

39. Reid, *supra* note 34, at 252.

40. Beginning in the late fifteenth and throughout the sixteenth century, the land-owning nobility, impoverished by the “great feudal wars” and enticed by the rising price of wool in England, entered on a campaign of usurpation of arable land tilled under color of customary rights, with an eye toward converting it into pasture for their large herds of sheep. See MARX, *supra* note 37, at 356. Many of these early enclosures were enshrined in neither royal decree nor parliamentary legislation, but carried out simply by means of individual acts of violence that excluded the copyholding small farmer from the new-found pastures of the powerful. See *id.* at 359.

41. *Id.* at 361.

42. *Id.* at 356. The illegality of the rights asserted in such an absolute fashion was declaimed to little effect. Marx documents that popularly demanded legislation fought “in vain” against this process “for 150 years.” *Id.* at 359. The monarchy approached the issue from a different perspective, which Francis Bacon summarized as the principle that “to make a good infrantry, it requireth men bred not in a servile or indigent fashion, but in some free and plentiful manner.” FRANCIS BACON, THE HISTORY OF THE REIGN OF KING HENRY VII 66 (Brian Vickers ed., Cambridge Univ. Press 1998) (1622). An Act of Henry VII “forbad the destruction of all ‘houses of husbandry’ to which at least 20 acres of land

The seventeenth century saw continued theft of customary rights. This entailed both an "attack on copyhold, which was preeminently the individual rights small landholders enjoyed over particular parcels of land," and "the limiting of access to open fields and the exercise of rights held in common by broadly defined and diffuse groups of individuals."<sup>43</sup> In the courts, these attacks were conducted by strict construction of customary rights. In *Gateward's Case*,<sup>44</sup> the Court of Common Pleas declared that "it would enforce only customs that were certain," its "chief policy concern" being "that landowners be able to enclose."<sup>45</sup>

With increasing frequency throughout the eighteenth century, the enclosure of communal property and state lands took place with this kind of legal formality.<sup>46</sup> The innovation of the times was the "parliamentary form of the robbery," embodied in "Acts for enclosures of Commons, in other words, decrees by which the landlords grant themselves the people's land as private property, decrees of expropriation of the people."<sup>47</sup> The forum was a "parliament of landlords," with one house dominated by the landed gentry, the other restricted to those with incomes in the top one percent of the population, and with the king wielding a veto over the whole.<sup>48</sup> The

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belonged," and fixed "a proportion between corn land and pasture land" to prevent the wholesale incursion of the latter on the former. MARX, *supra* note 37, at 357. A later Act of Henry VIII, this one of 1533, "ordain[ed] the rebuilding of the decayed farmsteads," and after reciting that "some owners possess 24,000 sheep," limited the allowable number to 2,000. *Id.* However, in the end both the "cry of the people and the legislation directed . . . against the expropriation of the small farmers and peasants, were . . . fruitless." *Id.*

43. Reid, *supra* note 34, at 245.

44. 77 Eng. Rep. 344 (C.P. 1607).

45. Andrea C. Loux, *Persistence of the Ancient Regime: Custom, Utility, and the Common Law in the Nineteenth Century*, 79 CORNELL L. REV. 183, 191 (1993).

46. The "Glorious Revolution" of 1688 gave a new impetus to the enclosure movement, as "colossal scale thefts of state lands" ensued. Crown estates were "given away, sold at a ridiculous figure, or even annexed to private estates by direct seizure," all this "without the slightest observation of legal etiquette." MARX, *supra* note 37, at 359. As one nineteenth century commentator exclaimed, "The illegal alienation of the Crown Estates, partly by sale and partly by gift, is a scandalous chapter in English history . . . a gigantic fraud on the nation." F.W. NEWMAN, *LECTURES ON POLITICAL ECONOMY* 129-30 (London, J. Chapman 1851) (quoted in MARX, *supra* note 37, at 359 n.3).

47. MARX, *supra* note 37, at 359.

48. HAY & ROGERS, *supra* note 16, at 100; *see also* 1 BLACKSTONE, *supra* note 19, at \*163 ("it is notorious, that a very large share of property is in the possession of the house of lords"). Blackstone described as "the true excellence of the English government" the fact that "the people are a check on the nobility, and the nobility on the people; . . . while the king is a check upon both." *Id.* at \*150. The class of those eligible to represent the "people" in the House of Commons was, however, restricted to "knights, elected by the proprietors of lands," and "citizens and burgesses, chosen by the mercantile part or supposed trading interest of the nation. . . ." *Id.* at \*154-55. In concrete terms, "every

landed aristocracy “monopolized the high offices of state,” occupying forty percent of seats in Parliament and dominating many of the rest via patronage.<sup>49</sup> One historian estimates that “[a]fter 1760 altogether there were about 5,400 enclosure acts and enclosures under general acts, covering . . . more than seven million acres—say a fifth of the area of England.”<sup>50</sup>

## B. Justifications for Enclosure: The Rhetoric of Waste

In the seventeenth and eighteenth centuries, the yeomanry’s longstanding rights in the commons were to be denied, transformed into criminal acts, and reassigned to the large landowners. In almost the same breath, use of the commons would be slandered as unproductive and economically useless, as an aimless and wasteful traipsing about lands that would be put to much better use by their new owners, the “capital” or “merchant” farmers.

Major English theorists of property, prominently among them Hobbes, Locke, and Blackstone, argued that pre-feudal rights in the commons were not only not rights at all, but that they were in fact moral and legal wrongs. The justification of capitalist private property on a natural rights rationale is the more familiar contribution of these theorists, but the utilitarian-economic aspects of their arguments are indissoluble components of their thinking, and even serve to ground the rights that they so vigorously champion. The true rights holders were those who enclosed the commons, expropriated the yeomanry, and exploited the land more intensively. The

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knight of a shire shall have a clear estate of freehold or copyhold to the value of six hundred pounds *per annum*, and every citizen and burgess to the value of three hundred pounds. . . .” *Id.* at \*170. Those eligible to vote, according to Blackstone, were those possessing freehold estates earning at least twenty pounds annual income. *See id.* at \*166-67. As of 1759, just two years before Blackstone was writing, less than one percent of English families earned an average annual family income of even four hundred pounds, and hundreds of thousands of farming, fishing, laboring and soldiering families earned less than 20 pounds. *See HAY & ROGERS, supra* note 16, at 20. Blackstone deemed these qualifications necessary to assure that members of parliament were “by no means of a degree of yeomen,” nor their electors “persons of indigent fortunes.” 1 BLACKSTONE, *supra* note 19, at \*170, \*165.

49. HAY & ROGERS, *supra* note 16, at 189; *see id.* at 57-58, 191.

50. W.E. TATE, THE ENGLISH VILLAGE COMMUNITY AND THE ENCLOSURE MOVEMENT 50-51 (1967), *quoted in* Reid, *supra* note 34, at 260. These included 776 enclosure acts enacted by Parliament between 1760 and 1780 alone. *See* THOMAS A. HORNE, *supra* note 13, at 130. The existence and sheer numbers of such Acts demonstrates that the commons were never the landlords’ private property and that a massive reconfiguration of rights was required to transform them into it. *See* MARX, *supra* note 37, at 359-60.

propertarian ideology of early enclosers like Sir Walter Raleigh took on a new and more enduring philosophical form.

While Hobbes and Locke are often set in philosophical opposition to one another, there is a good deal more continuity than is commonly recognized in their theorizing of the relationship between sovereign power and the right of private property. Their theories share a deep-seated tension, one that reflects their desire to render the rights of the yeomanry unstable, and subject to unlimited sovereign revision, while simultaneously providing strong theoretical grounds for protecting the property rights of the new class of intensive farmers. To accomplish this twin objective, the philosophers weave together rights-based and utility-based arguments to distinguish the two classes of rights—peasant/yeoman and merchant farmer—and to aggrandize the latter over the former.

Both Hobbes and Locke, for example, provide more than adequate grounds for revocation of the small farmers' usufruct in the commons. Writing in the 1640s, a time when efforts at private enclosures and royal giveaways of commons were on the rise, Hobbes took great pains to justify the sovereign's "whole power of prescribing the Rules, whereby every man may know, what Goods he may enjoy."<sup>51</sup> This power is contracted to the sovereign in exchange for delivering the people from the nightmarish uncertainty of life and property in the state of nature. In *De Cive*, Hobbes approaches identifying the commons of his day with the state of nature. He inquires, as the motivating question of his "Naturall Justice," into why it was that "what Nature at first laid forth in common, men did afterwards distribute into severall Impropriations," why in other words "when all was equally every mans in common, men did rather think it fitting, that every man should have his Inclosure."<sup>52</sup>

Hobbes initiates propertarian ideology's philosophical effacement of rights in the commons by equating the commons of his day with untouched nature, in a way that renders such rights an absurd and dangerous anachronism.<sup>53</sup> For in the Hobbesian state of nature, the right to every-

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51. THOMAS HOBBS, *LEVIATHAN* 125 (Richard Tuck ed., Cambridge Univ. Press 1991) (1651).

52. THOMAS HOBBS, *DE CIVE* 27 (Howard Warrender ed., Oxford Univ. Press 1983) (1651).

53. Sir Walter Raleigh could also claim some credit for this seventeenth century line of thought with his attack on the already moribund sixteenth century anti-enclosure legislation. His first point against the prohibition of enclosures was roughly rights-based; Raleigh argued that the "best course" regarding enclosure "is to set it at liberty, and leave every man free, which is the desire of a true English man." SIR SIMONDS D'EWES, *A COMPLEAT JOURNAL OF THE VOTES, SPEECHES, AND DEBATES BOTH OF THE HOUSE OF LORDS AND HOUSE OF COMMONS* 674 (1693), *quoted in* Reid, *supra* note 34, at 256

thing reduces into a right to nothing, for since "every man has a Right to every thing; even to one anothers body . . . there can be no security of any man."<sup>54</sup> Of course, it cannot be said of the English commons what Hobbes says of the state of nature, that "all men had right to all things." One commoner could not appropriate the whole to the exclusion of all others, for then it would cease to be a commons. As rights in the commons survived for some time, and an entire way of life built upon them, some degree of compromise and of negotiated uses must have prevailed, about which more will be said in good time.

In more or less attributing to the commons all the horrors of his idiosyncratic conception of the state of nature, Hobbes inaugurates the distorted account of the commons' disutility that will dominate proprietarian ideology. In some of the earliest statements of a sort of tragedy of the commons, Hobbes speaks of "the publick Wayes, which lye open to all passengers to traverse up and . . . so that with the Impertinencies of some, and the Altercations of others, those wayes never have a seeds time."<sup>55</sup> He argues that "from a Community of Goods, there must needs arise Contention whose enjoyment should be greatest, and from that Contention all kind of Calamities must unavoydably ensue, which by instinct of Nature, every man is taught to shun."<sup>56</sup> The absence of "Mine and Thine" in the seventeenth-century commons, as much as in the state of nature, leads to the "perpetual warre of every man against his neighbour," to uncertainty, friction, and waste.<sup>57</sup> Hence, as we know, "there is no place for Industry; because the fruit thereof is uncertain," no culture, arts, society, and so on unto an equally nasty death.<sup>58</sup>

This state of war prompts men to forfeit their "right to everything," except self-preservation, to the sovereign state. They forfeit to the sovereign their "universal right" to all things on the earth, but by this "mutuall

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n.147. He remarked that "I do not like the constraining of them to use their Grounds at our wills but rather let every man use his Ground to that which it is most fit for, and therein use his own Discretion." *Id.* The second was economic: anti-enclosure acts were counterproductive, he argued, because the yeomanry possessed less capital than the large landowners, and as a consequence "many poor men are not able to find seed to sow so much as they are bound to plough." *Id.* A number of pro-enclosure tracts throughout the first half of the seventeenth century reiterated these points. *See, e.g., Reid, supra* note 34, at 257-61 nn. 151-70 (collecting sources).

54. HOBBS, *supra* note 51, at 91.

55. HOBBS, *supra* note 52, at 26.

56. *Id.* at 27.

57. HOBBS, *supra* note 51, at 145.

58. *Id.* at 89.

Contract” acquire property rights “in recompence.”<sup>59</sup> Hence, as was noted, “the Introduction of *Propriety* is an effect of Common-wealth.”<sup>60</sup> As for “the Land it selfe,” the “Sovereign assigneth to every man a portion, according as he, and not according as any Subject, or any number of them, shall judge agreeable to Equity, and the Common Good.”<sup>61</sup>

From a state of perpetual war and mutual ruin of the earth held in common, Hobbes leads the reader to a world in which the sovereign, bound by nothing, allocates the lands as he or she sees fit. With an eye to the “common good” and with no regard for prior restrictions on the land, such as the sub-tenancies or usufructs of the yeomanry, the sovereign creates rights in his wealthier subjects based on their individual economic influence over him. The merchant farmer, who is not only better able to curry favor with the royals but contributes more to the “common good,” can thus appropriate the peasant’s rights as his or her own private property. This theft of rights, in turn, transforms continued use of the common by the peasant into theft, and a crime against the sovereign, a step back towards economic ruin and mutual universal murder. The charmed circle of propertarian thought has been drawn.

Before proceeding to Locke, this is a good place to point out just how the premises of propertarian ideology, as definitively explicated by Hobbes, foreclose critical avenues of inquiry into the costs of increased propertization of social resources. The petitions and pamphlets of Gerrard Winstanley, written more or less coterminously with Hobbes’s great tracts on government, pursue these avenues to the conclusion that indiscriminate enclosure is not only unjust but is inefficient. Winstanley was one of the English Levellers who advocated after the English Civil War that “Victory being obtained over the King, the spoyl which is properly in the Land, ought in equity to be divided now between the two Parties, that is, Parliament and Common-people.”<sup>62</sup> In these petitions and pamphlets, he con-

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59. *Id.* at 101.

60. *Id.* at 171.

61. *Id.*

62. JERRARD WINSTANLEY, A NEW-YEERS GIFT FOR THE PARLIAMENT AND ARMIE (1650), available at <http://www.tlio.demon.co.uk/gift.htm> [hereinafter NEW-YEERS GIFT]. See JERRARD WINSTANLEY ET AL., THE TRUE LEVELLERS STANDARD ADVANCED: THE STATE OF COMMUNITY OPENED, AND PRESENTED TO THE SONS OF MEN (1659), available at <http://www.tlio.demon.co.uk/diggers.htm#True> [hereinafter *True Levellers*]. The Levellers were a radical faction of the Parliamentary Army, and advocated reforms that anticipated by more than a century many of the rights later enshrined in the United States Constitution. They pleaded for the right to jury trial, criminal due process, and a prohibition on disproportionate punishments, compulsory self-incrimination, the monopolization of trade, debtor’s prisons, and the subjection of “matters of religion and

ceded that the "Parliament, consisting of Lords of Manors, and Gentry, ought to have their inclosure Lands free to them without molestation," on the condition that "the Common-people. . . ought to have the freedom of all waste and common land, and Crown-land equally among them."<sup>63</sup>

The arguments marshaled in support of the "true" Levellers' position are as critical today as are the much more politically dominant ones of Hobbes and his progeny. They appeal not to a complex mythology of an original state of nature, but to the history, experience, and morality of an actually existing people. For example, Winstanley answers Hobbes's question regarding "who gives the Earth to some part of mankind, and denies it to another part of mankind[?]" very differently, asserting that the one:

that hath the Earth, hath no right from the Law of creation to take it to himself, and shut out others; but he took it away violently by Theft and Murder in Conquest: As when our Norman William came into England and conquered, he turned the English out, and gave the Land unto his Norman Souldiers every man his parcel to inclose.<sup>64</sup>

The very mention of the historical origins of English holdings places Winstanley in distinct contrast to Hobbes, whose account of a primordial social contract whitewashes enclosure by inverting the fact of violent conquest and appropriation into a mythical granting away by the weaker of their equal claim of right in the land.<sup>65</sup>

In addition to this searing criticism of the natural rights rationale for the existing distribution of property rights, Winstanley makes a powerful case that the social costs of increased enclosure of commons may often outweigh the benefits. Against Hobbes and other partisans of the position that enclosure works only utilitarian and economic benefits, he argues that "Propriety," as the "fruit of War from the beginning," requires "those

God's worship [to] the compulsive or restrictive power of any authority upon earth." John Lilburne et al., *The Petition of Sept. 11 1648*, in *THE ENGLISH LEVELLERS* 131, 135-139 (Andrew Sharp ed., 1998).

63. WINSTANLEY, *NEW-YEERS GIFT*, *supra* note 62.

64. *Id.* John Rawls echoes this concern in considerably muted form when he argues in support of his Difference Principle that the "existing distribution of income and wealth . . . is the cumulative effect of prior distributions of natural assets—that is, natural talents and abilities—[and] social circumstances, . . . factors so arbitrary from a moral point of view." JOHN RAWLS, *A THEORY OF JUSTICE* 72 (1971).

65. *Cf.* Mark Twain, *The Damned Human Race*, in *LETTERS FROM THE EARTH* 209, 226 (Bernard Devoto ed., 1962) ("There is not an acre of ground on the globe that is in possession of its rightful owner, or that has not been taken away from owner after owner, cycle after cycle, by force and bloodshed.").

Laws that upholds Whips, Prisons, Gallows,” and which are “but the same power of the Sword that raged, and that was drunk with Blood in the field.”<sup>66</sup> The flip side of Hobbes’s vicious state of nature is the carnage meted out by that monstrous Leviathan, the state. Similarly, Winstanley inverts Hobbes’s account of common rights as the source of “all kind of Calamities” when he maintains that it is instead “pleading for Propriety and single Interest, [that] divides the People of a land, and the whole world into Parties, and is the cause of all Wars and Bloud-shed, and Contention every where.”<sup>67</sup>

Even more illuminating is his answer to Hobbes’s argument that the act of the sovereign in parceling out the land “as he sees fit” is the best way to advance the common good. Winstanley underlines the possibility, which has become the subject of insistent denials by propertarian thinkers, that improvement and equality could go hand in hand:

[T]hose we call Poor should Dig and freely plant the Waste and Common Land for a livelihood, seeing there is Land enough, and more by half then is made use of, and not be suffered to perish for want. . . . [L]et them quietly improve the Waste and Common Land, that they may live in peace, freed from the heavie burdens of Poverty; for hereby our own Land will be increased with all sorts of Commodities, and the People will be knit together in love.<sup>68</sup>

Winstanley and the “true” Levellers, by illustrating the costs incurred when governments “lock up Treasures of the Earth from the poor,” demonstrate the misleading one-sidedness of Hobbes’s hypothesis that it is only common rights that obstruct improvement and so impoverish everyone involved.<sup>69</sup> The point is not that Hobbes was entirely wrong in stating that property rights can reduce friction and increase social wealth, but that his account, like those of so many others to come, unjustifiably and disin-

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66. WINSTANLEY, *NEW-YEERS GIFT*, *supra* note 62. This point could be described as an early articulation of the administrative costs of property rights, so often minimized in legislative and judicial copyright discourse.

67. WINSTANLEY ET AL., *TRUE LEVELLERS*, *supra* note 62.

68. WINSTANLEY, *NEW-YEERS GIFT*, *supra* note 62.

69. *Id.* The idea that exclusive rights in social resources could impose social costs has also been explored in the modern economic literature under the rubric of “rent-seeking.” Rent-seeking expends scarce social resources in order to capture an artificial governmentally authorized transfer of wealth. See JAMES BUCHANAN & GORDON TULLOCK, *THE CALCULUS OF CONSENT: LOGICAL FOUNDATIONS OF CONSTITUTIONAL DEMOCRACY* (1962); TOWARD A THEORY OF THE RENT-SEEKING SOCIETY (James Buchanan et al. eds., 1980); Peter Brimelow, *Privilege Seeking?*, *FORBES*, Sept. 22, 1997, available at <http://www.forbes.com/forbes/97/0922/6006073a.htm>.

generously suggests that such rights inevitably serve these functions, so that there could never come a point where increased enclosure would work a net social loss.

The happy coincidence of the large landowner's sacred rights and economic productivity, and the small farmer's lack of rights and uselessness, is vividly portrayed by Locke in the fifth chapter of his *Second Treatise of Government*, entitled *Of Property*. First published in 1690, the treatise should be understood in context, as the manifesto of a wealthy investor in the Royal Africa Company and Bank of England, whose patron was the first Earl of Shaftesbury, himself a man of extensive holdings in land and stock.<sup>70</sup> It was also written during the early stages of parliamentary acts of enclosure and the post-revolutionary "illegal alienation of the Crown Estates," a giveaway some have called "a gigantic fraud on the nation."<sup>71</sup>

Like Hobbes before him, Locke provides ample grounds for the sovereign's giveaway of lands, subject to various rights of the peasantry,<sup>72</sup> although he prefers that landowners observe certain parliamentary niceties in acquiring the land.<sup>73</sup> At the same time, however, he provides powerful new arguments to convince those who dispose of this unlimited sovereign power that the sovereign's power to regulate property rights should be mobilized behind the enclosure movement.

Locke's seminal work justifying the rights of the "industrious and rational" is well known. In brief, their "subduing and cultivating" of what lay in common "joined [their labor] to" it, and made it their property as a

70. See Peter Laslett, *Introduction to LOCKE*, *supra* note 2, at 25, 43.

71. MARX, *supra* note 37, at 359 n.3 (quoting F.W. NEWMAN, LECTURES ON POLITICAL ECONOMY 129-30 (London, 1851)).

72. See LOCKE, *supra* note 2, at 320 ("[I]n governments, the laws regulate the right of property, and the possession of land is regulated by positive constitutions.").

73. Taxation and other takings of property must proceed by "established and promulgated Laws," *id.* at 378, and with "the consent of the People," *id.* at 380. This explains what some have deemed to be an "attack" on enclosure. See JAMES TULLY, A DISCOURSE ON PROPERTY: JOHN LOCKE AND HIS ADVERSARIES 153-54 (1980). Thus Locke does say in reference to land held in common, at least in civilized countries like England, that "no one can inclose or appropriate any part, without the consent of all his Fellow-Commoners," because it is "the joint property of this Country." LOCKE, *supra* note 2, at 310. For Locke, however, "consent" never meant unanimity, and parliamentary elections were, of course, limited to property owners. Locke favored a property qualification of fifty acres even in the American colonies' parliaments of limited and subordinate jurisdiction. See John Locke, *The Fundamental Constitutions of Carolina*, in POLITICAL ESSAYS 160, 174-75 (Mark Goldie ed., 1997) (1699). As noted above, election to Parliament was impossible for as much as ninety-nine percent of the population even a century after Locke's time, and the right to vote denied to at least half of the adult men. See *supra* note 48.

matter of natural right.<sup>74</sup> Perhaps more interestingly, Locke declares that mere “inclosure,” “incroachment,” or “appropriation” is sufficient labor to ground rights of exclusion.<sup>75</sup> The individualistic narrative of the lone pioneer throwing up fences leaves little room for customary common rights, for “cultivating” without “subduing” and “inclosing.”

What is still less well known is how deeply Locke’s rights-based analysis of title to what is appropriated or improved is intertwined with consequentialist arguments about the unalloyed benefits of enclosure of commons. Locke took up Hobbes’s favorite theme almost verbatim: “If all things be left in common, want, rapine and force will unavoidably follow in which state, as is evident, happiness cannot be had which cannot consist without plenty and security.”<sup>76</sup> While he argues at one point that “the rightness of an action does not depend on its utility; on the contrary, its utility is a result of its rightness,”<sup>77</sup> the economic case for property rights serves to define and delimit the “property.” The crucial proto-utilitarian concept of “waste” distinguishes the legitimate claims of those whose labor fences in and intensively exploits a part of the commons, from those whose uses of the land are less productive, or amount to something between foraging and full-blown capitalist agriculture. The prohibition against waste is incorporated into Locke’s labor-mixing theory of acquisition as an answer to perhaps the most fundamental objection against it, that “if gathering the Acorns, or other Fruits of the Earth, &c. makes a right to them, then any one may *ingross* as much as he will.”<sup>78</sup> Recall here the small peasant’s indispensable “usufruct to the common land, which gave pasture to their cattle, furnished them with timber, fire-wood, turf, &c.”<sup>79</sup> The problem is clear: what is to distinguish the rights of the merchant farmer, with a hedged-in and cultivated estate, from the feudal or customary rights of the yeomanry to cultivate common lands, or to utilize them for foraging or pasture?

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74. *Id.* at 310. The natural law bases of property rights are even more explicit in a series of lectures Locke gave as Censor of Moral Philosophy at Christ Church, Oxford, and later published as *Essays on the Law of Nature*. See JOHN LOCKE, *Essays on the Law of Nature*, in POLITICAL ESSAYS, *supra* note 73, at 79, 126, 132 (1663-64) (“[I]t is a law of nature that every man should be allowed to keep his own property, or, if you like, that no one may take away and keep for himself what is another’s property. . . . For what justice is there where there is no personal property or right of ownership. . .”).

75. LOCKE, *supra* note 2, at 309-11

76. John Locke, *Morality*, in POLITICAL ESSAYS, *supra* note 73, at 267, 268 (1677-78).

77. John Locke, *Essays on the Law of Nature*, *supra* note 73, at 133.

78. LOCKE, *supra* note 2, at 308.

79. See discussion *supra* note 36 and accompanying text.

Locke appeals to no less a force than divine command to dispel the specter of a common usufructuary right, pronouncing that: "Nothing was made by God for Man to spoil or destroy."<sup>80</sup> Only the labor of "the industrious and rational" conveys title; "inclosed and cultivated land," with "distinct title," yields "ten times more" produce, if not "much nearer an hundred" times more, than "[l]and, of an equal richnesse, lyeng wast in common."<sup>81</sup> The paradigmatic case of land open to enclosure by the rational is "the wild woods and uncultivated waste of America," where the Indians record no measurable profit and where by want of true labor, rational and industrious labor, even their kings dress in dirty rags.<sup>82</sup> Thus land "that hath no improvement of pasturage, tillage, or planting, is called, and indeed is, waste; . . . the benefit of it amount[s] to little more than nothing."<sup>83</sup> People that regularly hunt certain lands, or rely upon them for berries, nuts, firewood, or water, be they situated in the wilds of America or in communal lands and crown estates, have no better right to use the land than anyone with the power to exclude them. The "quarrelsome and contentious" have a duty to stand down in the face of those with superior resources and industry, who are better able to "increase the common stock of mankind."<sup>84</sup>

Everything except the estates of the merchant farmer appears to be up for grabs, save for one problem: Will not some people inevitably enclose a good deal more than they can use, and by letting it "spoil" violate God's command to "subdue the Earth, i.e. improve it for the benefit of Life"?<sup>85</sup> Furthermore, will not God's desire to give the world to "Men in Common" be frustrated if one person may enclose as much as he or she wants, and leave less "than enough, and as good, in common for others"?<sup>86</sup> Recall that these are precisely the sorts of costs, imposed by enclosure, that Gerrard Winstanley cited to attack its immoral effects and to advocate a more equal distribution of land.<sup>87</sup>

Locke's answer to this charge is that by using money, those left out of enclosure give tacit consent to infinite inequality, and attendant limitless deprivation. By giving their consent that certain metals would possess a value equal to inherently valuable land and goods, "men have agreed to

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80. *Id.* at 308.

81. *Id.* at 312.

82. *Id.* at 315.

83. *Id.*

84. *Id.*

85. *Id.* at 309.

86. *Id.*

87. See discussion *supra* notes 62-69 and accompanying text.

disproportionate and unequal Possession of the Earth” so that “a man may fairly possess more land than he himself can use the product of, by receiving in exchange for the overplus, Gold and Silver.”<sup>88</sup> This bizarre argument, invoking a Faustian bargain by the landless peasant, is a necessary step in Locke’s case for an “obligation” of property that is “antecedent to human laws.”<sup>89</sup> Without this rationale, the anti-egalitarian implications of title by enclosure as a zero-sum game would expose his theory to obvious and damning criticisms.

Another theorist, William Blackstone, Vinerian professor of the English Common Law at Oxford and author of a multi-volume set of *Commentaries on the Laws of England*, has likewise exercised a powerful influence upon the Anglo-American discourse of property rights, from the time of the Framers of the Constitution to the present day.<sup>90</sup> He weaves together natural rights and utilitarian rhetoric into a seamless argument for enclosure and against the continued exercise by the peasantry of their rights in the common.<sup>91</sup> Like Hobbes and Locke before him, Blackstone helps set the moral and legal stage for the revocation of these customary rights to communal, church, and crown lands.

To begin with, he completes the attack upon customary rights that began in Hobbes’s time.<sup>92</sup> He argues that “no custom can prevail against an express act of parliament,” even where Blackstone’s own extremely strict requirements for the “legality” of a custom are met.<sup>93</sup> He thus embellishes

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88. *Id.* at 320.

89. John Locke, *Obligation of Penal Laws*, in *POLITICAL ESSAYS*, *supra* note 73, at 235 (1676).

90. *See, e.g.*, Albert Altschuler, *Rediscovering Blackstone*, 145 U. PA. L. REV. 1 (1996).

91. *See* 1 BLACKSTONE, *supra* note 19, at \*134-5; 2 *id.* at \*1-15, \*400-07.

92. Sir Edward Coke in 1641 spoke of the “two pillars” for customs, namely “common usage, and time out of mind.” SIR EDWARD COKE, *THE COMPLETE COPY-HOLDER* (1641), *quoted in* E.P. THOMPSON, *CUSTOMS IN COMMON* 97 (1991). S. Carter in 1696 spoke of four, namely “antiquity, continuance, certainty, and reason,” such that “a reasonable Act . . . found to be good . . . being continued without interruption time out of mind, . . . obtaineth the force of a law.” S. CARTER, *LEX CUSTUMARIA: OR, A TREATISE OF COPY-HOLD ESTATES* (2d ed. 1701) (1696), *quoted in* THOMPSON, *supra*, at 97. Blackstone listed fully seven “necessary requisites” of the “legality” of a custom, and in the end it is difficult to imagine all of them being met. A custom, he held, must possess: antiquity, defeated “if any one can shew the beginning of it”; continuance, defeated by “[a]ny interruption”; acquiescence, defeated by being “disputed either at law or otherwise”; reasonableness, defeated not only by “every unlearned man’s reason” but by “artificial and legal reason”; certainty, defeated if the value may not “at any time be ascertained”; compulsoriness, defeated by the option of anyone not to obey it; and consistency, defeated by contradiction. 1 BLACKSTONE, *supra* note 19, at \*76-78.

93. *Id.* at \*76.

on the requirement that a custom possess sufficient antiquity that “the memory of man runneth not to the contrary,” since the statute itself could be deemed as proof of such a time.<sup>94</sup> Blackstone declares that “all property is derived from society” and can be revoked by society, although not without the blessing of a Parliament representing the propertied classes.<sup>95</sup> He writes that the “power and jurisdiction of parliament” is “transcendent and absolute,” a “sovereign and uncontrolable authority,” an “absolute despotic power . . . [to] do every thing that is not naturally impossible.”<sup>96</sup> Blackstone was himself a member of Parliament from 1761 to 1770,<sup>97</sup> the first half of a twenty-year period that saw fully 776 enclosure acts.<sup>98</sup>

In occasionally stark contrast to the legal positivism implicit in these statements, Blackstone employs, as is well known, the most extravagant natural law rhetoric in favor of private property rights. He holds forth at length about the “sacred and inviolable rights of private property,”<sup>99</sup> and more particularly of “the absolute right, inherent in every Englishman, . . . of property: which consists in the free use, enjoyment, and disposal of all his acquisitions without any control or diminution save only by the laws of the land.”<sup>100</sup> Finally, of course, we have Blackstone’s famously idiosyncratic definition of property as “that sole and despotic dominion which one man claims and exercises over the external things of the world, in total exclusion of the right of any other individual in the universe.”<sup>101</sup>

Blackstone’s derivation of property rights is explicitly Lockean, and rests on the “bodily labor, bestowed upon any subject which before lay in common to all men, which is universally allowed to give the fairest and most reasonable title to an exclusive property therein.”<sup>102</sup> Yet Blackstone requires as a predicate to exclusive rights, and enclosure, hardly any real labor or cultivation at all. His formulation, extremely destructive to the very idea of a commons, is that “[p]roperty, both in lands and moveables, being thus originally acquired by the first taker, which taking amounts to a

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94. *Id.*

95. *Id.* at \*289.

96. 1 *id.* at \*156.

97. See Altschuler, *supra* note 90, at 15.

98. See HORNE, *supra* note 50, at 130.

99. 1 BLACKSTONE, *supra* note 19, at \*135.

100. *Id.* at \*134. Blackstone contemplated not much more “diminution” of absolute control than amounted to “restraints in themselves so gentle and moderate . . . that no man of sense or probity would wish to see them slackened,” *id.* at \*144, such as entry onto lands to destroy “ravenous beasts of prey, [such] as badgers and foxes,” 3 *id.* at \*212.

101. 2 *id.* at \*2.

102. *Id.* at \*5.

*declaration that he intends to appropriate the thing to his own use, it remains in him, by the principles of universal law.*"<sup>103</sup>

Despite the heavy reliance on natural right, Blackstone is no pure Kantian deontological moralist, as Albert Altschuler has pointed out in a recent essay.<sup>104</sup> Following Locke, Blackstone argues that the "eternal, immutable laws of good and evil" closely coincide with utility and economic growth.<sup>105</sup> God, he writes, has "inseparably interwoven the laws of eternal justice with the happiness of each individual," ordaining an intimate "connection of justice and human felicity."<sup>106</sup> Blackstone pursues this line of thought so far as to declare that the test of whether an action comported with natural law is whether it "tends to man's real happiness . . . or, on the other hand . . . is destructive of man's real happiness. . . ."<sup>107</sup> Private property via enclosure so clearly passes that one wonders whether it was the very source of the test:

It was clear that the earth would not produce her fruits in sufficient quantities without the assistance of tillage: but who would be at the pains of tilling it, if another might watch an opportunity to seize upon and enjoy the product of his industry, art, and labor? Had not, therefore, a separate property in lands, as well as moveables, been vested in some individuals, the world must have continued a forest, and men have been mere animals of prey; which, according to some philosophers, is the genuine state of nature.<sup>108</sup>

For Blackstone, "separate property" proves as much a bulwark against the war of all against all, and against the waste that the commons must always be, as it was for Hobbes and Locke. As it turns out, not only eternal justice, but also human happiness and God's will, mandate the enclosure of commons and the expropriation of the yeomanry.

The thinker who has come to most embody this line of thinking regarding the distribution of property, tying up its various strands into one vivid and enduring metaphor, bears extended quotation.

It is to no purpose, that the proud and unfeeling landlord views his extensive fields, and without a thought for the wants of his brethren, in imagination consumes himself the whole harvest that

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103. *Id.* at \*9 (emphasis added).

104. See Altschuler, *supra* note 90, at 4.

105. See 1 BLACKSTONE, *supra* note 19, at \*40.

106. *Id.*

107. *Id.* at \*41.

108. 2 *id.* at \*7.

grows upon them. The homely and vulgar proverb, that the eye is larger than the belly, never was more fully verified than with regard to him. . . . The rich only select from the heap what is most precious and agreeable. They consume little more than the poor, and in spite of their natural selfishness and rapacity, though they mean only their own conveniency, though the sole end which they propose from the labours of all the thousands whom they employ, be the gratification of their own vain and insatiable desires, they divide with the poor the produce of all their improvements. They are led by an invisible hand to make nearly the same distribution of the necessaries of life, which would have been made, had the earth been divided into equal portions among all its inhabitants, and thus without intending it, without knowing it, advance the interest of the society, and afford means to the multiplication of the species.<sup>109</sup>

The metaphor of the Invisible Hand captures with unprecedented elegance the unity of private rights and the public good. It is the same unity posited by Locke as the tendency of distinct title to both vindicate the moral claims of labor and to increase the stock of mankind, and extolled in flowing terms by Blackstone as the intimate “connection of justice and human felicity.”<sup>110</sup>

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109. ADAM SMITH, *THE THEORY OF MORAL SENTIMENTS* 184-85 (D.D. Raphael & A.L. MacFie eds., Clarendon Press 1976) (1759). The corresponding passage from *The Wealth of Nations* is much less revealing:

[E]very individual necessarily labours to render the annual revenue of the society as great as he can. He generally, indeed, neither intends to promote the publick interest, nor knows how much he is promoting it. . . . [H]e intends only his own gain, and he is in this, as in many other cases, led by an invisible hand to promote an end which was no part of his intention.

ADAM SMITH, 1 *AN INQUIRY INTO THE NATURE AND CAUSES OF THE WEALTH OF NATIONS* 456 (R. H. Campbell et al. eds., Clarendon Press 1976) (1776). Compare in this regard Gerrard Winstanley’s complaint on behalf of the English landless:

[T]he government we have gives freedom and livelihood to the Gentry, to have abundance, and to lock up Treasures of the Earth from the poor, so that rich men may have chests full of Gold and Silver, and houses full of Corn and Goods to look upon; and the poor that works to get it, can hardly live, and if they cannot work like Slaves, then they must starve. And thus the Law gives all the Land to some part of mankind whose Predecessors got it by conquest, and denies it to others, who by the righteous Law of Creation may claim an equall portion.

WINSTANLEY, *NEW-YEERS GIFT*, *supra* note 62.

110. 1 BLACKSTONE, *supra* note 19, at \*40.

The inverse of the tragedy of the commons—or at least of the version that appears in Hobbes through Blackstone and that is destined to conflict, disorder, and waste—is the glory of the enclosure. The “proud and unfeeling landlord,” liberated to make “improvements” upon the wasteful practices of the yeomanry, manages to increase the produce of the lands while simultaneously approximating an equal division of the earth among all of humanity. The benefits of private property are rivaled only by the costs of common ownership. Classical economics makes the same argument, merely “shifting the terms of analysis from a language of rights to a language of markets.”<sup>111</sup> The content remains the same: the coincidence of rights and utility in favor of “sensibly dividing the country among opulent men.”<sup>112</sup>

The great landlords and their allies applied these philosophical and legal arguments with much success. They re-categorized the peasant’s meager but vital customary rights as acts of punishable theft. Regarding internal enclosure, the principle of a landlord “doing as he wills with his own” was marshaled to justify expropriation of the copyhold from the yeomanry.<sup>113</sup>

In an equally momentous distortion, the advocates of parliamentary Acts of enclosure, doubtless following a well-established practice, “tried to represent communal property as the private property of the great landlords who have taken the place of the feudal lords.”<sup>114</sup> Given this inversion of rights, opponents of enclosure were branded as “Buccaneers’ who

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111. Istvan Hont & Michael Ignatieff, *Needs and Justice in the Wealth of Nations, in WEALTH AND VIRTUE: THE SHAPING OF POLITICAL ECONOMY IN THE SCOTTISH ENLIGHTENMENT* 26 (I. Hont & M. Ignatieff eds., 1983).

112. ROY PORTER, *ENGLISH SOCIETY IN THE EIGHTEENTH CENTURY* 226 (1982) (quoting Adam Smith).

113. MARX, *supra* note 37, at 338 (quoting DR. SIMON, PUBLIC HEALTH, SEVENTH REPORT 9-14 (1865)). Another crucial right of the peasantry, the right of the indigent to glean ears of corn and leaves of wheat from harvested fields, was outlawed on similar grounds in 1788, despite being “sanctioned by custom,” “regulated by village by-laws,” and according to one dissenting judge, a common law right. THOMPSON, *supra* note 92, at 138. Lord Loughborough, channeling Blackstone, reasoned that the custom was both “inconsistent with the nature of property which imports exclusive enjoyment,” and “[d]estructive of the peace and good order of society, and amounting to a general vagrancy.” *Id.* at 139 (quoting *Steel v. Houghton et Uxor*, 126 Eng. Rep. 32, 39 (K.B. 1788)). One parliamentarian declared: “To sanction this usage would introduce fraud and rapine, and entail a curse upon the country.” *Id.* at 140 (quoting Justice Heath).

114. MARX, *supra* note 37, at 359.

‘sally out, and drive, or drown or steal, just as it suits them.’”<sup>115</sup> Some said that they “wish[ed] to ‘live at large, and prey, like pikes, upon one another,’”<sup>116</sup> and that enclosure would “be the means of producing a number of additional useful hands for agricultural employment, by gradually cutting up and annihilating that nest and conservatory of sloth, idleness and misery, which is uniformly to be witnessed in the vicinity of all commons, waste lands and forests.”<sup>117</sup> Finally, in what was presumably the greatest slur that could be leveled at the time, advocates of enclosure contended that “Forests and great Commons . . . make the Poor that are upon them too much like the *Indians*” and are “a hindrance to Industry, and . . . nurseries of Idleness and Insolence.”<sup>118</sup>

But in addition to cries of trespass, the great enclosure was justified by appeal to the progress of agriculture through more expansive and intensive cultivation. Arguments prefiguring the contemporary idea of “economies of scale” abounded, as the advocates of enclosure promised increased efficiency in agriculture through new “capital farms”<sup>119</sup> and “merchant farms.”<sup>120</sup> As one pro-enclosure pamphleteer wrote: “If, by converting the little farmers into a body of men who must work for others, more labour is produced, it is an advantage which the nation . . . should wish for. . . . The produce being greater when their joint labours are employed on one farm. . . .”<sup>121</sup>

Their economic calculus, however, depended upon the (mis)characterization of the commons as empty and unproductive. Economists relentlessly assumed away the contributions of the small farmer cultivating arable lands in their calculus of “advantage to the nation.” One prominent advocate of enclosure criticized the notion that “depopulation” was underway, merely “because men are not seen wasting their labour in the open field.”<sup>122</sup> Political economists and agricultural writers largely focused on the benefits of enclosure and internal consolida-

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115. THOMPSON, *supra* note 92, at 163 (quoting W. PENNINGTON, REFLECTIONS ON THE VARIOUS ADVANTAGES RESULTING FROM THE DRAINING, INCLOSING AND ALLOTTING OF LARGE COMMONS AND COMMON FIELDS 32, 37 (1769)).

116. *Id.*

117. *Id.* (quoting VANCOUVER, GENERAL VIEW OF THE AGRICULTURE OF HAMPSHIRE (1810)).

118. *Id.* at 165 (quoting A. RUTH FRY, JOHN BELLERS, 1654-1725, at 128 (1935)).

119. See MARX, *supra* note 37, at 360.

120. See *id.* at 360.

121. *An Inquiry into the Connection between the Present Price of Provisions, &c.* (London, 1773), quoted in MARX, *supra* note 37, at 124, 129.

122. *Id.*

tion, and ignored the social costs so eloquently declaimed by Thomas More in *Utopia*.<sup>123</sup>

### C. Expropriation and Inequality

In any case, the illegal expansion of the large private estates into the common lands is only half the story. Alongside it came the expropriation of the agricultural population's ancient and venerable rights and privileges, both to the use of the commons for forage and pasture, and to the historic limitations on a "private" landowner's right to exploit his estate. The expropriation was twofold: besides the "the usurpation of the common lands," there was "the forcible driving of the peasantry from the land, to which the latter had the same feudal right as the lord himself."<sup>124</sup>

Some historians and economists subscribe to the proposition that the English peasant enjoyed a "golden age" before the enclosure movement, at least relative to the increasingly difficult conditions that would prevail during and after the massive expropriations of the yeomanry. According to those sources, at the end of the fourteenth century "the labourer . . . could live in plenty, and accumulate wealth."<sup>125</sup> The fifteenth century, in turn, was deemed "the golden age of the English labourer in town and country."<sup>126</sup>

The yeomanry, according to the Welsh philosopher and economist Richard Price, consisted of "a multitude of little proprietors and tenants, who maintain themselves and families by the produce of the ground they occupy, by sheep kept on a common, by poultry, hogs, etc., and who therefore have little occasion to purchase any of the means of subsistence."<sup>127</sup> The yeoman relied both upon ownership "of the piece of land attached to his house," and upon ownership of the commons in the form of "the usufruct to the common land, which gave pasture to their cattle, furnished them with timber, fire-wood, turf, &c."<sup>128</sup>

How was this collective exploitation of the common lands possible? What about the "tragedy of the commons"? Garret Hardin, oft-cited for the

123. See THOMAS MORE, *UTOPIA* 46-49 (Paul Turner trans., Penguin Books 1965) (1516) ("Sheep . . . [t]hese placid creatures, which used to require so little food, have now apparently developed a raging appetite, and turned into man-eaters. Fields, houses, towns, everything goes down their throats.").

124. MARX, *supra* note 37, at 356.

125. JAMES E. THOROLD ROGERS, *A HISTORY OF AGRICULTURE AND PRICES IN ENGLAND* 690 (1866), *quoted in* MARX, *supra* note 37, at 333.

126. *Id.*

127. DR. RICHARD PRICE, *2 OBSERVATIONS ON REVERSIONARY PAYMENTS* 159 (6th ed. London, W. Morgan 1803), *quoted in* MARX, *supra* note 37, at 360.

128. *Id.* at 356.

idea, in fact derived his analysis from early nineteenth-century English economists and "propagandists of parliamentary enclosure."<sup>129</sup> Hardin argues that just as a "rational herdsman" has no incentive to preserve common pasture, so as a matter of the "remorseless working of things, . . . [f]reedom in a commons brings ruin to all."<sup>130</sup>

The historian E.P. Thompson has shed some light on why the existence of the commons did not ruin the yeomanry. "Over time and over space," he writes, "the users of commons . . . developed a rich variety of institutions and community sanctions which . . . effected restraints and stints upon use."<sup>131</sup> Hardin's account, like so many others to follow, assumes a "common free-for-all"<sup>132</sup> where it "is to be expected that each herdsman will try to keep as many cattle as possible on the commons."<sup>133</sup> Historians, in glaring contrast to this stark image of a Hobbesian commons, describe "village by-laws" and other mechanisms that ensured "orderly village agricultural practices [in] medieval England."<sup>134</sup> A commons was thus defined by "common rights" to be "a tract of land subject to common rights of pasture except when in crop and then necessarily fenced against stray animals, kept several to the individual cultivators and debarred to all other commoners."<sup>135</sup> This account of orderly collective exploitation accords to some extent with Robert Ellickson's tentative hypothesis that repeat players in small, tight communities develop informal dispute resolution systems and "customary rules" that function as well as, or even better than, legal regimes.<sup>136</sup> These considerations, taken together, indicate just why the declaiming of commons as inveterate waste in England, resuscitated in America, is so grossly overstated.

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129. THOMPSON, *supra* note 92, at 107. See Garrett Hardin, *The Tragedy of the Commons*, 162 SCI. 1243 (1968). Incidentally, Hardin's thesis was "the necessity of abandoning the commons in breeding," of relinquishing "our present policy of laissez-faire in reproduction," for purposes of population control and by "Mutual Coercion Mutually Agreed Upon." *Id.* at 1243-48.

130. *Id.* at 1244.

131. THOMPSON, *supra* note 92, at 107.

132. *Id.* at 108.

133. Hardin, *supra* note 129, at 1244.

134. THOMPSON, *supra* note 92, at 108.

135. KERRIDGE, *supra* note 36, at 5. As a court in Gloucester held in one case, "a right of common cannot be altered without the consent of all parties concerned therein." THOMPSON, *supra* note 92, at 108 (quoting *Bruges v. Curwin*, 23 Eng. Rep. 974 (Ch. 1706)).

136. ROBERT C. ELICKSON, ORDER WITHOUT LAW: HOW NEIGHBORS SETTLE DISPUTES 283 (1991). See also *id.* at 1-11; Henry H. Perritt, Jr., *Dispute Resolution in Electronic Network Communities*, 38 VILL. L. REV. 349, 359-60 (1993).

To each of the enclosures of commons discussed above, there was a corresponding seizure of yeoman farmers' rights in the land: to till, to forage, to pasture, and eventually even to occupy a small plot in a meager dwelling as owner or feudal sub-tenant. As the commons was wrested from its rightful owners, the owners of the new "capital farms" embarked upon the next step in the great enclosure. The "dwellings of the peasants and the cottages of the labourers were razed to the ground or doomed to decay."<sup>137</sup> Those seeking to exercise rights in the common were "turned into vagabonds, and then whipped, branded, tortured by laws grotesquely terrible."<sup>138</sup>

At least one nineteenth century commentator found this massive expropriation to be an appalling violation of the rights of the small farmer. The Privy Council, a prestigious group of advisers to the crown, requested of its Medical Officer, one Dr. Simon, a report on the housing conditions of agricultural laborers in Britain. In his 1864 report, he identified as a major source of the deteriorating housing situation the fact that "[l]arge proprietors . . . have but to resolve that there shall be no labourers' dwellings on their estates, and their estates will thenceforth be virtually free from half their responsibility for the poor."<sup>139</sup>

The cottages and appertaining usufructs to communal property, Church lands, and Crown estates, were all enclosed within the new intensive "capital farms." In the end "agricultural labourers do not find on the soil cultivated by them even the spot necessary for their own housing."<sup>140</sup> One landowner described the result: "I look around and not a house is to be seen but mine. I am the giant of Giant Castle, and have eat up all my neighbours."<sup>141</sup>

As intensive capitalistic agriculture displaced the remnants of subsistence farming by a more or less self-sufficient class of yeomen, the latter were driven either into the role of agricultural wage laborers, or out of agriculture altogether and into the towns and manufacturing work. The anti-enclosure economist Dr. Price summarized the process:

[T]he little farmers will be converted into a body of men who earn their subsistence by working for others, and who will be under a necessity of going to market for all they want. . . . Towns

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137. MARX, *supra* note 37, at 356.

138. *Id.* at 365-66.

139. DR. SIMON, PUBLIC HEALTH, SEVENTH REPORT 9-14 (1865), *quoted in* MARX, *supra* note 37, at 338.

140. *Id.* at 361.

141. *Id.* at 343 n.1 (quoting Lord Leicester).

and manufactures will increase, because more will be driven to them in quest of places and employment. This is the way in which the engrossing of farms naturally operates.<sup>142</sup>

The results of enclosure were that “the place of the independent yeoman was taken by tenants at will, small farmers on yearly leases, a servile rabble dependent on the pleasure of the landlords.”<sup>143</sup>

The effects on the yeomanry, at least in the short term, were dire. The “golden age” for agricultural labor, in which a yeomanry rose out of serfdom,<sup>144</sup> gave way to a period where the buying power of agricultural labor decreased considerably.<sup>145</sup> According to Karl Marx, “the position of the English agricultural labourer from 1770 to 1780, with regard to his food and dwelling, as well as to his self-respect, amusements, &c., is an ideal never attained again since.”<sup>146</sup> In 1866, Dr. Rogers of Oxford would conclude that “‘the peasant has again become a serf,’ and a serf worse fed and worse clothed.”<sup>147</sup>

### III. RIGHTS AND UTILITIES IN COPYRIGHT HISTORY

Over the centuries, as we have seen, large landowners who desired to expand their holdings and exploit them more intensively employed a two-fold rhetorical strategy, based on natural right and utility, to liquidate customary and common rights. Thus were estates enlarged, both internally and externally.

History and present-day experience confirm that the conceptual and tactical structure of “land grabs” is not confined to real property, but extends to intellectual property as well. The relevant examples can be

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142. PRICE, *supra* note 127, at 159, *quoted in* MARX, *supra* note 37, at 360.

143. *Id.* Scattered farmers and artisans, consuming their own produce and trading for the produce of their brethren, were replaced by a mass of wage-laborers, constituting a “great market provided for by industrial capital.” *Id.* at 371. Centralization made intensive agriculture possible on a larger scale, intensive in “conscious technical application of science, the methodical cultivation of the soil,” and “the economizing of all means of production by their use as means of production of combined, socialized labor.” *Id.* at 378. The process therefore culminates in the “transformation of the individualized and scattered means of production into socially concentrated ones.” *Id.* This is primitive accumulation, the “prelude to the history of capital.” *Id.*

144. *See id.* at 333 n.4 (citing one Dr. Rogers).

145. *See id.* at 334 n.1 (quoting PRICE, *supra* note 127, at 159) (“The nominal price of day-labour is at present no more than about four times, or at most, five times higher than it was in the year 1514. But the price of corn is seven times, and of flesh-meat, and raiment about fifteen times higher.”).

146. *Id.* at 333.

147. ROGERS, *supra* note 125, at 693, *quoted in* MARX, *supra* note 37, at 336.

grouped into two categories: those that extend the duration of copyright, thus excluding the public from access to public domain works, and those that extend the scope of copyright, revoking the public's rights to make private and/or transformative uses of copyrighted material. Expansion of duration resembles the expansion of private estates to enclose external commons, while revocation of rights of access and transformation resembles internal expropriation. This Part will discuss these expansions first from a historical perspective, beginning with duration and then turning to scope, and second from a present-day perspective, in which questions of duration and scope are more conveniently grouped together. As William Fisher has recently argued, "the set of entitlements created by . . . [intellectual property] doctrines has grown steadily and dramatically from the eighteenth century to the present."<sup>148</sup> The remainder of this section will argue that censorship by copyright, even when the effects on social welfare are unknown or are clearly detrimental, has rapidly increased with time and continues to do so.

#### A. The Public Domain as Theft and Waste

The history of copyright duration vividly demonstrates the truth of Fisher's statement, as the term of copyright protection has been extended far beyond sensible limits, steadily encroaching upon the public domain. With each additional invasion of the public's rights to untrammelled use of what lies in the intellectual commons, we hear the same Lockean-Blackstonian refrain that justified the enclosures of communal lands, namely natural right and the common weal.

The history of attempts to enclose the intellectual commons demonstrates that the struggle between copyright holders and the public on the issue of copyright duration is as old as copyright itself. In England, the Stationer's Company, which enjoyed a total monopoly on printing through a royal charter of 1557, consistently maintained that copyright was perpetual.<sup>149</sup> They justified the eternalization of their monopoly with arguments that closely mirror the large landowners' claims that (1) they *already* owned as private property the common land that they stole, and (2) the refusal of their claims would wreck the agricultural economy.

The earliest rationales the Stationer's Company forwarded in support of its monopoly relied on its ability to restrain political and religious dissent, rather than on economic incentives. This position was in accord with

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148. William Fisher III, *The Growth of Intellectual Property: A History of the Ownership of Ideas in the United States* (Sept. 4, 1997) (<http://cyber.harvard.edu/metaschool/fisher/growth.html>). See also Lemley, *supra* note 4, at 894.

149. See ROSE, *supra* note 20, at 12.

the Royal Charter of the guild, which focused on concentrating the “art or mystery of printing” in the hands of those able to practice it responsibly, and stamping out the publications of “divers scandalous malicious schismatical and heretical persons.”<sup>150</sup> The Stationer’s Company employed a system of pre-publication censorship (or “licensing”) to secure their property rights and to fulfill their corollary statutory duty to prevent the printing and sale of “heretical schismatical blasphemous seditious and treasonable Bookes Pamphlets and Papers.”<sup>151</sup> The regime was very much oriented around “the regulation of public discourse” in the service of Church and State, and around the power to censor and destroy rather than the incentive to produce and disseminate.<sup>152</sup>

In response to public agitation against this censorship,<sup>153</sup> the Stationers mobilized new arguments, oriented around the reinvigorated doctrines of natural right and utility. The guild members, perhaps to defuse the attacks on their “mercenary” and monopolistic role in British publishing, began to introduce a new rhetoric about the sanctity of their property rights, and relied increasingly on consequentialist, incentive-based rationales for copyright protection. Nevertheless, their monopoly power was limited in 1641 by the collapse of licensing due to the abolition of the monopoly-enforcing Court of Star Chamber. As Mark Rose writes, this collapse meant that “anyone with access to a press, legal or surreptitious, could print.”<sup>154</sup> However, licensing was later reinstated, at least for a time.<sup>155</sup>

It would soon become clear how the propertization of copyright could detach the monopoly from service to the Crown or the public, and transform it into an abstract and reified eternal right. As early as 1666, the Sta-

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150. 1 A TRANSCRIPT OF THE REGISTERS OF THE COMPANY OF STATIONERS OF LONDON: 1154-1640, at xxviii, xxxi (Edward Arber ed., 1950), *quoted in* ROSE, *supra* note 20, at 12.

151. Licensing Act of 1662, 14 Car. 2 ch. 33 (Eng.).

152. *Id.* at 15. Thus, early entries in the Stationer’s Register often conveyed to its members a “license” or “*generall pardon*” from the Stationers’ own private police force and Court of Assistants, or the liberty to print without censorship. *Id.* at 14.

153. As early as 1644, John Milton decried the nefarious bargain through which the Crown secured religious intolerance and immunity from political dissent in exchange for granting the Stationers huge monopoly profits and near-complete control over the institution of printing in England. In his anti-licensing tract *Areopagitica*, he inveighs against the subordination of the learned author to a licenser “perhaps much his younger, perhaps far his inferior in judgment, perhaps one who never knew the labor of book-writing.” *Id.* at 28 (quoting John Milton, *Areopagitica* (1644), in JOHN MILTON: COMPLETE POEMS AND MAJOR PROSE 719 (Merritt Y. Hughes ed., 1957)).

154. ROSE, *supra* note 20, at 15.

155. *See id.* at 30-34 (describing passage of the Licensing Act of 1662, and its expiration in 1695).

tioners attempted to invalidate a royal grant of a patent to exclusively print law books, so that they could exploit that lucrative market. The Stationers argued that copyright, just like a landed estate, conveyed "the most absolute property" on its owner, and that the taking of the one is "equivalent to bereaving him of the other."<sup>156</sup> Therefore, they continued, it would be every bit as "prejudicial to deprive [the purchasers of a copyright] of the benefit of their Purchase, as to Disseise them of their Freehold."<sup>157</sup> Their argument thus equated the owner of a competing royal grant with a common trespasser plundering a lawful estate, and is one of the first examples of legal use of copyrighted work being recharacterized as theft.

In 1695 the Licensing Act expired, and in 1709 the London booksellers submitted a petition and endorsed a bill for a new type of copyright regime, one focused less on the unfashionable topic of censorship and more on the emergent Lockean rights-utility rationale for vigorous private property rights. The bill they petitioned for would "secur[e] to them the Property of Books, bought and obtained by them," and end the "Discouragement of all Writers in any useful Part of Learning" wrought by the free market in books.<sup>158</sup>

However, once parliamentarians suspicious of monopoly had begun to ask whether protection for a limited time was sufficient "encouragement," the booksellers rapidly backed away from such arguments. They vigorously reasserted their common law rights, based on reason and the law of nature, claiming that "if we have a Right for Ten Years, we have a Right for Ever."<sup>159</sup> The booksellers maintained that the author (and, of course, "his assigns"), was "the absolute Master of his own writings," and that "this Property is the same with that of Houses and other Estates."<sup>160</sup> As we shall see, later proponents of the elimination of the intellectual commons will similarly find utilitarian arguments easy to abandon in favor of rights-talk, should circumstances so require.

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156. Brief of appellants the Stationers in *The Case of the Booksellers and Printers Stated; with Answers to the Objections of the Patentee*, in ENGLISH PUBLISHING, THE STRUGGLE FOR COPYRIGHT, AND THE FREEDOM OF THE PRESS: THIRTEEN TRACTS 1666-1774 (Stephen Parks ed., 1975), quoted in ROSE, *supra* note 20, at 24.

157. *Id.*

158. 16 H.C. JOUR. 240, quoted in ROSE, *supra* note 20, at 42.

159. MORE REASONS HUMBLY OFFER'D TO THE HONOURABLE HOUSE OF COMMONS, FOR ENCOURAGING LEARNING AND FOR SECURING PROPERTY OF COPIES OF BOOKS TO THE RIGHTFUL OWNERS THEREOF (London, 1710), quoted in ROSE, *supra* note 20, at 44.

160. THE CASE OF THE BOOKSELLERS RIGHT TO THEIR COPIES, OR SOLE POWER OF PRINTING THEIR RESPECTIVE BOOKS, REPRESENTED TO THE PARLIAMENT (London, 1710), quoted in ROSE, *supra* note 20, at 44.

Opposition continued to mount among prominent thinkers and writers to the Stationers' hallowed idea of a perpetual copyright. In particular, Locke had decried the power of the Stationer's Company to deny licenses to, and prevent the printing of, new editions of ancient authors going back to Aesop,<sup>161</sup> arguing that such power was "very unreasonable and injurious to learning."<sup>162</sup> Locke's antipathy towards retroactive copyrights, at least as applied to the ancients, was echoed in the eighteenth century by Henry Fielding, who in his *Tom Jones* portrayed the "Antients" as "a rich Common, where every Person who hath the smallest Tenement in *Parnassus* hath a free Right to fatten his Muse."<sup>163</sup>

When Parliament passed the Statute of Anne in 1710,<sup>164</sup> it rejected the arguments of the booksellers that the first Copyright Act should merely confirm their perpetual common-law rights. The Statute departed in significant ways from the Act the booksellers had endorsed, in that it vested rights "in the Authors, or Purchasers, of such Copies," rather than in "the rightful Owners" of "Books," and only vested these rights "during the Times therein mentioned."<sup>165</sup> These statutory rights were thus limited in purpose and duration, rather than consecrating preexisting "natural" and hence eternal common-law rights.

The Statute of Anne's drafters provided for a fourteen-year term of protection, and a second term of the same length at the end of that for authors still living.<sup>166</sup> Nevertheless, the booksellers continued for decades to portray the use of public domain works as piracy and a violation of "the law of Reason and Nature."<sup>167</sup>

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161. See ROSE, *supra* note 20, at 33.

162. John Locke, *Memorandum* (1693), in PETER KING, *THE LIFE AND LETTERS OF JOHN LOCKE* 208-9 (London, 1884), *quoted in* ROSE, *supra* note 20, at 33.

163. HENRY FIELDING, *THE HISTORY OF TOM JONES* (Fredson Bowers ed., Wesleyan Univ. Press 1975) (1749), *quoted in* ROSE, *supra* note 20, at 116. Parnassus was, according to Greek legend, a mountain sacred to Apollo and the Muses, and hence representative of the arts.

164. Statute of Anne, 8 Anne ch. 19 (1710) (Eng.) [hereinafter Statute of Anne].

165. *Id.* at 46 (quoting original title, and as amended, 16 H.C. JOUR. 369).

166. See ROSE, *supra* note 20, at 47. Books already published as of April 10, 1710, when the act came into force, were to enjoy a fixed 21-year term of protection. *Id.* at 45.

167. ROSE, *supra* note 20, at 55 (quoting *A Letter from an Author to a Member of Parliament Occasioned by a Late Letter Concerning the Bill Now Depending in the House of Commons* (London, 1753)). Thus in 1735 the booksellers lobbied Parliament for a retroactive extension of copyright to a single 21-year term, a measure that would have preserved until 1756 their monopolies over the works of Shakespeare, Milton, and Locke. See *id.* at 52. The still monopoly-wary House of Lords, however, rejected this effort. See *id.* at 56.

The booksellers renewed their campaign for perpetual copyright in the courts. William Murray, later Lord Mansfield, argued as counsel on behalf of the London booksellers, and subsequently from the bench, that their claims to perpetual copyright must prevail because "it is just, that an author should reap the pecuniary profits of his own ingenuity and labour."<sup>168</sup>

Still, Mansfield did not neglect instrumental arguments for the enclosure of commons, in this case literary works whose term of protection under the Statute of Anne had expired. If works were ever allowed to fall into the public domain, he argued, then the author would "not only be deprived of *any* profit, but lose the expence he has been at."<sup>169</sup> Mansfield would later memorably state his dual argument for copyright:

[W]e must take care to guard against two extremes equally prejudicial; the one, that men of ability, who have employed their time for the service of the community, may not be deprived of their just merits, and the reward of their ingenuity and labour; the other, that the world may not be deprived of improvements, nor the progress of the arts be retarded.<sup>170</sup>

This quote is often treated as a precursor to modern attempts to strike a balance between desert/incentives on the one hand and access on the other.<sup>171</sup> Given Mansfield's support of perpetual copyright from the bench, however, one wonders whether he recognized any danger that "the progress of the arts [might] be retarded" by *over-protection*, as he had made crystal clear only his belief that underprotection would impede progress.

It was Blackstone himself who argued the case for the plaintiff booksellers. He basically applied his arguments for landed property to literary property, that any "thing of value" is and should be the "subject matter of property."<sup>172</sup> Later, in the second volume of his *Commentaries on the Laws of England*, Blackstone would seal his unified theory of landed and literary property by treating them both under the heading of "Title to Things Personal by Occupation."<sup>173</sup>

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168. *Millar v. Taylor*, 98 Eng. Rep. 201, 252 (K.B. 1769) (opinion of Lord Mansfield).

169. *Id.* (emphasis added).

170. *Cary v. Longman*, 102 Eng. Rep. 138, 140 (K.B. 1801) (quotations and citations omitted).

171. See, e.g., Joseph A. Lavigne, Comment, *For Limited Times? Making Rich Kids Richer Via the Copyright Term Extension Act of 1996*, 73 U. DET. MERCY L. REV. 311, 321 (1996).

172. ROSE, *supra* note 20, at 77.

173. *Id.* at 90.

Blackstone's and Mansfield's victory for perpetual copyright was to be undone by a House of Lords opposed to monopoly. In *Donaldson v. Becket*,<sup>174</sup> the Lords voted overwhelmingly to reverse a Chancery decision enjoining the reprinting of a public domain work, a decision that had been premised on Mansfield's theory of perpetual common-law copyright.<sup>175</sup> Later that year, the peers rejected yet another proposal for an additional fourteen years of copyright, a measure that had passed in the House of Commons.<sup>176</sup>

With the history of English copyright to *Donaldson* as important context, we turn to the history of the term of American copyright. The enumerated power of Congress, as defined by the Constitution, to secure to authors the exclusive rights to their writings, is restricted as to purpose, subject matter, beneficiaries, and duration.<sup>177</sup> The Copyright Clause effectively constitutionalized the rule announced in *Donaldson* that perpetual common-law copyright does not exist.<sup>178</sup> Later, the Copyright Act of 1790<sup>179</sup> provided for a 14 year term from the time of prepublication filing of a copy with the local United States District Court, and gave the author (and apparently only the author) the right to renew the right for an additional 14 years.<sup>180</sup> Thus, the work "fell" into the public domain after 14

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174. 98 Eng. Rep. 257 (H.L. 1774) (appeal taken from Eng.).

175. See ROSE, *supra* note 20, at 102.

176. One lord decried the proposal as "nothing but encouraging a Monopoly." *Id.* at 103. Despite these eighteenth century setbacks, however, the proponents of an extended copyright term in Britain became increasingly successful in overcoming anti-monopoly sentiment in the nineteenth and twentieth centuries, and the term stands today at the life of the author plus seventy years. See Council Directive 93/98/EEC of 29 October 1993 harmonizing the term of protection of copyright and certain related rights, art 1, 1993 O.J. (L 290).

177. U.S. CONST. art. I, § 8, cl. 8 ("To promote the Progress of Science and the useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."); see *Feist Publications v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991).

178. See ROSE, *supra* note 20, at 102-03 ("[W]hat the House of Lords did in *Donaldson v. Beckett* was . . . to declare by authority that copyright henceforth would be limited in term."). The vote of the peers was not accompanied by an opinion or other official rationale, thus it is unclear whether the vote was premised on the idea that no common-law copyright had ever existed, that it had existed but was preempted by the Statute of Anne, or, more likely, some mixture of these and other views. See *id.* at 102-03 & n.7. Whatever the reasoning, perpetual copyright was soundly rejected.

179. Act of May 31, 1790, § 1, 1 Stat. 124 ("An Act for the Encouragement of Learning, by securing the Copies of Maps, Charts and Books, to the Authors and Proprietors of such Copies, during the Times therein mentioned.").

180. See William F. Patry, *The Copyright Term Extension Act of 1995: Or How Publishers Managed to Steal the Bread From Authors*, 14 CARDOZO ARTS & ENT. L.J. 661,

years if the author died or failed to renew in time, and after 28 years if he or she lived and renewed the right.

While the Founding Fathers generally supported a copyright law premised on natural rights and instrumental arguments, this support was accompanied by a historical mistrust of monopoly, thought to be a source of innumerable inefficiencies and oppressions.<sup>181</sup> James Madison, among others, justified a limited copyright as being simultaneously just and useful. The committee designated by the Continental Congress to deal with the literary property question, of which Madison was a member, concluded in its report that “nothing is more properly a man’s own than the fruit of his study, and that the protection and security of literary property would greatly tend to encourage genius.”<sup>182</sup> Similarly, in a famous passage of *The Federalist Papers*, Madison sounds positively Blackstonian in declaring that: “The utility of the power will scarcely be questioned. The copyright of authors has been solemnly adjudged, in Great Britain, to be a right of common law. . . . The public good fully coincides . . . with the claims of individuals.”<sup>183</sup> Still, in drafting the Science and useful Arts Clause of the Constitution, Madison sought to balance the rights of authors, and the encouragement of writing, with the principle, widespread by that time, that “perpetual monopolies of every sort are forbidden . . . by the genius of free governments.”<sup>184</sup> Even those limited monopolies granted to authors and inventors must be “guarded with strictness against abuse.”<sup>185</sup>

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669-70 (1996). The author’s survivors and assigns might benefit from the renewal if the author died during the renewal period.

181. Anti-monopoly sentiment in the English Parliament was embodied in the Statute of Monopolies, and the Statute of Anne in turn applied the Statute of Monopolies’ term limitation to the author’s monopoly and provided for judicial review of and “redress” for the sale of books at prices “too high or unreasonable.” Statute of Anne, *supra* note 164, § 4. See Statute of Monopolies, 21 Jam., ch. 3, § 1 (1624) (Eng.); see also 2 SMITH, *supra* note 109, at 755 (arguing that monopolies amount to a tax on the public both in terms of “the high price of goods, which, in the case of free trade, they could buy much cheaper,” and of “their total exclusion [of competition] from a branch of business, which might be both convenient and profitable”).

182. William Patry, *The Failure Of The American Copyright System: Protecting The Idle Rich*, 72 NOTRE DAME L. REV. 907, 911 (1997) (quoting 24 J. OF THE CONTINENTAL CONG. 326 (1783)).

183. THE FEDERALIST NO. 43, at 270-71 (James Madison) (Clinton Rossiter ed., 1961). At least three of the former colonies had passed laws for the protection of literary property before the ratification, each of which contained preambles stating the same two-pronged rationale. See *Wheaton v. Peters*, 33 U.S. 591, 682-83 (1834) (Thompson, J., dissenting) (quoting preambles to the copyright laws of Massachusetts, Connecticut, and New York).

184. James Madison, *Monopolies, Perpetuities, Corporations, Ecclesiastical Endowments*, in *Aspects of Monopoly One Hundred Years Ago*, HARPER’S MAG., March

Thomas Jefferson eschewed any talk of natural or moral rights, favoring instead a careful balancing of the benefits of incentives with the acknowledged costs of monopolies. In 1788, he wrote to Madison that he favored a total constitutional ban on monopolies.<sup>186</sup> He took a more moderate stance in a subsequent letter, after he failed to secure protection from monopolies in the Bill of Rights, writing to Madison that he would have favored an amendment allowing monopolies “for a term not exceeding \_\_\_ years, but for no longer term, and for no other purpose.”<sup>187</sup> Jefferson filled in the blank with the span of a generation in his day, or 19 years, reasoning “that the earth belongs in usufruct to the living; that the dead have neither powers nor rights over it.”<sup>188</sup> His circumspection would come under gradual but sustained assault over the next two centuries of American copyright jurisprudence.

Since 1790, the term of copyright in America has expanded ever onward, albeit in fits and starts. In response to the pleas of Noah Webster in particular, Congress made two changes to the term of copyright in 1831.<sup>189</sup> First, the original term was doubled to twenty-eight years; and second, the renewal provision was altered so that the author’s spouse or children could renew even in case of the author’s death.<sup>190</sup> The victory of copyright expansionists was muted, however, as within three years of that Act’s passage, the Supreme Court squarely rejected a claim that perpetual copyright was carried over from English common law and survived the Constitution.

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1914, at 490 (published posthumously). This essay, and many other sources regarding the intent of the Framers as to copyright and freedom of speech, are discussed in Timothy Phillips’ voluminously researched draft brief, *The Unconstitutionality of the Copyright Term Extension Act of 1998* (visited January 10, 2000) (<http://www.public.asu.edu/~dkarjala/constitutionality/phillips02.html>).

185. Madison, *supra* note 184, at 490.

186. “The saying there shall be no monopolies lessens the incitements to ingenuity, which is spurred on by the hope of a monopoly for a limited time, as of 14 years; but the benefit even of limited monopolies is too doubtful to be opposed to that of their general suppression.” Letter from Thomas Jefferson to James Madison of July 31, 1788, in 13 *The Papers of Thomas Jefferson* 442-43 (Julian P. Boyd ed., 1956).

187. Letter from Thomas Jefferson to James Madison of Aug. 1789, in 5 *THE WORKS OF THOMAS JEFFERSON* 493 (Paul L. Ford ed., 1904).

188. Thomas Jefferson, quoted in *Liber: Jefferson and the Copyright Monopoly* (visited Apr. 8, 2000) (<http://users.vnet.net/alight/jefferson.html>).

189. See Patry, *supra* note 180, at 670. Noah Webster had also been influential in persuading both individual American states and the likes of James Madison and George Washington of the necessity for copyright in the pre-Constitutional period, in hopes of maintaining his monopoly over his popular English grammar. See Irah Donner, *The Copyright Clause of the U.S. Constitution: Why did the Framers Include it with Unanimous Approval?*, 36 *AM. J. LEGAL HIST.* 361, 370-74 (1992).

190. See Patry, *supra* note 180, at 670.

In *Wheaton v. Peters*,<sup>191</sup> the plaintiff, a publisher of reports of Supreme Court cases, marshaled a powerful combination of rights- and incentive-based rationales in his attempt to recharacterize aspects of intellectual commons as acts of theft. Plaintiff's counsel argued first that, unlike a patent, which amounted to a mere "legalized monopoly," copyright was founded in "natural right,"<sup>192</sup> and second that the plaintiff would have lacked the incentive to "have spent half a year or more in making and publishing these reports, if he had supposed he had not the copyright."<sup>193</sup> The Court rejected these arguments, confirming the "statutory monopoly theory of copyright"<sup>194</sup> in its holding that copyright "does not exist at common law," and that "Congress, then, by [the Copyright Act of 1790], instead of sanctioning an existing right, as contended for, created it."<sup>195</sup>

Attempts to extend copyright duration received new momentum in the early twentieth century. In 1906, a copyright bill before Congress would have extended the term to life of the author plus fifty years. Lobbying was intensive, as prominent artists, musicians, and writers appeared before Congress to press their cause. Mark Twain appears to have made a particular impression. His speech evoked many of the London booksellers' favorite themes: the moral necessity of perpetual copyright, the analogy to real estate, and the recharacterization of the limits of a state-sanctioned monopoly as simple theft.<sup>196</sup>

In the end, Congress extended copyright duration to a 28-year initial term followed by a 28-year renewal term.<sup>197</sup> Curiously enough, the rejection of a "life-plus" term was prompted not only by concern for the fate of the public domain, but also out of solicitude for authors themselves, who

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191. 33 U.S. 591 (1834).

192. *Id.* at 598.

193. *Id.* at 614.

194. See L. Ray Patterson, *Folsom v. Marsh and its Legacy*, 5 J. INTELL. PROP. L. 431, 442 (1998).

195. *Wheaton*, 33 U.S. at 663.

196. Twain recounted appearing before the House of Lords on the matter of copyright duration and testifying that the only appropriate limit would be "Perpetuity." After first analogizing literary property with real estate, Twain forwarded the heart of his argument with rare frankness, that any limit to the copyright monopoly, and by extension the continued existence of a public domain, would legalize theft. Noting that the Constitution set limits to the duration of copyright, Twain recalled that "earlier Constitution, which we call the decalogue," which "says you shall not take away from any man his profit. . . . What the decalogue really says is, 'Thou shalt not steal,' but I am trying to use more polite language." Mark Twain, *Copyright*, in MARK TWAIN, SPEECHES 314, 315 (Oxford University Press, 1996).

197. Copyright Act of 1909, 35 Stat. 1075 (1909).

might not want to renew the term if the work was unsuccessful.<sup>198</sup> Thus, the turn of the century push for a vastly extended if not perpetual copyright on the part of publishers and some authors was partially deflected by considerations of the public domain. It achieved no more than a 14-year extension of the renewal term established by the 1834 Act, and on terms distinctly unfavorable to publishers and other assignees.

The most important expansion of the copyright term occurred with the passage of the Copyright Act of 1976, providing a powerful example of the persistent dominance of the dual rights-utility argument for increased privatization and a diminished commons. It was actually the last in a series of retroactive extensions by Congress of the "limited" term of 28 years (56 with a renewal) available to authors under the 1909 Copyright Act.<sup>199</sup> Together, these extensions made certain that except for the three years in which the 1998 Sonny Bono Copyright Term Extension Act ("CTEA")<sup>200</sup> was being debated, virtually nothing in twentieth century America entered the public domain, at least where the authors were attentive to their rights. As a result, "1961 was the last time copyrighted work that had been renewed fell into the public domain," work which was "originally authored in 1905."<sup>201</sup>

A barrage of rationales was offered for the switch from a term of 56 years, split by renewal, to one of life plus 50 years for individuals and of 75 years from publication for corporate "authors."<sup>202</sup> Natural rights rhetoric was prominent as ever, surfacing in the legislative history on several

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198. Renewal was deemed to be a useful "device for adjusting the term in accordance with the commercial value of the work, so that 'undeserved or undesired extensions of term' would not be conferred upon those 'hundreds of thousands of copyrights of no pecuniary value to the owners.'" R. Anthony Reese, Note, *Reflections On The Intellectual Commons: Two Perspectives on Copyright Duration and Reversion*, 47 STAN. L. REV. 707, 717 (1995) (quoting Arguments Before the Committees on Patents of the Senate and House of Representatives, Conjointly, on the Bills S. 6330 and H.R. 19853, to Amend and Consolidate the Acts Respecting Copyright, 59th Cong., 1st Sess. 183 (1906) (letter of Charles W. Ames, representing United Typothetae of America)).

199. See Pub. L. No. 87-668 (1962); Pub. L. No. 89-142 (1965); Pub. L. No. 90-141 (1967); Pub. L. No. 90-416 (1968); Pub. L. No. 91-147 (1969); Pub. L. No. 91-555 (1970); Pub. L. No. 92-170 (1971); Pub. L. No. 92-566 (1972); Pub. L. No. 93-573 (1974); Pub. L. No. 94-533 (1976).

200. See discussion *infra* Part VI.A.

201. Memorandum in Support of Plaintiffs' Motion for Judgment on the Pleadings or, in the Alternative, for Summary Judgment and in Opposition to Defendants' Motion for Judgment on the Pleadings, at 11, *Eldred v. Reno*, 74 F.Supp.2d 1 (D.D.C. 1999) (No. 99CV00065), available at [http://cyber.law.harvard.edu/eldredvreno/sj\\_memo.pdf](http://cyber.law.harvard.edu/eldredvreno/sj_memo.pdf) (PDF file) [hereinafter "Eldred Memorandum"].

202. See Reese, *supra* note 198, at 718.

occasions. One rationale for the expansion was “to insure an author and his dependents the fair economic benefits from his works,” especially given the increase in life expectancy since the 1909 Act.<sup>203</sup> Similarly, members of Congress adopted as a *per se* moral principle that “copyright should extend beyond the author’s lifetime,” and that therefore “the present term of 56 years is too short.”<sup>204</sup>

A series of other rationales focused on the economic and utilitarian benefits of the change.<sup>205</sup> These benefits included the simplicity of a single term, the costs of renewal formalities, and harmonization with other countries’ life-based terms, particularly after the U.S. entered the Berne Convention in 1989.<sup>206</sup> Incentive-based arguments persisted, despite the increasing improbability that revenue materializing after an already-distant 56 years could motivate or inspire,<sup>207</sup> and the absurdity of applying such arguments to retroactive extensions.<sup>208</sup>

Most importantly, Congress concluded that all of these instrumental benefits could be achieved at virtually no cost, maintaining that “too short a term harms the author without giving any substantial benefit to the public.”<sup>209</sup> This refusal in American copyright debates to grapple with the costs of a diminished public domain demonstrates the pernicious influence that classical theory has exerted over the debates. The costs that arise have

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203. *Id.* (quoting H.R. REP. NO. 94-1476, at 134 (1976)).

204. *Id.* (quoting H.R. REP. NO. 94-1476, at 135). Another fairness- or rights-based rationale was the need to compensate authors for preemption of common law rights in unpublished works. *See id.*

205. *See id.*

206. *See id.*

207. As Macaulay said in opposition to Britain’s enactment of a “life plus” copyright duration, “an advantage that is to be enjoyed more than half a century after we are dead by somebody, we know not whom, perhaps by somebody unborn . . . is really no motive at all to action.” T.B. MACAULAY, WORKS 199 (Trevelyan ed. 1879), *quoted in* Eldred Memorandum, *supra* note 201, at 38. *See also* Stephen Breyer, *The Uneasy Case for Copyright*, 84 HARV. L. REV. 281, 350 (1970) (concluding that pre-1976 maximum copyright term of 56 years was already “too long” in economic terms); Affidavit of Hal Varian in Support of Plaintiffs’ Motion for Judgment on the Pleadings or, in the Alternative, for Summary Judgment and in Opposition to Defendants’ Motion for Judgment on the Pleadings at 3, *Eldred v. Reno*, 74 F. Supp. 2d 1 (D.D.C. 1999) (No. 99-CV00065), *available at* (<http://cyber.law.harvard.edu/eldredvreno/varian.pdf>) (PDF file) (applying economic principles discounting net present value of future income streams, and concluding that “the value of investment returns after 50 years . . . [is] miniscule” and thus “has a tiny effect on the present economic incentives to invest in creative works”).

208. *See* Eldred Memorandum, *supra* note 201, at 27 (“Congress cannot now magically expand the incentives that authors faced in 1923.”); *id.* at 39 (“Incentives work forward. Retrospective term extensions look backward.”).

209. Reese, *supra* note 198, at 718 (quoting H.R. REP. NO. 94-1476, at 134 (1976)).

been exhaustively described by William Fisher<sup>210</sup> and Glynn Lunney,<sup>211</sup> among others,<sup>212</sup> and include the economic costs of foregone consumer surplus, due to higher prices and outright denials of access, and the administrative costs of licensing, paperwork, and federal litigation (an expensive proposition at any time but particularly so in the case of copyright).<sup>213</sup> Moreover, term extension works considerable costs to freedom of expression, a point to which I shall return. The legislative discourse surrounding the 1976 Act provides a powerful example of how the debate over copyright regulation is dominated by time-honored Lockean-Blackstonian rhetoric, an approach that dismisses the commons as barren and lauds enclosure as an untarnished good.

## B. Fair Use as Piracy and Market Failure

In discussing the history of the expansion of copyright scope, I will focus on two broad axes. The first axis deals with the expansion of the definition of copyright infringement, which had originally referred to unauthorized multiplying of copies, to encompass literal copying of smaller and smaller fragments of a work, a process that perhaps reached its nadir in *Harper & Row Publishers v. Nation Enterprises*.<sup>214</sup> The second axis of expansion deals with the expansion of the notion of copyright infringement to include nonliteral as well as literal copying, and even to the copying of only a nonliteral part of a work—such as a character or scene. Not unsurprisingly, each new incursion into the commons, and each corresponding revocation of public rights, has been justified by the providential Blackstonian “connection of justice and human felicity.”<sup>215</sup>

During the nineteenth century and into the twentieth, copyright infringement has expanded from only the unauthorized reprinting of a work to include unauthorized literal copying of some sufficient part of a work, and finally to include unauthorized copying of the nonliteral elements of a

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210. See William W. Fisher III, *Reconstructing the Fair Use Doctrine*, 101 HARV. L. REV. 1659, 1669-72 (1988).

211. See Glynn S. Lunney, Jr., *Reexamining Copyright's Incentives-Access Paradigm*, 49 VAND. L. REV. 483, 655 (1996).

212. See, e.g., Dennis S. Karjala, *The Term of Copyright*, in GROWING PAINS: ADAPTING COPYRIGHT FOR EDUCATION AND SOCIETY 33, 38-39 (Laura N. Gasaway ed., 1997).

213. For example, Borland International incurred more than \$20 million in attorneys fees and costs in its litigation with the Lotus Development Corporation over the “look and feel” of a pull-down menu for spreadsheet software. See *Lotus Development Corp. v. Borland International, Inc.*, 140 F.3d 70, 72, 76 (1st Cir. 1998) (denying prevailing defendant Borland’s request for attorneys fees and costs).

214. 471 U.S. 539, 558 (1985).

215. 1 BLACKSTONE, *supra* note 19, at \*40.

work. Under the 1831 Copyright Act, like the 1790 Act and Statute of Anne before it, the copyright holder possessed only “the sole right and liberty of printing, reprinting, publishing, and vending” the work.<sup>216</sup> As Alfred Yen has noted, these early statutes “adopted a very limited view of infringement.”<sup>217</sup> One commentator complained that even in 1870s America “all property in books is confined in its enjoyment to a limited period of years, while even for this period it is protected only scantily.”<sup>218</sup>

Abridgments, which are condensed versions of another’s work with perhaps some new additions, enjoyed broad protection. The right of “fair abridgement” was endorsed by all four justices sitting in the much-publicized case of *Millar v. Taylor*,<sup>219</sup> decided in 1769 by the Court of King’s Bench, the highest common-law court in England, and by some of the most prominent British jurists, including Lord Mansfield, an avowed champion of authorial rights.<sup>220</sup> In the 1830s even the plaintiff in *Wheaton* recognized this right of fair abridgement, but denied that the defendant’s case reporter qualified.<sup>221</sup> Early American copyright cases acknowledged

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216. Copyright Act of February 3, 1831, 4 Stat. 436-39.

217. Alfred C. Yen, *Restoring the Natural Law: Copyright as Labor and Possession*, 51 OHIO ST. L.J. 517, 534 n.119 (1990).

218. Arthur Sedgwick, *International Copyright by Judicial Decision*, THE ATLANTIC MONTHLY, Feb. 1879, at 217-30.

219. See *Millar v. Taylor*, 98 Eng. Rep. 201 (K.B. 1769).

220. The court in *Stowe v. Thomas*, 23 F. Cas. 201 (C.C.E.D. Pa. 1853) (No. 13,514), ably summarized the law of copyright scope as the Framers understood it:

An author, says Lord Mansfield, has the same property in his book, which the king has to the English translation of the Bible. “Yet if any man should turn the Psalms, or the writings of Solomon, or Job, into verse, the king could not stop the printing or sale of such a work. It is the author’s work; the king has no power or control over the subject-matter. His power rests in property. His whole right rests upon the foundation of property in the copy.” Mr. Justice Willes, in answer to the question, “Wherein consists the identity of a book?” says, “Certainly, bona fide imitations, translations and abridgments are different, and in respect of property, may be considered new works.” And Mr. Justice Aston observes: “The publication of a composition does not give away the property in the work. But the right of copy still remains in the author. No more passes to the public from the free will and consent of the author, than unlimited use of every advantage that the purchaser can reap from the doctrine and sentiments which the work contains. He may improve it, imitate it, translate it, oppose its sentiments; but he buys no right to publish the identical work.”

*Id.* at 207 (quoting *Millar*, supra note 219 (respective opinions of Chief Justice Lord Mansfield, Justice Richard Aston, and Justice Edward Willes)).

221. See *Wheaton v. Peters*, 33 U.S. 591, 651 (1834) (“An abridgement fairly done, is itself authorship, requires mind; and is not an infringement, no more than another work

that a “real, substantial condensation” of a work was “not a piracy” provided that “intellectual labor and judgment [was] bestowed thereon.”<sup>222</sup>

In 1841, however, Justice Joseph Story, a disciple of Blackstone like his friend John Marshall,<sup>223</sup> would expand infringement to include unauthorized copying of portions of a work, contravening the intent of Congress as expressed in the statutory language of the 1790 and 1831 Copyright Acts.<sup>224</sup> In *Folsom v. Marsh*, Story enjoined the publication of defendant’s book, *The Life of Washington in the Form of an Autobiography*, on the ground that 388 out of its 866 pages, consisting of “writings, correspondence, messages, addresses, and other papers” of George Washington, were copied from the plaintiff’s authorized work.<sup>225</sup> Not surprisingly, natural rights rhetoric peppered his decision.<sup>226</sup> However, incentive-based arguments also played an important part. Justice Story’s opinion asked, rhetorically, who “would undertake to publish, at his own risk and expense, any such papers . . . if, the moment they were successful . . . a rival bookseller might republish them, either in the same, or in a cheaper form, and thus either share with him, or take from him the whole profits?”<sup>227</sup>

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on the same subject. . . . The [defendant’s] Condensed Reports have none of the features of an abridgement, and the work is made up of the same cases, and no more than is contained in Wheaton’s Reports.”).

222. *Folsom v. Marsh*, 9 F. Cas. 342, 345 (C.C. Mass. 1841) (No. 4,901).

223. Justice Story wrote a three volume series of *Commentaries on the Constitution of the United States*, in which he quotes so many passages from Blackstone’s *Commentaries* that he may have been liable for infringement under *Folsom* or *Harper & Row*, had not Blackstone’s work been in the public domain due to the 1790 Copyright Act’s reservation of its protections to U.S. citizens. See generally JOSEPH STORY, COMMENTARIES ON THE CONSTITUTION OF THE UNITED STATES (Cambridge, Brown, Shattuck & Co. 1833).

224. Both of those statutes had copied the language of the Statute of Anne, which had always been interpreted to restrict infringement liability to the act of reprinting something close to the “identical work.” See Patterson, *supra* note 194, at 441.

225. *Folsom*, 9 F. Cas. at 342.

226. See *id.* at 348 (“None are entitled to save themselves trouble and expense, by availing themselves, for their own profit, of other men’s works, still entitled to the protection of copyright.”); *id.* at 349 (“The entirety of the copyright is the property of the author; and it is no defence, that another person has appropriated a part, and not the whole, of any property.”). Story said upon acceding to his professorship at Harvard Law School that the lawyer’s “most glorious and not infrequently perilous duty” was to salvage the “sacred rights of property” from the “rapacity” of the majority’s redistributive impulses. JOSEPH STORY, DISCOURSE UPON THE INAUGURATION OF THE AUTHOR AS DANE PROFESSOR OF LAW, 1829 (Cornell Law School Collection), quoted in Elizabeth Mensch, *History of Mainstream Legal Thought*, in THE POLITICS OF LAW 14 (David Kairys, ed., 1990).

227. *Folsom*, 9 F. Cas. at 347.

Story's expansion of copyright compelled him to articulate the right of "fair abridgment" or "fair use" more elaborately than American courts had done before. If he had not done so, the opinion would have been precedent that even a short quotation in a book review or commentary would be illegal.<sup>228</sup> Perhaps even the plaintiff in *Folsom* would have been guilty of infringement by quotation, and have deserved denial of relief under the equitable doctrine of unclean hands.<sup>229</sup> So Story set down as a rule that a later author "may fairly cite largely from the original work, if his design be really and truly to use the passages for the purposes of fair and reasonable criticism."<sup>230</sup> To distinguish "fair" from unfair quotation, he laid out a number of factors (quantity, effect on market, etc.) that have become familiar in fair use jurisprudence.<sup>231</sup>

The scope of copyright protection has expanded even further since the *Folsom* decision, to arguably preclude all but the most trivial uses of copyrighted work.<sup>232</sup> The Supreme Court would demonstrate how little protection fair use currently provides to transformative users in *Harper & Row, Publishers, Inc. v. Nation Enterprises*.<sup>233</sup> In that case, an article in *The Nation Magazine* that quoted some 300 words from Gerald Ford's biography (itself over 200,000 words long) was held to infringe Ford's copyright.<sup>234</sup> The article used Ford's own words to discuss his pardon of Nixon, his relations with Reagan and Kissinger, and his policy on the bombing of

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228. *Cf. Emerson v. Davies*, 8 F. Cas. 615, 619 (C.C.D. Mass. 1845) (No. 4,436) (Story, J.) ("In truth, in literature, in science and in art, there are, and can be, few, if any, things, which, in an abstract sense, are strictly new and original throughout. Every book in literature, science and art, borrows, and must necessarily borrow, and use much which was well known and used before. . . . If no book could be the subject of copy-right which was not new and original in the elements of which it is composed, there could be no ground for any copy-right in modern times.").

229. *See Folsom*, 9 F. Cas. at 347.

230. *Id.* at 344.

231. *Id.* ("In short, we must often, in deciding questions of this sort, look to the nature and objects of the selections made, the quantity and value of the materials used, and the degree in which the use may prejudice the sale, or diminish the profits, or supersede the objects, of the original work.").

232. For an extreme example, "sampling" even a few notes of music has been held infringing, frustrating the emerging genres of rap, pastiche, and postmodern music. Ground-breaking records by resource-poor artists like John Oswald (who agreed to a settlement) and Negativland have been enjoined and destroyed for forays into a "copy and paste" aesthetic. *See* David Gans, *The Man Who Stole Michael Jackson's Face*, WIRED, Feb. 1995, at 136; *see generally* NEGATIVLAND, FAIR USE: THE STORY OF THE LETTER U AND THE NUMERAL 2 (1995).

233. 471 U.S. 539, 558 (1985).

234. *See id.* at 569.

Cambodia. Ford was at the time of publication a potential candidate in the 1980 presidential election.<sup>235</sup>

The majority opinion in *Harper & Row* seamlessly weaves together rights-based and utility-based arguments. It first notes the incentive for authors, that granting copyright protection to those who “who write and publish factual narratives” ensures that “they may at least enjoy the right to market the original expression contained therein as just compensation for their investment.”<sup>236</sup> The opinion turns quickly, however, to the public interest: “The monopoly created by copyright thus rewards the individual author in order to benefit the public.”<sup>237</sup> The result, at least at first glance, is a somewhat confused combination of various arguments for copyright. As we have seen, however, it stands solidly within the discourse of proper-tarian theory since Locke.

In rejecting *The Nation*'s (and dissenting Justice Brennan's<sup>238</sup>) argument that the public interest supported wide dissemination of Ford's views, the Court marshaled a barrage of economic arguments.<sup>239</sup> In a significant footnote, the Court cited “[e]conomists who . . . believe the fair use exception should come into play only in those situations in which the market fails or the price the copyright holder would ask is near zero.”<sup>240</sup> According to this reasoning, where “a fully functioning market exists, permitting fair use to displace normal copyright channels disrupts the copyright market without a commensurate public benefit.”<sup>241</sup> This argument constitutes an invitation to copyright holders to ask for prices greater than zero for virtually any use (and thus eliminating fair use), to aggressively prosecute even private and non-profit uses, and to invent methods of collecting fees for each and every use, no matter how trivial (such as reading more than once, loaning to a friend, copying small sections, etc.).

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235. *See id.* at 590.

236. *Id.* at 556-57 (emphasis added).

237. *Id.* at 546.

238. *See id.* at 579 (Brennan, J., dissenting) (“[T]his zealous defense of the copyright owner's prerogative will, I fear, stifle the broad dissemination of ideas and information copyright is intended to nurture. Protection of the copyright owner's economic interest is achieved in this case through an exceedingly narrow definition of the scope of fair use.”).

239. 471 U.S. 539, 558 (“In our haste to disseminate news, it should not be forgotten that the Framers intended copyright itself to be the engine of free expression. By establishing a marketable right to the use of one's expression, copyright supplies the economic incentive to create and disseminate ideas.”).

240. *Id.* at 568 n.9 (citing T. Brennan, *Harper & Row v. The Nation, Copyrightability and Fair Use*, Dept. of Justice Economic Policy Office Discussion Paper 13-17 (1984); Wendy Gordon, *Fair Use as Market Failure: A Structural and Economic Analysis of the Betamax Case and its Predecessors*, 82 COLUM. L. REV. 1600, 1615 (1982)).

241. *Id.* (internal quotation marks omitted).

At the same time, and in classical fashion, this interpretation of copyright law assumes away the “commensurate public benefits” of not requiring a license for fair use of a work. The benefits that the Court might have discussed include cheaper access, broader distribution, less censorship (it is noteworthy that *The Nation* is a left-leaning periodical and Ford a former Republican president), lower transaction costs, less litigation, and reduced administrative costs. Instead, the Court followed Locke, Blackstone, the Stationers, and countless others in deeming that a conclusory public goods argument, with regard to incentives, self-interest, and rational economic actors, was sufficient to bar the plaintiff’s use. Again, the benefits of limiting enclosures are discarded as illusory or irrelevant.

The second axis along which copyright scope has been expanded concerns nonliteral similarity. One early opinion illustrates how far we have come. In *Stowe v. Thomas*,<sup>242</sup> the court rejected Harriet Beecher Stowe’s claim that a German translation of Uncle Tom’s Cabin infringed the copyright in the book. Restating the standard for copyright infringement that had prevailed from Queen Anne’s time to that of Justice Story, the court declared that the “author’s exclusive property in a literary composition or his copyright, consists only in a right to multiply copies of his book, and enjoy the profits therefrom, and not in an exclusive right to his conceptions and inventions, which may be termed the essence of his composition.”<sup>243</sup> The court also focused on the transformation embodied in defendant’s translation, saying that translation often requires “more learning, talent and judgment, than was required to write the original.”<sup>244</sup> In language unthinkable today, the court concluded that “[b]y the publication of Mrs. Stowe’s book, the creations of the genius and imagination of the author have become as much public property as those of Homer or Cervantes. [Uncle Tom and Topsy are as much *publici juris* (of public right) as Don Quixote and Sancho Panza.]”<sup>245</sup>

The *Stowe* court’s reasoning, sympathetic as it was to the public’s right to make use of intellectual property, soon came under attack. The court in *Daly v. Palmer* relied upon Justice Story’s trilogy of copyright cases to hold that it is the “quality” rather than the “quantity” of what is taken that matters, and that the “adaptation of [a] series of events to different charac-

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242. 23 F. Cas. 201 (C.C.E.D. Pa. 1853) (No. 13,514).

243. *Id.* at 207 (emphasis added).

244. *Id.* Doubtless the same could be said of a great many allegedly infringing transformative works.

245. *Id.* at 208 (second set of brackets in original) (parentheses added).

ters who use different language” is a “piracy.”<sup>246</sup> The court accompanied its moral denunciation of the defendant with the canonical economic rationale that free-riding is the ruination of cultural production. The analysis was naturally conducted without reference to the inhibitive and censorial effects, or increased transaction and administrative costs, posed by such a rule.<sup>247</sup>

Copyright scope has expanded so far in the direction of nonliteral protection that the court’s reasoning in the *Stowe* decision would today be considered anathema to the very core of copyright. Derivative rights, extending far beyond the limits on literal appropriation, have found increasing favor with courts and legislatures.<sup>248</sup> Since Judge Learned Hand’s decision in *Nichols v. Universal Pictures Corp.*,<sup>249</sup> even paraphrasing and imitation have been disfavored as fair uses, because otherwise a “plagiarist would escape [liability] by immaterial variations” of the work.<sup>250</sup> Today’s derivative rights are “so expansive that they allow a copyright owner to assert control over works that have little resemblance with her work and that have little effect on economic prospects of her work.”<sup>251</sup>

As a result, protection from nonliteral copying of phrasings, characters, plots, and scenes has become almost as important as protection from fragmented literal copying. The plot and characters of a Stephen King or Michael Crichton novel are likely to be far more valuable than the mere words. The short animated film *Steamboat Willie* is of negligible value in comparison to the image of the character it introduced to the world: Mickey Mouse.

### C. Explaining Copyright Expansion: The Rhetoric and Economics of Real Property

With the benefit of this brief overview, we may reflect upon the reasons for such marked expansions in copyright term and scope. One prominent school of thought on the subject attributes the trend to the “continuing

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246. *Daly v. Palmer*, 6 F. Cas. 1132, 1138 (C.C.S.D.N.Y. 1868) (No. 3552) (infringement premised on copying of scene in which villain ties victim to railroad tracks, to be foiled again by hero at the last moment).

247. See Naomi Abe Voegtli, *Rethinking Derivative Rights*, 63 BROOK. L. REV. 1213, 1236 n.127 (1997).

248. See Paul Goldstein, *Derivative Rights and Derivative Works in Copyright*, 30 J. COPYRIGHT SOC’Y 209, 217 (1983); Voegtli, *supra* note 247, at 1234-39 (collecting numerous statutory and judicial sources).

249. 45 F.2d 119 (2d Cir. 1930).

250. *Id.* at 121; see, e.g., *Sid & Marty Krofft Television Prods. v. McDonald’s Corp.*, 562 F.2d 1157 (9th Cir. 1977).

251. Voegtli, *supra* note 247, at 1268.

grip on the legal imagination” of the “full-blown Romantic conception of ‘authorship,’” which devalues collective creative endeavor and effaces the inevitable reliance of writers and others on prior sources and a common cultural heritage.<sup>252</sup> In a recent essay, Mark Lemley criticizes this account, claiming that it explains neither the contours of copyright law at the present, nor its development over time. Regarding the extension of terms and proliferation of rights, he questions whether “authorship has gotten more romantic over time.”<sup>253</sup> With regard to other recent changes in the law, Lemley argues that the doctrines of work-for-hire and assignment heavily favor corporate “authors” over starving artists, and that the expansive rights available to “initial creators” to censor what are often far more creative “transformative improvers,” are contrary to what the romantic author theory would predict.<sup>254</sup>

By contrast to what he therefore believes to be a failed theory, Lemley argues that the increase in the duration of copyright protection, and in the uses that it prohibits, is attributable primarily to the fact that “the rhetoric and economic theory of real property are increasingly dominating the discourse and conclusions of the very different world of intellectual property.”<sup>255</sup> On the side of rhetoric, he argues that the “property rights” view of copyright has achieved an unprecedented hegemony in recent years. He notes that the widespread use of the term “intellectual property” itself is a relatively recent phenomenon,<sup>256</sup> and that courts are with increasing frequency foregoing nuanced analysis of the hard questions in intellectual property law in favor of the sort of earthy moralisms that inevitably favor copyright plaintiffs.<sup>257</sup> He associates this rise of property rhetoric, and the galloping advance of ownership entitlements, with the particular economic

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252. Peter Jaszi, *Toward a Theory of Copyright: The Metamorphoses of “Authorship,”* 1991 DUKE L.J. 455, 463. See also JAMES BOYLE, SHAMANS, SOFTWARE, AND SPLEENS: LAW AND THE CONSTRUCTION OF THE INFORMATION SOCIETY 51-60 (1996).

253. Lemley, *supra* note 4, at 22. This is a particularly telling argument given that the authors of the eighteenth and nineteenth centuries, when protection was short and thin, so to speak, cut a rather more romantic figure than those of the commercialized and trivialized present.

254. See *id.* at 885-88.

255. *Id.* at 895.

256. See *id.* at 895-96. Since the foundation of the World Intellectual Property Organization in 1967, Lemley notes, the ABA section on Patent, Trademark, and Copyright Law has changed its name to the ABA Section on Intellectual Property Law. See *id.* at n.123.

257. See *id.* at n.126. Lemley’s example is *Grand Upright Music Ltd. v. Warner Bros. Records, Inc.*, 780 F. Supp. 182, 183 (S.D.N.Y. 1991), in which the court resolved the novel issue of music sampling as a fair use by recourse to that “earlier Constitution,” as Twain called it, which declares, “thou shalt not steal.”

view that “emerges from the Chicago School law-and-economics movement,”<sup>258</sup> a view which “emphasizes the importance of private ownership as the solution to the economic problem known as the ‘tragedy of the commons.’”<sup>259</sup>

The question remains whether this trend, and the expansion in the copyright monopoly that has accompanied it, is attributable to the persistence of romantic authorship or the rise of Chicago-style economic analysis. Framed this way, however, the question presents a bit of a false dichotomy. After all, given the history of English thinking on property and copyright, we might ask of Lemley a question analogous to the one he puts to authorship theory, namely has the commons gotten more tragic over time? Not since Hobbes and Locke, certainly. As property theorists, these philosophers stand near the beginning of the line of discourse critical of the commons on the grounds that no one is “liable for the consequences of her own actions,” a line that continues through the very economists from whom Hardin derived his tragically evocative turn of phrase.<sup>260</sup> The problem of bolstering private incentives with property-based expectations in the future was hardly invented by the Chicago School out of whole cloth. Romantic authorship should be understood in this context, as a crucial buttress to natural rights arguments for expanded copyright. By effacing the moment of collectivity in cultural production, it makes the labor of authors seem all the more arduous and awe-inspiring. By casting transformative users in the role of talentless hacks, it mobilizes the taboo against plagiarism in support of exclusive authorial rights. And by sustaining the impression that copyright is never “a zero-sum game,” that “there is always ‘enough and as good’ left over,”<sup>261</sup> it papers over the costs of constricting the public domain and narrowing the rights of imitation and appropriation.

#### IV. CONTEMPORARY MOVEMENTS TOWARDS ENCLOSURE OF THE INTELLECTUAL COMMONS

The frequent characterization of anyone who makes unauthorized use of a once-copyrighted work as a “pirate” is the Information Age analogue to the equation of peasants exercising their rights in the common with

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258. *Id.* at 897

259. *Id.*

260. *Id.* Indeed, the point can be traced as far back as Aristotle, who remarked of Plato’s proposal of raising children in common that “[w]hat belongs in common . . . is accorded the least care,” and that parents would “slight them on the grounds that someone else is taking thought for them.” ARISTOTLE, *THE POLITICS* 57 (Carnes Lord trans., Univ. of Chicago Press 1984).

261. BOYLE, *supra* note 252, at 57.

highwaymen. Meanwhile, the old “tragedy of the commons” argument has been resuscitated for application to the Global Information Infrastructure, on which anarchy is said to prevail. The Lockean vision of common lands as waste, and the Stationers’ view of unlicensed printing as waste, are revived in the contemporary propertarian discourse that surrounds the regulation of cyberspace, as we shall see in this Part.

The ongoing copyright grab, which is being carried out on many fronts and which will set the ground rules for speech in the Information Age, shares the conceptual and tactical structure of the Great Enclosure of English common lands and of the efforts of the Stationers and others to revoke public rights in the intellectual commons. The current struggle to transform limited rights in expression to rights of perpetual duration and near-absolute scope is taking place on four broad fronts. The first is outright extension of copyright duration. The second is extra-legal copyright adjudication by Internet Service Providers (“ISPs”). The third is implementation of technological locks to protect content from appropriation in perpetuity (and the legal protection of such locks). The fourth is the transformation, via the Uniform Computer Information Transactions Act (“UCITA”), of sales of copyrighted works, currently governed by the public law of copyright and governed by courts, into licenses for the use of those works, strictly limited in duration and scope by standard form contract language and seamlessly implemented by mechanisms of technological self-help.

Just as the “ancient and venerable rights” secured by the peasants in their long struggle against the feudal landlord were mere theft in the eyes of a rising bourgeoisie claiming the absolute rights of exclusion, so the public’s traditional rights to the public domain and fair use are now being dismissed as mere piracy. Determined to more intensively and efficiently exploit their holdings, the copyright industries will simply dispense with these rights. Once the public has been forcibly driven from the informational commons, the rising class of copyright conglomerates will usher in an age of Blackstonian absolutism in the realm of speech.

#### **A. The Public Domain: Of “Legal Piracy” and “Orphan Works”**

The Sonny Bono Copyright Term Extension Act (“CTEA”),<sup>262</sup> signed into law on October 27, 1998, retroactively extends the term of copyright to life plus 70 years, or to 95 years for corporate authors. Whereas Mickey Mouse’s copyright would have expired in 2003, Pluto’s in 2006 and Goofy’s in 2008, Disney’s monopoly on each of these characters will now

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262. Pub. L. No. 105-298, Title I, 112 Stat. 2827 (1998) (codified in scattered sections of 17 U.S.C.); *see, e.g.*, 17 U.S.C. § 302.

last another 20 years.<sup>263</sup> Taking up the mantle of the Stationers, et al., are those media corporations whose most bankable characters and works are nearing the end of their current statutory terms of protection.

The movement toward the CTEA gained impetus following the GATT Treaty's mandate for retroactive protection of foreign works that had fallen into the U.S. public domain. These provisions were later used to justify U.S. copyright extension in the name of "harmonization" and "reciprocity."<sup>264</sup> Another innovation in Blackstonian discourse, and its criminalization of the intellectual commons, arose during lobbying for these GATT measures, as the falling of foreign works into the public domain was dubbed "legal piracy . . . a calamity that need not occur."<sup>265</sup> Further testimony also equated the public domain with theft, alleging that the passage of copyrights into the public domain constituted a "not insignificant portion" of foreign acts of "piracy" that purportedly cost U.S. industries \$2 billion in 1993 alone.<sup>266</sup>

At the same time as access to the public domain has been criminalized under the umbrella of "piracy," the ancient Lockean theme of commons as waste has been revitalized with a vengeance. For example, proponents of the 1998 extension argued that, contrary to what "[s]ome academics" may believe, it is false that with shorter terms "more public domain works would find wider circulation at cheaper prices."<sup>267</sup> As evidence, it is noted that the "theater ticket remains the same price" and that "video stores give no discounts to the public" for public domain works.<sup>268</sup> This is as valid an

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263. See Dennis Karjala, *Mouse Droppings*, WASH. POST, Oct. 15, 1998, available at (<http://www.public.asu.edu/~dkarjala/commentary/WashPost10-15-98.html>).

264. "Europe would not guard American works beyond the American term limit" without retroactive protection of European works. *The Copyright Term Extension Act of 1995: Hearing on S. 483 Before the Senate Comm. on the Judiciary*, 104th Cong. 41 (1995) (statement of Jack Valenti, Chairman and Chief Executive Officer, Motion Picture Association) [hereinafter Valenti CTEA Statement].

265. *General Agreement on Tariffs and Trade (GATT): Intellectual Property Provisions: Joint Hearing on H.R. 4894 and S. 2368 Before the Subcomm. on Intellectual Property and Judicial Admin. of the House Comm. on the Judiciary and the Subcomm. on Patents, Copyrights and Trademarks of the Senate Comm. on the Judiciary*, 103d Cong. 257 (1994) (statement of Jack Valenti, President and Chief Executive Officer, Motion Picture Association of America).

266. *Copyright Restoration and Other Matters: Joint Hearing on H.R. 4894 and S. 2368 Before the Subcomm. on Intellectual Property and Judicial Admin. of the House Comm. on the Judiciary and the Subcomm. on Patents, Copyrights and Trademarks of the Senate Comm. on the Judiciary*, 103d Cong. 244 (1994) (statement of Eric H. Smith, Executive Director, International Intellectual Property Alliance).

267. Valenti CTEA Statement, *supra* note 264, at 42.

268. *Id.*

argument as that of Locke and other advocates of enclosure that because some of the common lay in waste, common lands as such were waste. Just because oligopolistic movie theater chains sometimes fail to offer discounts does not mean that public domain works are destined to remain the same price regardless of medium or decade. Witness the proliferation of public domain works of literature and philosophy on the World Wide Web, from the ancient Greeks to Shakespeare to Kant. Joyce's *Ulysses* and Eliot's *The Waste Land*, to cite just two examples, are freely accessible on the Web less than two years after entering the public domain in 1998.<sup>269</sup> Evidence of dramatic reductions in the costs to local orchestras desiring to perform classical music pieces, once they fall into the public domain, also demonstrates that a work's passing into the public domain may benefit consumers.<sup>270</sup>

Proponents of extension further argue that "[a] public domain work is an orphan," and that "[w]hatever work is not owned is a work that no one protects and preserve[s]."<sup>271</sup> This is the yet another invocation of long-standing, and dubious, "tragedy of the commons" argument. The wide availability of the works of Shakespeare demonstrates that public domain works need not fall into obscurity. In the case of copyrighted examples of early cinema, many copyright holders are not making use of or maintaining old films, and by allowing the film stock to deteriorate may be erasing the works forever; there is evidence that copyright extension would even further "reduce the ability of archivists and film distributors to restore and distribute old films."<sup>272</sup>

Perhaps advocates of the public domain need a concept of "tragedy of the enclosure."<sup>273</sup> Otherwise, it seems that extensions like the 1998 Act,

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269. See JAMES JOYCE, *ULYSSES* (1922), available at <http://www.bibliomania.com/Fiction/joyce/ulysses/>; T. S. ELIOT, *THE WASTE LAND* (1922), available at <http://www.bartleby.com/201/>. For copyright information on these and many other "subverted" and "near miss" public domain texts, see Dennis Karjala, *Some Famous Works and Year of First Publication (Subverted Public Domain List)* (visited Mar. 8, 2000) (<http://www.public.asu.edu/~dkarjala/publicdomain/PDlist.html>).

270. See letter from Randolph P. Luck, President, Luck's Music Library, to Senator Spencer Abraham, June 28, 1996, available at <http://www.public.asu.edu/~dkarjala/letters/Luck'sMusic01.html>.

271. Valenti CTEA Statement, *supra* note 264, at 42.

272. Letter from Larry Urbanski, Chairman of the American Film Heritage Association, to Senator Strom Thurmond, March 31, 1997, available at <http://www.public.asu.edu/~dkarjala/letters/AFH.html>.

273. Analogous arguments have been made by Carol Rose, speaking of the "comedy of the commons." See Carol Rose, *The Comedy of the Commons: Custom, Commerce, and Inherently Public Property*, 53 U. CHI. L. REV. 711 (1986), and by Michael A.

which Peter Jaszi has dubbed a “down payment on perpetual copyright on the installment plan,”<sup>274</sup> will continue at regular intervals, justified each time with the language of natural rights (and its counterpart, the public domain as piracy) and utility (and its counterpart, the public domain as waste). The probability that any works published recently will enter the public domain in most of our lifetimes approaches zero, and is rather low even for works published as long ago as the 1940s.

The public’s reversionary interest in most twentieth-century works is functionally non-existent. The coalition of Internet publishers that signed on to the complaint in *Eldred v. Reno*, a case filed to challenge the constitutionality of CTEA, argued that a copyright term of life plus seventy years violates the Constitutional requirement that protection be “for limited Times.”<sup>275</sup> Some arguments in favor of their position are marshaled in Part V below.

## **B. ISP Liability: Private Copyright Police and Erring on the Side of Caution**

The second main front along which copyright protection is expanding at present is ISP liability. The drafting of service providers as “copyright police”<sup>276</sup> endangers public rights in the intellectual commons, although the danger may be greater regarding fair use rights than rights in the public domain. This trend began with isolated yet disturbing court decisions,<sup>277</sup> and received its major impetus from the Report of the Working Group on

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Heller, referring to the “tragedy of the anticommons.” See Michael A. Heller, *The Boundaries of Private Property*, 108 YALE L.J. 1163 (1999).

274. Peter Jaszi, *Caught in the Net of Copyright*, 75 OR. L. REV. 299, 303 (1998) (internal quotation marks omitted).

275. See First Amended Complaint, *Eldred v. Reno*, 74 F.Supp.2d 1 (No. 99-CV00065) (D.D.C. 1999), available at <http://cyber.law.harvard.edu/eldredvreno/complaint.html>; see also *United Christian Scientists v. First Church of Christ*, 829 F.2d 1152, 1169 (D.C. Cir. 1987) (stating that even if a copyright of a duration of around 150 years is not a “copyright in perpetuity,” it at least “purports to confer rights of unprecedented duration”).

276. Samuelson, *supra* note 10, at 188.

277. See *Playboy Enters., Inc. v. Frena*, 839 F. Supp. 1552, 1559 (M.D. Fla. 1993) (holding BBS operator directly liable for enabling subscribers to distribute and display copies of photographs); *Sega Enters., Ltd. v. MAPHIA*, 857 F. Supp. 679, 687 (N.D. Cal. 1994) (granting preliminary injunction against BBS operator for direct and contributory copyright infringement for soliciting and enabling subscriber’s uploading and downloading of video games); cf. *Religious Tech. Ctr. v. Netcom*, 907 F. Supp. 1361 (N.D. Cal. 1995) (rejecting theory that defendant ISP directly infringed copyrights in written works by distributing and displaying them, but finding that genuine issues of fact existed as to whether failure to delete postings after receiving notice of potential infringement grounded contributory liability, and as to whether Netcom’s role constituted fair use).

Intellectual Property Rights (the “White Paper”).<sup>278</sup> That document advocated “maintaining” what it described as the current state of the law on ISPs—namely, strict liability.<sup>279</sup> ISPs would then have the incentive to “react promptly and appropriately to notice by copyright owner that infringing material is available on their systems,” and implement technological protections, such as tracking mechanisms.<sup>280</sup>

The White Paper refused to consider the possibility that copyright owners might overreach and demand “prompt reaction” to public domain material or fair uses. Numerous copyright plaintiffs have pursued meritless claims through years of litigation and heavy financial costs in hopes of a broader monopolistic privilege or censorial prerogative than the law grants.<sup>281</sup> It stands to reason that the same parties will hardly shy from a little bad publicity stemming from enforcement sweeps demanding the deletion of web sites, even where premised on bogus claims of infringement.

The White Paper, under the rubric of “response to notice of infringement,” lumped together the complex policy questions of how ISPs should be forced to resolve two competing legal claims: one by the copyright holder that infringement is occurring, and the other by the putative infringer that only legal activity is at issue.<sup>282</sup> James Boyle has noted that ISPs would be induced to violate privacy, and to curtail “fair use rights so as to make sure that no illicit content was being carried.”<sup>283</sup> Indeed, the White Paper encouraged ISPs to do so, effectively interpreting fair use out of existence.<sup>284</sup>

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278. INFORMATION INFRASTRUCTURE TASK FORCE, INTELLECTUAL PROPERTY AND THE NATIONAL INFORMATION INFRASTRUCTURE: THE REPORT OF THE WORKING GROUP ON INTELLECTUAL PROPERTY RIGHTS (1995) [hereinafter WHITE PAPER].

279. *See id.* at 114-24.

280. *Id.* at 124.

281. *See, e.g.,* Universal City Studios, Inc. v. Nintendo Co., 615 F. Supp. 838, 862 (S.D.N.Y. 1985) (holding that Universal had sought in bad faith to enjoin Nintendo from shipping Donkey Kong on grounds that it infringed King Kong, after having threatened large legal costs in settlement negotiations).

282. *See* WHITE PAPER, *supra* note 278, at 122 (it would “encourage intentional and willful ignorance” to allow ISPs to refuse to disconnect “subscribers who break the law,” or in other words, alleged infringers).

283. James Boyle, *Foucault in Cyberspace* (visited Mar. 10, 2000) (<<http://www.wcl.american.edu/pub/faculty/boyle/foucault.htm>>). *See also* Samuelson, *supra* note 10, at 188-90.

284. *See* Samuelson, *supra* note 10, at 188-90; compare WHITE PAPER, *supra* note 278, at 73-82 (interpreting precedent to state that any harm to an actual or “potential” market for a use will “in most cases” invalidate defense of fair use) with *Sony Corp. v. Universal Studios, Inc.*, 464 U.S. 417 (1984) (holding that plaintiffs, in suits for contribu-

The Clinton administration officials who drafted the White Paper, failing to achieve passage of their proposed bill, sought to include strict liability for ISPs in the 1996 WIPO Copyright Treaty.<sup>285</sup> A letter from copyright law professors to the Patent and Trademark Office echoes Boyle in expressing concern that strict liability encloses large swaths of public domain material and alienates the rights of the public to fair use access and transformation. As the law professors put it: "Over-expansive liability would inhibit free speech while attempts to police this requirement by the providers themselves would undermine privacy and access and subject fair use to the conservative interpretation of a private body."<sup>286</sup> But the treaty passed without the recommended free speech protections against excesses by copyright plaintiffs.

The White Paper Task Force glosses over such concerns, focusing instead on the evils of theft and the utility of the broadest possible rights. The White Paper suggests that ISPs "educat[e] their subscribers about infringement"<sup>287</sup> as part of a "comprehensive program" to teach consumers about the overall rightness and utility of "seeking permission" from copyright holders, and why they should "just say yes" to pervasive licensing schemes.<sup>288</sup> At early grades, such a program was to include educating children about the need to pay for intellectual property by means of an analogy to a playmate stealing one's pencil,<sup>289</sup> yet again treating physical and intellectual property rights as though they are identical.

The White Paper similarly weighs in with the kind of conclusory public goods analysis that typically accompanies radical movements towards

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tory infringement of copyright premised on manufacture of copy equipment, must show that the equipment is not capable of substantial noninfringing use) *and* *Sega Enter. Ltd. v. Accolade, Inc.* 977 F.2d 1510 (9th Cir. 1992) (holding that Accolade's disassembly of Sega's object code for purposes of interoperability of game cartridges was fair use).

285. See WIPO Copyright Treaty Art. 8, available at (<http://www.wipo.int/eng/diplconf/distrib/94dc.htm>) ("Right of Communication to the Public: . . . authors of literary and artistic works shall enjoy the exclusive right of authorizing any communication to the public of their works, by wire or wireless means, including the making available to the public of their works in such a way that members of the public may access these works from a place and at a time individually chosen by them."); Gregory Alexander et al., *Letter from 50 Law Professors to USPTO Against WIPO Treaty* (visited Oct. 7, 1998) (<http://www.public-domain.org/copyright/law-profs.html>) (criticizing the WIPO right of communication, arguing that this "new exclusive right of communication to the public apparently subjects online service providers to strict liability for copyright infringement").

286. Alexander et al., *supra* note 285.

287. WHITE PAPER, *supra* note 278, at 134.

288. *Id.* at 226.

289. See *id.* at 224.

privatization and enclosure.<sup>290</sup> The exclusive focus on the incentive effects of rewarding authors tends to justify expanding protection indefinitely, until the full social value of a work is captured at whatever the cost. The questionable proposition that ISPs—“and perhaps only they—are in a position to know the identity and activities of their subscribers and to stop unlawful activities,”<sup>291</sup> goes unaccompanied by the equally vital consideration that they, and perhaps only they, are in a position to wrongfully delete public domain or fair use materials, and to summarily revoke the Internet access of those who post such materials.

The Digital Millennium Copyright Act (“DMCA”),<sup>292</sup> passed by Congress in October of 1998, embodies a compromise between ISPs and the large content providers to the effect that ISPs will not be strictly liable for their role as an automatic conduit between Internet publishers and the browsing public.<sup>293</sup> Service providers shall, nevertheless, be threatened with liability for information that they “store”<sup>294</sup> if, upon notice of a copyright holder’s “good faith belief”<sup>295</sup> that infringement is occurring, they do not “respond expeditiously to remove, or disable access to, the material that is claimed to be infringing or to be the subject of infringing activity.”<sup>296</sup>

One wonders how much of a “compromise” this actually represents. Were ISPs even in a strict liability regime really going to be able to control “everything users do,” a feat requiring “continuous monitoring of user

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290. *See id.* at 7-15.

While, at first blush, it may appear to be in the public interest to reduce the protection granted works and to allow unfettered use by the public, such an analysis is incomplete. Protection of works of authorship provides the stimulus for creativity, thus leading to the availability of works of literature, culture, art and entertainment that the public desires and that form the backbone of our economy and political discourse. If these works are not protected, then the marketplace will not support their creation and dissemination, and the public will not receive the benefit of their existence or be able to have unrestricted use of the ideas and information they convey. . . . [A] legal free-for-all would transform the [Global Information Infrastructure] into a veritable copyright Dodge City. As enticing as this concept may seem to some users, it would hardly encourage creators to enter its confines.

*Id.* at 14-15.

291. WHITE PAPER, *supra* note 278, at 117 n. 377 and accompanying text.

292. Digital Millennium Copyright Act, Pub. L. No. 105-304, 112 Stat. 2860 (1998) (codified in scattered sections of 17 U.S.C.).

293. *See* 17 U.S.C. § 512 (Supp. IV 1998).

294. *Id.* § 512(c).

295. *Id.* § 512(c)(3)(A)(v).

296. *Id.* § 512(c)(1)(C).

accounts” for anything that copyright owners might not like?<sup>297</sup> Such a regime would have entailed the legal review of “trillions of bits representing millions of messages and files.”<sup>298</sup> An expeditious and probably disproportionate response to anything that is claimed to infringe copyrights seems to have been the real aspiration of the copyright industries all along.

In any case, adjudication of copyright disputes by profit-oriented service providers occurring “in the private realm, far from the scrutiny of public law” has perhaps the most sweeping potential to curtail legal rights of free expression and fair use of any of the ongoing enclosures of speech.<sup>299</sup> But these speech- and access-related concerns were largely ignored, obscured by the fog of anti-theft and public goods rhetoric that dominated the legislative debate.

### C. Copyright Plus I: Anti-Circumvention Legislation

On the third major front of the enclosure movement, the legal framework is very nearly in place for extending the duration and scope of the copyright monopoly via some combination of mass-market licensing and technology backed by anti-circumvention prohibitions. Appearing in their usual rhetorical roles are the sanctity of rights, the iniquity of trespass, the fragile incentive to produce, and the devastation that, according to enclosure proponents, inevitably accompanies common or public rights, regardless of century or context.

Some have argued that the legal limits to copyright may be avoided by means of so-called “trusted systems.”<sup>300</sup> Mark Stefik, one of the most prominent architects of these systems, describes them as strings of computer code that can “specify terms and conditions for using a digital work

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297. Samuelson, *supra* note 10, at 188.

298. WHITE PAPER, *supra* note 278, at 116. A coalition of telephone, computer, and online service companies made this argument in opposition to the attempt to get strict liability in the WIPO treaty, explaining that “[j]ust like the postal service cannot (and indeed should not) monitor the contents of all the envelopes it handles, it is simply not possible for an infrastructure provider to monitor whether the millions of electronic messages it transmits daily have been authorized.” Pamela Samuelson & John Browning, *Confab Clips Copyright Cartel*, WIRED, Mar. 1997, at 61, 63.

299. Dave Powell’s Copyright Control Services has developed “fast-track” relationships with 1,000 ISPs across the globe: “We’re into 5,000 sites shut down in a year. . . . [A]s long as you act quickly, we aren’t even interested in suing.” Chris Oakes, *Stamping Out Pirated Tunes*, WIRED NEWS, Jan. 29, 2000 (<http://www.wired.com/news/mp3/0,1285,33940,00.html>); see also BOYLE, *supra* note 252, at 10.

300. See, e.g., LAWRENCE LESSIG, CODE, AND OTHER LAWS OF CYBERSPACE 127-30 (1999). See also the various writings of Lawrence Lessig on this topic collected at (<http://cyber.harvard.edu/~lessig>).

in an agreement between a publisher and a consumer.”<sup>301</sup> As the recent *ProCD v. Zeidenberg*<sup>302</sup> case shows, software and content publishers will hardly be inclined to adopt terms that limit their ability to make money or control the reception of their works, as the right to copy after a certain date obviously does and as the right to copy for public purposes is believed to do.

Soon these unilateral “terms” will be enforceable through a panoply of technological locks that will enable content owners to 1) restrict access to a picture or article on a pay-per-view basis; 2) deny the ability to copy even small portions of a work, even for non-profit scholarly or educational purposes; and 3) track any and all references to and uses of a work in cyberspace. None of these technological measures need comply with limits on copyright duration or scope, and from this technological fact arises the legal problem of absolute and perpetual protection of digital works. As Lessig notes, such systems could and perhaps are already being deployed to curtail our ability to copy and paste fragments of copyrighted material, including presidential speeches and battlefield reports, into critical and transformative works.<sup>303</sup> In other words, the “loss of fair use is a consequence of the perfection of trusted systems.”<sup>304</sup>

The general public will be defenseless against such encroachments upon its rights in the intellectual commons. The tiny minority who possess the ability to circumvent technological protections, to defend rights to the public domain and to fair uses, prompted the DMCA’s prohibition on circumvention technologies. The anti-circumvention provisions of the DMCA impose civil and criminal liability on those helping consumers hack trusted systems. Specifically, the DMCA makes it a felony to manufacture, import or distribute “devices, products, components,” and to perform acts “that defeat technological methods of preventing unauthorized use.”<sup>305</sup> Furthermore, the DMCA prohibits noncompliance with technical copyright management systems, specifically for intentionally removing

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301. Mark Stefik, *Round Two: Response; Roundtable; Life, Liberty, Copyright?*, ATLANTIC UNBOUND, (visited Apr. 27, 2000) (<http://www.theatlantic.com/unbound/forum/copyright/stefik2.htm>).

302. See *ProCD, Inc. v. Zeidenberg*, 86 F.3d 1447 (7th Cir. 1996) (holding that non-republication clause in license for a directory of public domain phone numbers on a CD was enforceable).

303. See LESSIG, *supra* note 300, at 128.

304. *Id.* at 137.

305. 17 U.S.C. § 1201 (Supp. IV 1998).

copyright management information,<sup>306</sup> and for providing or distributing false information.<sup>307</sup>

The Digital Future Coalition (“DFC”), an organization of academics, librarians, and concerned members of the technology industry, characterized this new anti-circumvention provision, section 1201 of the DMCA, as an epochal enclosure of the public domain, both in terms of duration and scope. A representative of the group testified before Congress that the provision “allow[s] copyright owners to ‘lock up’ public domain materials.”<sup>308</sup> On the matter of scope, Peter Jaszi, a founding member of the DFC, expressed the concern that:

[A]n electronic information vendor who wished to restrict the ability of readers, viewers and listeners to comment negatively on its products could use technological protection measures backed up with the threat of legal sanctions against circumvention to frustrate such criticism, even though the copyright doctrine of “fair use” authorizes the use of quotations from protected works for this purpose.<sup>309</sup>

Because “a defense to copyright infringement is not a defense to the prohibition,”<sup>310</sup> the expiration of the statutory term of copyright or the fairness of a use will likely be irrelevant to copyright holders and courts. Uncompromising anti-circumvention laws thus permit copyright holders to expand their rights to encompass every conceivable use for an indefinite period of time.

The lobbying for the DMCA employed the classic strategies of lumping legal and illegal activity together as theft. The Creative Incentive Coalition, the lobbying arm of the large software and media corporations for the DMCA, produced an informational CD-ROM and mounted an ad

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306. Copyright Management Information includes the name of the author and copyright owner, the terms of use, and anything else the Register of Copyrights proclaims should qualify. See 17 U.S.C. § 1202 (Supp. IV 1998).

307. See *id.*

308. *WIPO Copyright and Phonograms Treaties: Hearing on H.R. 2281 Before the Subcomm. on Courts and Intellectual Property of the House Judiciary Comm.*, 105th Cong. 243 (1997) (testimony of the Digital Future Coalition, presented by Douglas Bennett, President, Earlham College), available at <http://www.dfc.org/issues/wipo/benhos.html>).

309. *WIPO Copyright and Phonograms Treaties: Hearing on H.R. 2281 Before the Senate Foreign Relations Comm.*, 105th Cong. (1998) (testimony of the Digital Future Coalition, presented by Peter Jaszi, Professor of Law, Washington College of Law, The American University).

310. Jonathan Band, *The Digital Millennium Copyright Act* (visited Apr. 24, 2000) (<http://www.dfc.org/issues/wipo/JP-Index/JP-Memo/jb-memo.html>).

campaign along precisely these lines.<sup>311</sup> Jon Newcomb, President and CEO of Simon & Schuster, wrote a reply in response to Samuelson's "copyright grab" article<sup>312</sup> on behalf of the CIC, arguing that content creators would provide work for the Internet only if they could be assured that users could not "hijack" or "digitally burglarize[]" their work, or engage in "online looting."<sup>313</sup> Coalition members argued before Congress that any attempt to preserve public rights would entail "crippling amendments," and rejected out of hand efforts to amend the law so that "liability under section 1201 require proof . . . of an act of copyright infringement"; that "liability under section 1201 . . . be made subject to the copyright defense of fair use"; or that the distribution of anti-circumvention technology "be excused if it is proven to have a substantial non-infringing use."<sup>314</sup> A proposed right to circumvent for the purpose of obtaining access to "public domain materials" was equated with the "right to break and enter" or "pick locks," for example, in an attempt to snatch the Declaration of Independence from the National Archives.<sup>315</sup>

The language of the White Paper presaged much of the rhetoric of the DMCA debate, representing the rejection of trusted systems as an invitation to a legal free-for-all on the Internet, a "copyright Dodge City"<sup>316</sup> from which the determined settler would be driven by marauding copyright outlaws. To avert this vast wasteland brought on by piracy, the White Paper favored absolute control by IP owners over their property, arguing that

[c]reators and other owners of intellectual property rights will not be willing to put their interests at risk if appropriate systems . . . are not in place to *permit them to set and enforce the terms and conditions* under which their works are made available in the

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311. See Avant Digital, *Clients: The Creative Incentive Coalition*, (visited Apr. 16 2000) ([http://www.morgana.de/avant/html/body\\_cic.html](http://www.morgana.de/avant/html/body_cic.html)) (Users of the CD-ROM "can tour pirated web sites, watch testimonials of content creators and read about the impact of copyright industries on the U.S. economy.").

312. See Samuelson, *supra* note 10.

313. Jon Newcomb, *Rants and Raves: The Copyright Grab Bag*, WIRED, Apr. 1996, at 30 (letter to the editor).

314. *WIPO Copyright Treaties Implementation Act: Hearing on H.R. 2281 Before the Subcomm. on Courts and Intellectual Property of the House Comm. on the Judiciary*, 105th Cong. 57 (1998) (statement of Steven J. Metalitz on behalf of the Motion Picture Association of America).

315. *Id.* at 208 (statement of Allan R. Adler Vice President for Legal and Governmental Affairs Association of American Publishers).

316. WHITE PAPER, *supra* note 278, at 15.

NII environment. . . . All the computers . . . in the world will not create a successful NII, if there is no *content*.<sup>317</sup>

The economic benefits of anti-circumvention legislation are in this way magnified to the extent that without it the public will have no access to “literature, culture, art, and entertainment” whatsoever. The only restrictions on public access or transformative uses that are recognized are those that flow from underprotection, essentially assuming away the costs of overprotection.<sup>318</sup> This argument seems overstated even considering an all or nothing choice about copyright protection; it is ludicrous as applied to the choice between present levels of protection and additional controls via legally enforced mechanisms of technological protection.

The Creative Incentive Coalition took up these economic themes in its lobbying campaign for the DMCA. As the CIC’s representative testified before Congress, section 1201 would “benefit every Internet user who wants to see the network employed to make available a richer selection of movies and other audiovisual materials—as well as other copyrighted works.”<sup>319</sup> Serendipitously, these benefits would be unequivocal and attainable at no cost, for the “only parties it will hurt are those who wish to go into the business of disseminating the means to hack through [trusted systems] so that valuable intellectual property can be stolen.”<sup>320</sup> According to the Coalition, any attempt to distinguish actual “pirates” from members of the public exercising their long-standing rights to the public domain would foreclose the benefits of copyright laws for no good purpose. As in Locke’s time, any attempt to safeguard rights to the commons is dismissed as doing nothing more than endorsing highway robbery and raising uncompensated barriers to progress. Any amendment limiting liability for circumvention was rejected, under the assumption that the public could only be harmed, and could receive no benefit, from circumvention.

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317. *Id.* at 10-11 (emphasis added). See also Mark Stefik, *Trusted Systems*, SCI. AM., Mar. 1997, at 81 (“Trusted systems address the lack of control in the digital free-for-all of the Internet.”).

318. See Julie Cohen, *Some Reflections On Copyright Management Systems And Laws Designed To Protect Them*, 12 BERKELEY TECH. L.J. 161, 180 (1997) (noting the “White Paper’s deliberate lack of concern for the practical difficulties that attend unauthorized but lawful uses of works under a CMS [copyright management systems] regime”).

319. Metalitz, *supra* note 314, at 57.

320. *Id.*

#### D. Copyright Plus II: Mass-Market Licensing

The latest ongoing effort to enclose swaths of the public domain is taking place under the auspices of the Uniform Computer Information Transactions Act ("UCITA"), formerly proposed Article 2B of the Uniform Commercial Code. The advocates of UCITA in its current form employ a twin rhetorical strategy, much like that used by publishers from the Stationers on down, to argue against any sort of public domain or fair use. The strategy's first prong invokes private natural rights, while ignoring the theft of public rights; its second prong promises that unbounded utilitarian/economic benefits will flow from increased monopolization, yet assiduously ignores the costs of monopoly.

The scope of UCITA has been narrowed from that of Article 2B, which was to govern all transactions in information. Instead the Act will govern only "computer information transactions," which is nevertheless a crucial subset of copyrightable material, insofar as it includes, in addition to software, "electronically disseminated" news, opinion, pictures, and possibly even movies.<sup>321</sup> There is a distinct possibility that the "shrink-wrap" and "click-through" licenses accorded protection under that provision will not need to observe even the Copyright Act's ever-receding limit on copyright duration.<sup>322</sup> The power of licensors to set the boilerplate terms of mass-market licenses create the conditions for displacing limited

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321. See National Conference of Commissioners on Uniform State Laws, *New Uniform Act Meets Immediate Needs of the Information Age* (July 1999) ("UCITA covers software and information that is electronically disseminated. It does not cover other kinds of licenses of information such as motion picture contracts. Also excluded are distribution of information in traditional written form, such as books, magazines and newspapers."); see also Carlyle C. Ring, Jr., Chair of UCC2B Drafting Committee, *Summary of Actions at Article 2b Meeting November 13-15, 1998* (visited Apr. 24, 2000) (<<http://www.2BGuide.com/docs/cr1198sum.html>>).

322. Compare *ProCD, Inc. v. Zeidenberg*, 86 F.3d 1447 (7th Cir. 1996) (protecting arguably uncopyrightable database from copying on basis of shrinkwrap license), with *DSC Communications v. DGI Technologies*, 81 F.3d 597 (5th Cir. 1996) (declaring copyright unenforceable on basis of copyright misuse in attempt to expand copyright scope into "a patent-like monopoly" in hardware), *Lasercomb America v. Reynolds*, 911 F.2d 970 (4th Cir. 1990) (holding that a ninety-nine year license amounted to misuse, although the preclusion of licensees from developing competing products likely played greater role than the length of the license), and Mark Lemley, *Beyond Preemption: The Federal Law and Policy of Intellectual Property Licensing*, 87 CALIF. L. REV. 111, 132-33 (1999) (arguing that a license purporting to withdraw a work from the public domain may be unenforceable). The version of UCITA passed by the NCCUSL includes a "public policy" provision that may or may not override attempts to expand copyright duration.

copyright duration and scope with licenses restricted to narrowly defined uses and asserted in perpetuity.<sup>323</sup>

Section 105 of UCITA incorporates federal preemption doctrine, and provides that a court may refuse to enforce a contract term that “violates a fundamental public policy,” at least “to the extent that the interest in enforcement is clearly outweighed by a public policy against enforcement of the term.”<sup>324</sup> UCITA simply assumes that the enforcement of a contract outweighs a licensee’s fair use or First Amendment rights: “In practice, enforcing private contracts is most often consistent with these policies, largely because contracts reflect a purchased allocation of risks and benefits.”<sup>325</sup>

The comments to section 105(b) offer a wealth of examples of mass-market license terms that “promote interests in free expression and association” in this way, such as a term restricting “libelous or obscene language in an on-line chat room,” or terms that prohibit the licensee from making multiple copies, using the information for commercial purposes, allowing access by unauthorized users, or modifying software or informational content without the licensor’s permission.<sup>326</sup> Even a prohibition on “quotation of limited material for education or criticism purposes” could be enforced under UCITA upon “a showing of significant commercial need.”<sup>327</sup> If UCITA’s statutory language and comments are given much weight, then even the vaunted “neutrality” of UCITA and its predecessor, the proposed Article 2B,<sup>328</sup> toward federal rights would seem to provide scant protection to a licensee wishing to use the material in a “fair” but unauthorized manner.

The *ProCD* decision demonstrates that even in the absence of this burden-shifting provision of UCITA, many courts have already been inclined to take an expansive view of the freedom to “opt out” of copyright and

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323. See, e.g., Julie Cohen, *Copyright and the Jurisprudence of Self-Help*, 13 BERKELEY TECH. L.J. 1089, 1119 (1998).

324. National Conference of Commissioners on Uniform State Law, UCITA §105(b) (1999) ([http://www.law.upenn.edu/bll/ulc/ucita/UCITA\\_99.htm](http://www.law.upenn.edu/bll/ulc/ucita/UCITA_99.htm)). This incorporates a motion made at the November 1998 meeting of the UCC2b drafting committee. See Ring, *supra* note 321.

325. National Conference of Commissioners on Uniform State Law, Comment to 105(b), *available at* (<http://www.law.upenn.edu/bll/ulc/ucita/cita10cm.htm>).

326. *Id.* (citing *Storm Impact, Inc. v. Software of the Month Club*, 13 F. Supp. 2d 782 (N.D. Ill. 1998) (finding that “no commercial use” term in Internet contract was enforceable)).

327. *Id.*

328. Jessica Litman, *The Tales that Article 2B Tells*, 13 BERKELEY TECH. L.J. 931, 933 (1998).

into licensing, and have held restrictive views of preemption, public policy override, and First Amendment interests. Furthermore, there is no disputing that the existence of UCITA will be a force operating to contract rather than expand the intellectual commons.<sup>329</sup> This is true even if reference to UCITA decides only “marginal cases” of infringement, affects mostly “resource-poor defendants” who can ill afford to litigate, or merely operates “in terrorem” to chill speech that might result in breach-of-license litigation.<sup>330</sup> The right of the licensor under UCITA to engage in self-help without going to court may permit a technological end run around the public policy provisions.<sup>331</sup> In short, this system of legal and technological locks and keys may thus fulfill Blackstone’s vision of an intellectual property system whereby producers “may give out a number of keys” to the nooks and crannies of their literary estates, while maintaining in perpetuity the absolute right to exclude the universe from the remainder.<sup>332</sup>

The reference to Blackstone is apposite because we see in the advocacy for legal enforcement of mass-market information licenses another convergence of his “inseparably interwoven” principles of right and utility. In this case, the natural right is the right of contract. The drafters’ comments regarding UCITA’s treatment of preemption and public policy argue that “the fundamental interests in contract freedom” render “inappropriate” the “limitations on the information rights of owners that may be imposed in a copyright regime.”<sup>333</sup> Section 605, for example, disturbingly sanctions “electronic regulation of performance” without judicial supervision—read digital repossession.<sup>334</sup> As part of Article 2B, these measures

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329. *See id.*; *see also* Cohen, *supra* note 323, at 1128-29.

330. *See* Lemley, *Beyond Preemption*, *supra* note 322, at 125 n.33.

331. *See id.* at 122-23 (discussing provision in latest draft for licensor “electronic self-help” without going to court, subject to consequential damages in restricted circumstances).

332. ROSE, *supra* note 20, at 91 (quoting *Tonson v. Collins*, 96 Eng. Rep. 169, 188 (K.B. 1761)).

333. National Conference of Commissioners on Uniform State Law, Comments on Uniform Computer Information Transactions Act (1999) at 19; *available at* <http://www.law.upenn.edu/blil/ulc/ucita/cita10cm.htm>.

334. *See* National Conference of Commissioners on Uniform State Law, UCITA § 605(b)(2) (“prevents a use that is inconsistent with the agreement or with informational rights that were not granted to the licensee”); *see also id.* §§ 618, 701, 801; *cf.* American Law Institute and the National Conference of Commissioners on Uniform State Law, U.C.C. Art. 2B: Licenses (Annual Meeting Draft August 1998), § 2B-310(b)(2) (“restraint prevents uses of the information which are inconsistent with the agreement or with informational rights which were not granted to the licensee”), *available at* <http://www.law.upenn.edu/library/ulc/ucc2b/2b898.htm>. *See generally* Cohen, *supra* note 323, at 1096-98.

were justified by reference to “[t]he basic principle . . . that a contract can be enforced,”<sup>335</sup> thus implying that leases and other types of contracts with limited self-help remedies are somehow unenforceable.<sup>336</sup> Similarly, the preface to the August 1998 draft of Article 2B listed as some of the Article’s main benefits that it “confirms contract freedom in commercial transactions,”<sup>337</sup> and that it supports the “fundamental tenet of the common law . . . freedom of the parties to contract.”<sup>338</sup> This despite the manifest absence of freedom of consumers to alter contract terms in markets uniformly characterized by pro-seller mass-market contracts of adhesion.<sup>339</sup>

Economic justifications, which could be portrayed as issuing from “the other end of the epistemological spectrum,”<sup>340</sup> but which have virtually always followed close upon rights-talk, are perhaps even more prominent in the movement for enclosure via licensing. The primary economic argument for such licensing regimes is that regulation intended to safeguard consumers’ rights, whether to the commons, to free expression, or to privacy, is inefficient “friction” on the flow of commerce. Such arguments support the *ProCD* decision, in which standardized mass-market contracts drafted by sellers, and invisible to consumers until after purchase, are characterized as “a means of doing business valuable to buyers and sellers alike.”<sup>341</sup> This is because “adjusting terms in buyers’ favor might help individual litigants, “but would lead to a response, such as a higher price, that might make consumers as a whole worse off.”<sup>342</sup> In the end, any doubts about the convergence of freedom of contract and consumer welfare are resolved, because sellers will hypothetically compete on fair use and copyright terms:<sup>343</sup> “Competition among vendors, not judicial revision

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335. Proposed UCC Art. 2B-310, Reporter’s Note 1 (August 1998 draft).

336. See Cohen, *supra* note 323, at 1101-02.

337. American Law Institute and the National Conference of Commissioners on Uniform State Law, U.C.C. Art. 2B: Licenses (Annual Meeting Draft August 1998), “Preface” (“General Benefits” section).

338. *Id.* (“Freedom of Contract” section).

339. Cohen, *supra* note 323, at 1125-26 (“In the mass market context, consumers are contract takers; they can refuse to buy, or hold out for a lower price, but they generally cannot demand a particular package of contract terms or product characteristics.”).

340. *Id.* at 1120. Cohen also notes the “substantial overlap” and common “normative premises” of “libertarianism” and “neoclassical economic theory.” *Id.* at n.107.

341. *ProCD, Inc. v. Zeidenberg*, 86 F.3d 1447, 1449-50 (7th Cir. 1996).

342. *Id.* at 1451.

343. An analogy is provided by the luxury cruise industry, where cruise lines already presumably compete to provide the most consumer-friendly boilerplate on choice of forum in case of wrongful death suits. See *Carnival Cruise Lines, Inc. v. Shute*, 499 U.S. 585, 585-86 (1991).

of a package's contents, is how consumers are protected in a market economy."<sup>344</sup>

The August 1998 draft of Article 2B, from which UCITA was largely adapted, stands firmly in the tradition of representing enclosures as a source of net increases in the general welfare. The draft begins with a laundry list of "general benefits," "benefits to licensors," and "benefits to licensees."<sup>345</sup> Costs to licensees and third parties are imagined away, initially under the questionable assumption that the courts will prevent overreaching by licensors, and later under the pretense that the interests of consumers and producers are identical in every case.

The question of potential conflicts between the exclusive exploitation of information as a commodity and the wide circulation of information as a First Amendment value is quickly and easily resolved. In terms quite reminiscent of the White Paper's assumption that without expanded protection there will be "no content" on the NII, the draft maintains that "[c]ommercialization is not inconsistent with the role of information in political, social and other venues of modern culture. If it were, newspapers, books, television, motion pictures, video games, and other sources of informational content could not exist."<sup>346</sup>

The section concludes with the observation that First Amendment values "argue strongly for an approach to contract law in this field that does not encumber, but supports incentives for distribution of information and its distribution."<sup>347</sup> Thus, like the White Paper and countless other documents advocating expanded monopoly rights in information, the draft stresses the need for incentives while ignoring the costs. Once more, a non-exhaustive list of such costs would prominently feature the increase in outright refusals of access, the increase in prices owing to diminished competition, pervasive censorship of transformative works, and the increased transactions and court costs attendant to the proliferation of exclusive rights by contract.<sup>348</sup>

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344. *ProCD*, 86 F.3d at 1453.

345. American Law Institute and National Conference of Commissioners on Uniform State Laws, *supra* note 320, U.C.C. Art. 2B: Licenses (Annual Meeting Draft August 1998), "Preface" ("Informational Content" section).

346. *Id.*

347. *Id.*

348. *See generally* Fisher, *supra* note 212.

## V. THE FIRST AMENDMENT CHALLENGE TO BLACKSTONIAN COPYRIGHT

The crucial difference between enclosures of the intellectual commons, and land grabs proper, is that the former are regulations of speech that demand heightened judicial scrutiny as to whether legislative invocations of natural rights and utilitarian-economic benefits are sufficiently persuasive to justify the attendant impact on the public sphere. Although Blackstone's principle of the "sovereign and uncontrolable authority"<sup>349</sup> of parliament survives in America in deferential rational basis review of social and economic legislation, a like deference is not warranted for regulations that curtail freedom of expression.

The Framers explicitly sanctioned judicial suspicion of laws that inhibit the exercise of constitutional rights to free expression.<sup>350</sup> The Supreme Court has repeatedly held that these "choicest privileges," first and "transcendent" among all our natural rights in the American tradition,<sup>351</sup> are not to be "sacrificed . . . for too speculative a gain."<sup>352</sup> As the Court has held, freedom of expression possesses "a sanctity and a sanction not permitting dubious intrusions."<sup>353</sup> Yet courts and commentators, if not the Congress, are increasingly recognizing the fact that copyright largely determines the accessibility and cost of information in a democratic society, and that it grants rights holders substantial powers of censorship through the threat of prosecution for infringement.

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349. BLACKSTONE, *supra* note 19, at \*156.

350. In proposing the language that was eventually enacted in the First Amendment, James Madison remarked that, "[t]he freedom of the press and rights of conscience, those choicest privileges of the people, are unguarded in the British Constitution." See *Thomas v. Collins*, 323 U.S. 516, 530 (1945) (providing that the preferred place given in our scheme to the great democratic freedoms secured by the First Amendment gives them "a sanctity and a sanction not permitting dubious intrusions"); *United States v. Carolene Products Co.*, 304 U.S. 144, 152 n.4 (1938) (stating that the usual presumption of constitutionality will not rescue legislative invasions of rights indispensable to the democratic process); *Board of Education v. Barnette*, 319 U.S. 624, 639 (1943) ("The right of a State to regulate, for example, a public utility may well include, so far as the due process test is concerned, power to impose all of the restrictions which a legislature may have a 'rational basis' for adopting. But freedoms of speech and of press, of assembly, and of worship may not be infringed on such slender grounds."); cf. James Madison, *Memorial and Remonstrance Against Religious Assessments*, para. 3 (1785) ("it is proper to take alarm at the first experiment on our liberties"), available at <http://www.regent.edu/acad/schgov/polinet/histdoc/madisonm.html>.

351. *Freedman v. Maryland*, 380 U.S. 51, 56 (1965) (Brennan, J.).

352. *Denver Area Educ. Telcoms. Consortium, Inc. v. FCC*, 518 U.S. 727, 760 (1996).

353. *Thomas v. Collins*, 323 U.S. 516, 530 (1945).

This Part describes the definite and palpable costs posed to free expression on the Internet by the incursion by copyright holders into the public domain and fair use rights. The discussion commences with the observation that the view the Constitution's Framers held on freedom of expression was as generous as Justice Story's was stingy. Such views, if respected today, would limit the regulation of the Internet on First Amendment grounds. The argument then turns to the unparalleled capacity of Internet communication to fulfill the vision of Madison and Jefferson that "full information of their affairs . . . should penetrate the whole mass of the people."<sup>354</sup> Finally, this section argues that the galloping advances of Web publishing and Internet discourse will be chilled to a slow crawl by the revision of copyright from a right to publish and vend into a right to privately censor expression otherwise protected under the First Amendment. Such an abridgement of a fundamental right should follow only after the sort of searching inquiry that prevails in analyses of seditious and private libels, and of the right to jury trial.<sup>355</sup>

#### A. Copyright and First Amendment Originalism

In *Harper & Row*,<sup>356</sup> the Court held that the "definitional balance" struck by the idea-expression distinction, along with "the latitude for scholarship and comment traditionally afforded by fair use," resolves most if not all First Amendment difficulties posed by the copyright laws.<sup>357</sup> What is so troubling about *Harper & Row* from a First Amendment perspective is that by endorsing protections against quotation and imitation exceeding even those of Justice Story's opinion in *Folsom v. Marsh*,<sup>358</sup> the

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354. Letter from Thomas Jefferson to Edward Carrington (Jan. 16, 1787), in LETTERS (Merrill D. Peterson, ed., 1984).

355. Overbroad speech regulations were compared by Justice Marshall in words that foresaw the sort of treatment in store for Internet speech under *Harper & Row* and the DMCA. "That this Court will ultimately vindicate [a person] if his speech is constitutionally protected is of little consequence—for the value of a sword of Damocles is that it hangs—not that it drops." *Arnett v. Kennedy*, 416 U.S. 134, 231 (1974) (Marshall, J., dissenting).

356. 471 U.S. 539, 558 (1985).

357. *Id.* at 555, 560.

358. 9 F. Cas. 342, 345 (C.C. Mass. 1841) (No. 4,901). The *Harper & Row* Court was, it should be noted, interpreting provisions of the 1976 Copyright Act that it believed to render fair use an affirmative defense, and harm to potential markets a factor weighing against it. *See Harper & Row*, 471 U.S. at 561. The characterization of fair use as a "defense" rather than a "right" is increasingly relied upon to curtail what is in any case an ancient privilege. *See, e.g., Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 590 (1994) (holding that copyright defendant not entitled to fair use defense unless he or she presents "favorable evidence about relevant markets").

Court relied upon doctrines developed in an age in which the First Amendment did not even protect against fundamental infringements of the freedom of speech.<sup>359</sup> These doctrines were themselves only necessary to rein in and delimit Justice Story's unprecedented expansion of copyright liability to shelter activities that were legal at the time the Constitution and Bill of Rights were drafted.

Story, in turn, derived his restrictive interpretation of the First Amendment from the foremost advocate of perpetual and broad-ranging common law copyright, William Blackstone.<sup>360</sup> We have already seen what Blackstone thought about copyright duration and scope, as well as liberty of the press.<sup>361</sup> Story may be called, without exaggeration, the author of the American variant of Blackstonian copyright, favoring a form of protection as undying as that prescribed by his mentor. Story remarked, echoing Blackstone, that it is "indeed, but a poor reward, to secure to authors and inventors, for a limited period only, an exclusive title to that, which is, in the noblest sense, their own property; and to require it ever afterwards to be dedicated to the public."<sup>362</sup> On the matter of scope, Story approached Blackstone's protection even of "sentiments," declaring that it

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Section 107 of the 1976 Copyright Act by its literal terms appears to provide that no prima facie case of infringement will lie against a fair use, as opposed to a fair use claim serving as an affirmative defense to infringement. Section 106 grants copyright holders certain exclusive rights "subject to" section 107, which is itself titled "Limitations on exclusive rights" and refers to fair use as "not an infringement of copyright," rather than as an infringement saved by a defense. 17 U.S.C. §§ 106-07 (1976). The legislative history, however, appears to have cast section 107 as an affirmative defense. *See* H. R. REP. NO. 90-83, at 37 (1967); WILLIAM F. PATRY, *THE FAIR USE PRIVILEGE IN COPYRIGHT LAW* 477-78 n.4 (1985) (stating that educational groups sought unsuccessfully to have burden of proof regarding fair use shifted to plaintiffs, although they "freely acknowledged that fair uses as developed by the courts put the burden of proof on the defendant").

359. *Folsom v. Marsh* was decided in 1841, and the idea-expression distinction was established in 1879 in *Baker v. Selden*, 101 U.S. 99 (1879). The first Supreme Court case striking down a prior restraint on First Amendment grounds, by contrast, appears to be *Near v. Minnesota*, 283 U.S. 697 (1931). *See also* *New York Times Co. v. Sullivan*, 376 U.S. 254, 276 (1964) (stating that the Sedition Act, 1 Stat. 596 ch. 74 (1798), "was inconsistent with the First Amendment" because "of the restraint it imposed upon criticism of government and public officials").

360. *See* Story, *supra* note 223, at Ch. XLIV, § 995 (quoting Blackstone's discussion of liberty of the press at length).

361. *See* 4 BLACKSTONE, *supra* note 19, at \*151-52.

362. Joseph Story, *A FAMILIAR EXPOSITION OF THE CONSTITUTION OF THE UNITED STATES* (New York, American Book Co. 1840) (quoted in Phillips, *supra* note 184).

was “no defence, that another person has appropriated a part, and not the whole, of any property.”<sup>363</sup>

The Framers of the Constitution envisioned quite a different First Amendment from that of Blackstone or Story, and their vision must continue to be respected when addressing the matter of copyright.<sup>364</sup> If it is true that few statements on the intersection between copyright and freedom of speech have survived, it is equally true that the Framers had little reason to make any. The tiny footprint left by copyright in post-revolutionary America was the combined result of the 14-year term of the Statute of Anne,<sup>365</sup> the 28-year maximum term of the Copyright Act of 1790,<sup>366</sup> and an English common law of copyright scope that proffered an expansive right of fair abridgement.<sup>367</sup>

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363. *Folsom*, 9 F. Cas. at 349. See also *id.* at 348-49 (“None are entitled to save themselves trouble and expense, by availing themselves, for their own profit, of other men’s works, still entitled to the protection of copyright. . . . The entirety of the copyright is the property of the author.”). Story was also the first American judge to grant exclusive rights to compilers of preexisting or unprotected material, according to the U.S. Copyright Office. See U.S. COPYRIGHT OFFICE, REPORT ON LEGAL PROTECTION FOR DATABASES 4 (1997), available at (<http://www.loc.gov/copyright/reports/>); compare *Kilty v. Green*, 4 H. & McH. 345 (Gen. Ct. Md. 1799) (denying protection to compilation of statutes), with *Gray v. Russell*, 10 F. Cas. 1035 (C.C.D. Mass. 1839) (No. 5,728) (Story, J.) (favoring protection), and *Emerson v. Davies*, 8 F. Cas. 615, 618-25 (C.C.D. Mass. 1845) (No. 4,436) (Story, J.) (holding that a compiler’s original “plan, arrangement and combination of materials” for a series of arguably original arithmetic lessons was copyrightable, and finding infringement because a compiler of such an arrangement is entitled to exclusive rights by virtue of “his own expense, or skill, or labor, or money”).

364. See *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 57 (1889) (“The construction placed upon the constitution . . . by the men who were contemporary with its formation, many of whom were members of the convention which framed it, is of itself entitled to very great weight.”).

365. See Statute of Anne, *supra* note 164.

366. See Copyright Act of 1790, Act of May 31, 1790, § 1, 1 Stat. 124. The persistence of this term for more than forty years should be considered by courts confronting the meaning of the “for limited Times” language of the Copyright Clause and the First Amendment implications of term extension. See *Printz v. United States*, 521 U.S. 98 (1997) (quoting *Myers v. United States*, 272 U.S. 52, 175 (1926), which held that “contemporaneous legislative exposition of the Constitution . . . , acquiesced in for a long term of years, fixes the construction to be given its provisions”). Also crucial to the Framers’ comparative indifference to copyright as a tool of censorship must have been the vigorous public domain ensured by the complete denial of protection to books published in Britain, which outnumbered American works by a large number into the nineteenth century. “American law made it impossible for foreign publishers to secure copyrights until 1891 . . . . Dickens and Trollope were but two of the many noted European authors who thought their livelihood threatened by rampant piracy on these shores.” William Alford, *Making the World Safe for What? Intellectual Property Rights, Human Rights and Foreign Economic Policy in the Post-European Cold War World*, 29 INT’L L.

The danger posed by the national government to the liberty of the press was an explicit subject of debate in both the original constitutional convention and the state conventions on ratification. Yet so oblivious were those debating the new document as to the lengths that copyright protection would be taken that The Federalist Papers rejected a constitutional protection of press freedom on the grounds that “no power is given by which restrictions may be imposed.”<sup>368</sup>

What is the relation of this endorsement of a wide-ranging and well-nigh unlimited freedom of the press to early American copyright law? Simply this: it is likely that the early American intellectual property balance was influenced, not only by anti-monopoly sentiment, but also and perhaps more decisively by a profound rejection of licensing and censors especially, and of restraints on speech in general, for any reason. The transcendent value of free expression for rational agents and democratic self-governors may account in part for the dearth of successful copyright suits in the early decades of the United States.<sup>369</sup>

The Supreme Court arguably resolved the question of abridgement of the freedom of speech by copyright in rather too hasty a fashion. In relying solely upon the internal structure of copyright as influenced by the frankly anti-constitutional views of Justice Story, it neglected to engage in the sort of inquiry into the type of abridgements that the Framers anticipated would actually occur under the Copyright Clause in drafting the Bill of Rights.<sup>370</sup> Compare this refusal to discuss the Copyright Act of 1790 or the common law of copyright in determining a minimum standard for abridgement of “the freedom of speech” to the careful attention devoted to the English and American law of both seditious and private libel in cases like *Sullivan*,<sup>371</sup> or to the common law right to jury trial in Seventh Amendment cases.<sup>372</sup>

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& POLITICS 135, 147 (1996-97). See Jane Ginsburg & John Kernochan, *One Hundred and Two Years Later: The U.S. Joins the Berne Convention*, 13 COLUM.-VLA J.L. & ARTS 1, 1-18 (1988).

367. See, e.g., *Millar v. Taylor*, 4 Burr. 2303, 98 Eng. Rep. 201 (K.B. 1769).

368. THE FEDERALIST NO. 84, at 535 (Alexander Hamilton) (B. Wright ed., 1961).

369. See Mark Lemley & Eugene Volokh, *Freedom of Speech and Injunctions in Intellectual Property Cases*, 48 DUKE L.J. 147, at n.24 (1998) (collecting copyright cases denying injunctions in 1820s and 1830s).

370. See Phillips, *supra* note 184.

371. See *New York Times Co. v. Sullivan*, *supra* note 359, at 273-77.

372. See *Patton v. United States*, 281 U.S. 276, 288 (1930) (interpreting the right to jury trial under the Seventh Amendment to preserve at a minimum “a trial by jury as understood and applied at common law, and [to] include[] all the essential elements as they were recognized in this country and England when the Constitution was adopted”). The

My analysis of the First Amendment implications of the creeping advance of copyright to encompass uses of works formerly sheltered by limited term or restricted scope is not meant as a rigorous application of contemporary free speech doctrine. The Court's recent case law on intermediate scrutiny of content-neutral speech regulations has been ably and exhaustively applied to copyright extension by the briefs of the plaintiffs in *Eldred v. Reno*.<sup>373</sup> Yochai Benkler has performed a similar task with regards to the DMCA's anti-circumvention prohibitions, UCC Article 2B, and the proposed Collections of Information Antipiracy Act.<sup>374</sup>

What I advocate here is an originalist inquiry into copyright and free expression, and into the need for a reading of the First Amendment that would provide as much protection against censorship via copyright as by any other means. In the absence of such a thorough and systematic inquiry into the historical and philosophical conflict between speech interests and print monopolies, it will be all too easy for courts to conclude, as the *Eldred* court did, that "there are no First Amendment rights to use the copyrighted works of others."<sup>375</sup>

The reception toward First Amendment defenses to copyright claims in the courts will depend on whether judges perceive First Amendment rights to be threatened by increasingly broad copyright laws.<sup>376</sup> Far from being "no essential part of any exposition of ideas,"<sup>377</sup> like obscenity or fighting words, imitation and quotation "is almost as much a part of free

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language of the Seventh Amendment parallels that of the First in that both are unequivocal. Compare U.S. CONST., amend. VII ("the right of trial by jury shall be preserved") with U.S. CONST., amend. I ("Congress shall make no law . . . abridging the freedom of speech. . ."). Recently the Supreme Court relied upon early American practice under the Copyright Act of 1790, under which copyright actions for damages were tried at law and before a jury, along with the similar English practice under the common law and Statute of Anne, to strike down a section of the Copyright Act that abridged the Seventh Amendment right to jury trial. See also *Feltner v. Columbia Pictures Television, Inc.*, 523 U.S. 340 (1998).

373. See, e.g., *Eldred Memorandum*, *supra* note 201, *passim*. The Berkman Center for Internet and Society at Harvard Law School maintains a website on the *Eldred v. Reno* case with links to the legal documents at <http://cyber.law.harvard.edu/eldred-vreno/legaldocs.html>.

374. See Benkler, *supra* note 12.

375. *Eldred v. Reno*, 74 F. Supp.2d 1, 3 (D.D.C. 1999) (granting judgment on the pleadings against plaintiff's First Amendment challenge).

376. Cf. 1 MELVILLE NIMMER AND DAVID NIMMER, NIMMER ON COPYRIGHT § 1.10[A], at 69 (1998) ("Rather surprisingly, up to now the Supreme Court of the United States has not found it necessary fully to delineate the respective claims of copyright and freedom of speech.").

377. *Chaplinsky v. New Hampshire*, 315 U.S. 568, 572 (1942).

speech as the right to use our tongues.”<sup>378</sup> The view must be fostered among judges and legislators alike that cyberspace deserves First Amendment protection as much from expansive copyright enforcement as from the vague indecency provisions of the Communication Decency Act held invalid in *ACLU v. Reno*.<sup>379</sup>

Congress should be required to use more “sensitive tools” to enforce the “separation of legitimate from illegitimate speech” in making copyright legislation.<sup>380</sup> However, whether judges in particular will take the trouble to test a proposal for overbreadth, vagueness, or similar vices may rest on how well they have been convinced that constitutional values will be served by doing so.<sup>381</sup> Hence some discussion is needed as to whether copyright’s “engine of free expression” is not in fact operating more like a series of brakes, roadblocks, and checkpoints on the information superhighway.

### B. Independent Web Publishing: The Rise of the Cyber-Yeoman

In one entry, the Oxford English Dictionary defines the “yeoman” as “one who cultivates his own land.”<sup>382</sup> The yeomanry was often juxtaposed on the one hand to the nobility, the gentlemen, and on the other to the

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378. *Milwaukee Social Democratic Publ’g Co. v. Burleson*, 255 U.S. 407, 437 (1921) (Holmes, J., dissenting) (referring to the use of the mails).

379. See *Copyright Piracy, and H.R. 2265, The No Electronic Theft (Net) Act: Hearing on H.R. 2265 Before the Subcomm. on Courts and Intellectual Property of the House Comm. of the Judiciary*, 105th Cong. 156 (1997) (statement of David Nimmer) (arguing that with overbroad intellectual property laws, “the danger arises that the Internet itself could [be] prosecuted out of existence”).

380. *Speiser v. Randall*, 357 U.S. 513, 525 (1958). See also, e.g., *NAACP v. Button*, 371 U.S. 415, 433 (1963).

381. Cf. *Universal City Studios, Inc. v. Reimerdes*, 82 F. Supp 2d 211, 222 (S.D.N.Y. 2000) (weighing society-wide benefits of the DMCA’s anti-circumvention provisions only against the costs to particular defendants prevented from publishing computer code, information “best treated as a virtual machine” and “arguably” of no First Amendment value therefore disregarding the society-wide costs imposed by encryption technologies that render the fair use of digital content impossible); but see *Los Angeles Times v. Free Republic*, No. 98-7840 (C.D. Cal. Nov. 9, 1999), available at <http://www.techlawjournal.com/courts/freerep/19991108.htm> (relying upon *Harper & Row* to hold that while “defendants and users of freerepublic.com might find [linking] less ideal than being able to copy entire news articles verbatim, their speech is in no way restricted by denying them the ability to infringe on plaintiffs’ exclusive rights in the copyrighted news articles”) (emphasis added); see also *Intellectual Reserve, Inc. v. Utah Lighthouse Ministry, Inc.*, 75 F. Supp. 2d 1290, 1295-96 (D. Utah 1999) (cursorily rejecting First Amendment defense to contributory infringement action premised upon hyper-text links, and granting preliminary injunction against defendant’s linking to sites that posted religious documents “alleged to infringe plaintiff’s copyright”).

382. 20 OXFORD ENGLISH DICTIONARY, “yeoman,” definition II.4.a., at 41.

class of farmers more beholden to the landowners, whether as renters or as agricultural wage-laborers. Dr. Price distinguished this class by its self-sufficiency, saying that since they “maintain themselves and families by the produce of the ground they occupy” and by cattle “kept on a common,” they “therefore have little occasion to purchase any of the means of subsistence.”<sup>383</sup> As we have seen, the English yeomanry is said by some to have enjoyed a “golden age” between the decline of serfdom and the growth of an agricultural and manufacturing proletariat.

Whether this is an accurate historical characterization or not, it is an apt analogy to contemporary developments in cyberspace, or more formally, on the National and Global Information Infrastructure. The rise and explosive growth of the World Wide Web has represented a movement “up from serfdom,” by providing an alternative to the well-documented moral and intellectual serfdom imposed by the mass media. Television and radio, and to a lesser extent print, suffer from a restricted range of political coverage,<sup>384</sup> a narrow and stultifying range of debate,<sup>385</sup> excessive dependence upon the favor of the political officials they claim to cover ob-

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383. DR. RICHARD PRICE, 2 OBSERVATIONS ON REVERSIONARY PAYMENTS 159 (6th ed. London, W. Morgan 1803), *quoted in* MARX, *supra* note 37, at 360.

384. See The Freedom Forum Online, ABC, CBS, NBC, *Downsizing Overseas Bureaus, Discuss Shared Effort with CNN* (Oct. 17, 1998) (<http://www.freedomforum.org/professional/1998/10/27downsize.asp>) (“It’s . . . cheaper and easier to use more entertainment-driven news rather than complex international stories, said Ed Turner, former CNN executive and now a fellow at The Freedom Forum’s Media Studies Center.”).

385. Dissenting voices and facts and images unfavorable to the war effort were almost entirely silenced during the leadup to and prosecution of the Persian Gulf War. See DOUGLAS KELLNER, *THE PERSIAN GULF TV WAR* (1992) (criticizing media complicity with Pentagon propaganda); JOHN MACARTHUR, *SECOND FRONT: CENSORSHIP AND PROPAGANDA IN THE GULF WAR* (1992) (same). To take another example, during the 1999 Kosovo bombing campaign, only 5% of sources on ABC’s Nightline were critical of the Administration’s policy, along with only 10% of those on PBS’s News Hour with Jim Lehrer. See Fairness and Accuracy in Reporting, *Slanted Sources in NewsHour and Nightline Kosovo Coverage* (May 1999), available at (<http://www.fair.org/reports/kosovo-sources.html>). And it has long been the practice of political discussion programs, including those on PBS, to stage a “debate” between far-right pundits such as Pat Buchanan, Robert Novak, or John McLaughlin, and centrists such as Bill Press, Mark Shields, or former CIA official Tom Braden. See Jim Naurekas, *Crossfire: Still Missing a Space on the Left*, EXTRA! UPDATE, (Apr. 1996) (<http://www.fair.org/extra/9604/crossfire.html>); *Public TV Tilts Toward Conservatives*, EXTRA!, (June 1992) (<http://www.fair.org/extra/best-of-extra/public-tv-conservatives.html>); Jeff Cohen, *Television’s Political Spectrum*, EXTRA! (July/August 1990) (<http://www.fair.org/extra/best-of-extra/tv-spectrum.html>).

jectively,<sup>386</sup> and the distortions wrought by for-profit operation and advertiser influence.<sup>387</sup>

These considerations account for much of the enthusiasm many felt with the advent of the Internet, perceived as a forum for the exchange of information and opinion. Justice Stevens' majority opinion in *Reno v. ACLU*<sup>388</sup> captured the radical difference between the Internet and "old media" by describing this new communications space in language rarely used in reference to print publishing, radio or television. Cyberspace, he wrote, is characterized by "astoundingly diverse content,"<sup>389</sup> and indeed, he went on, the "content on the Internet is as diverse as human thought."<sup>390</sup> There reigns online a "relative parity among speakers."<sup>391</sup> For between zero and a few hundred dollars annually, anyone can become a modern-day Tom Paine, a "town crier with a voice that resonates farther than it could from any soapbox."<sup>392</sup>

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386. The print and broadcast media corporations depend upon the federal government to pass legislation relating to the broadcast spectrum, content regulation, and copyright law; to approve mergers; to funnel large amounts of advertising their way; and for preferential treatment in wartime. Lawsuits were brought during the Persian Gulf War by *The Nation* magazine and Agence-France Presse challenging discriminatory grants of access to a system of "press pools" organized by the U.S. Department of Defense as a "trusted agent of the U.S. military." Capt. Jon Mordan, *Press Pools, Prior Restraint and the Persian Gulf War*, AIR CHRONICLES (visited Apr. 27, 2000) (<http://www.airpower.maxwell.af.mil/airchronicles/cc/mordan.html>); cf. Thomas G. Havener, *Assault on Grenada and the Freedom of the Press*, 36 CASE W. RES. L. REV. 483 (1986) (discussing the constitutional arguments in favor of press access to military operations and concluding that such a right exists). A number of broadcast interests contributed at least \$9.5 million over the past decade in lobbying and unknown amounts of in-kind compensation for the estimated \$70 billion giveaway of the digital broadcast spectrum. See Common Cause, *Channeling Influence: The Broadcasting Lobby and the \$70 Billion Free Ride* (1997) ([http://www.commoncause.org/publications/040297\\_rpt.htm](http://www.commoncause.org/publications/040297_rpt.htm)). Political campaigning accounted for some \$400 million in television advertising revenue in 1996 alone. See *id.* The multi-billion dollar merger of AOL and Time Warner awaits potential FTC/DOJ enforcement actions and Congressional hearings. See *AOL's Big Bite*, THE NATION, Jan. 31, 2000, at 3 (editorial).

387. See generally DEAN ALGER, *MEGAMEDIA: HOW GIANT CORPORATIONS DOMINATE MASS MEDIA, DISTORT COMPETITION, AND ENDANGER DEMOCRACY* (1998); BEN BAGDIKIAN, *THE MEDIA MONOPOLY* (5th ed. 1997).

388. 521 U.S. 844 (1997).

389. *Id.* at 2343.

390. *Id.* at 2344 (internal quotation marks omitted).

391. *Id.*

392. *Id.* As of 1998, over 88.5% of the 461 public libraries serving populations of 100,000 or more offered Internet access to the public, along with more than 50% of classrooms in the public schools. See American Library Association, *How Many Libraries Are on the Internet?* LARC Fact Sheet Number 26 (visited Apr. 24, 2000)

In short, as Andrew Shapiro has written, “new technology is allowing individuals to take power from large institutions such as government, corporations and the media. To an unprecedented degree, we can decide what news and entertainment we’re exposed to, . . . and even how . . . political outcomes are reached.”<sup>393</sup> The benefits of such a system of information storage and retrieval was prophesied as long ago as 1945, in Vannevar Bush’s proposal of a “memex” which would harness the associational genius of the human mind such that “books, records, and communications . . . may be consulted with exceeding speed and flexibility.”<sup>394</sup> Cyberspace reveals the first faint glimmers of a sort of “groupmind,” the “Over-soul” that Emerson called the “Supreme Critic on the errors of the past and the present, and the only prophet of that which must be . . . within which every man’s particular being is contained and made one with all other.”<sup>395</sup>

In cyberspace, thinkers and writers may speak frankly and from the heart, without worrying about offending bosses, advertisers, or politicians. Thus liberated, they go about constructing in tandem a cultural “operating system,” using “the entire world as its talent pool.”<sup>396</sup> Not only has that

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(<http://www.ala.org/library/fact26.html>). Home Internet access is available to anyone who can manage between zero and a few hundred dollars in installment payments for a computer, a telephone connection, and between zero and another hundred or so dollars annually for dial-up access. PeoplePC, among others, offers “new computer, a suite of software, and unlimited Net access” for \$24.95 monthly, and recently “brokered” the deal between Hewlett Packard and Ford that will provide the auto maker’s 350,000 global workforce with 500-megahertz computers and unlimited Internet access for \$5 monthly. See Leander Kahney, *PeoplePC Drives Easy Bargain*, WIRED NEWS (Feb. 3, 2000) (<http://www.wired.com/news/business/0,1367,34096,00.html>); Keith Bradsher, *Ford Offers Workers PC’s and Internet Service for \$5 a Month*, N.Y. TIMES, Feb. 4, 2000, at A1, available at (<http://www.nytimes.com/library/tech/00/02/biztech/articles/04ford.html>). None of this is to say that all Americans, let alone citizens of other nations, have the ability and desire to acquire home access. See Malla Pollack, *The Right to Know?: Delimiting Database Protection at the Juncture of the Commerce Clause, the Intellectual Property Clause, and the First Amendment*, 17 CARDOZO ARTS & ENT L.J. 47, 122 nn.381-82 (1999) (noting that many home Internet users tend to be affluent, and that many Americans do not have telephones).

393. ANDREW SHAPIRO, *THE CONTROL REVOLUTION: HOW THE INTERNET IS PUTTING INDIVIDUALS IN CHARGE AND CHANGING THE WORLD WE KNOW* xiii (1999).

394. Vannevar Bush, *As We May Think*, THE ATLANTIC MONTHLY, July 1945, at 106-07. As he concludes: “The applications of science have . . . enabled [man] to throw masses of people against one another with cruel weapons. They may yet allow him truly to encompass the great record and to grow in the wisdom of race experience.” *Id.*

395. Ralph Waldo Emerson, *The Over-Soul*, in *ESSAYS: FIRST SERIES* (1841).

396. Eric S. Raymond, *White Paper: The Cathedral and the Bazaar*, (visited Apr. 13, 2000) ([http://www.redhat.com/support/wpapers/cathedral/whitepaper\\_cathedral.html](http://www.redhat.com/support/wpapers/cathedral/whitepaper_cathedral.html)) (essay outlining some of the founding principles of the Open Source movement, which advocates the open licensing of software so as to be freely used and adapted).

talent pool amassed a digital library comparable in terabytes of data to the Library of Congress,<sup>397</sup> but that library is searchable with unprecedented efficiency.<sup>398</sup>

A few examples of the Net's diversity will make this discussion concrete. Unparalleled access to the array of thinkers and writers from Aesop and Louisa May Alcott to Emile Zola and Zoroaster is provided by thousands of commercial, educational, and personal Web pages.<sup>399</sup> The world-views represented by such collections may not be "as diverse as human thought," but they do more or less encompass Western thought, with increasingly comprehensive multicultural additions.

The Internet also provides a wealth of political information and opinion of far more depth and breadth of scope than anything available on television or radio. For example, Think for Yourself, a site devoted to the adverse consequences of the war on drugs, reproduces a wide range of views from ACLU Position Papers to a 1996 Rand Corporation study on mandatory minimum sentencing and the efficiency of incarceration versus treatment.<sup>400</sup> On the foreign policy side, the Iraq Action Coalition, maintained by Rania Masri, has assembled an impressive array of evidence and

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397. While the Library of Congress is estimated to house around 20 terabytes of text, the Internet Archive has saved more than 14 terabytes of public Internet content as of early 2000. See Brewster Kahle, *Archiving the Internet*, SCI. AM., Nov. 4, 1996, at 82. The images on the Internet alone would fill over 1 million printed volumes. See Brewster Kahle and Peter Lyman, *Archiving Digital Cultural Artifacts: Organizing an Agenda for Action*, D-LIB MAGAZINE July/Aug. 1998, available at (<http://www.dlib.org/dlib/july98/07lyman.html>).

398. See, e.g., Google.com, *Company Info* (<http://www.google.com/company.html>) (describing how Google's associational system for searching the Internet "uses the collective intelligence of the web to determine a page's importance").

399. These sites include Project Gutenberg, (<http://promo.net/pg>), the *Online Books Page* at the University of Pennsylvania, (<http://digital.library.upenn.edu/books>), the Malaspina Great Books page, (<http://www.mala.bc.ca/~mcneil>), the Internet Classics Archive at MIT, (<http://classics.mit.edu>), the Internet History Sourcebooks at Fordham, (<http://www.fordham.edu/halsall>), the Christian Classics Ethereal Library at Wheaton, (<http://ccel.wheaton.edu>), the Constitution Society, (<http://www.constitution.org>), Findlaw.com, (<http://www.findlaw.com>), the McMaster Archive of the History of Economic Thought, (<http://socserv2.socsci.mcmaster.ca/~econ/ugcm/3ll3/>), and those of countless individuals. The *Online Books Page* alone provides access to over 10,000 free, and freely modifiable and adaptable, electronic books. See (<http://digital.library.upenn.edu/books>). Project Gutenberg has published over 1,700 public domain texts. See (<http://promo.net/pg>).

400. See Think for Yourself, *War on Drugs Archives* (visited Dec. 20, 1999) (<http://turnpike.net/~jnr/wodarts.htm>).

argumentation in support of the view that economic sanctions are unproductive and brutal.<sup>401</sup>

While the Internet has continued to broaden public discourse, the major media have devoted even more time and resources to the minutiae of the Simpson and Menendez cases, the death of Lady Diana, and Monica Lewinsky's shopping sprees, than to, for example, the plight of the Iraqi people or the justifications for maintaining sanctions. The old mass media has thus relinquished its claim as servant to the public sphere, to be supplanted in that role by Internet discourse and independent web publishing.

### C. Digital Fencing and Estate Clearing in Cyberspace

Traditional media have characterized the noncommercial Internet in a manner closely resembling the view of the public domain held by the Stationers and other copyright industry players: that it is a waste, an incoherent babble, a thicket of weeds and brambles. Internet content is commonly portrayed as untrustworthy, fanatical, or merely frivolous.<sup>402</sup> Many argue that in the absence of expanded intellectual property protections, Internet content will "devolve into something akin to advertising, or more specifically, infomercials," and will therefore "slide toward information that someone is attempting to foist on the viewer—partisan, untrustworthy, and thin in usable content."<sup>403</sup>

While independent web publishing cannot exist without its small plots of "land" on university servers and free web hosting sites, just as vital are

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401. Through many dozens of available documents, the site contends that the policy of economic sanctions on the Iraqi people leads to thousands of avoidable deaths monthly, violates international law, strengthens the regime, decimates the Iraqi middle class, and has been condemned by people ranging from human rights advocates and U.N. officials to Catholic bishops. See Iraq Action Coalition, *Impact of the 8-Year Sanctions War on the People of Iraq* (visited Dec. 20, 1999) (<http://leb.net/~iac/factsheet.html>) (collecting sources).

402. The New York Times, in an article about drug information on the Internet, writes that "[p]artly owing to free-speech protection, the Internet lacks a quality-control mechanism to separate fact from hyperbole or from outright falsehood." Christopher S. Wren, *A Seductive Drug Culture Flourishes on the Internet*, N.Y. TIMES, June 20, 1997, at A1. After the Heaven's Gate suicides, the cult's use of the Web was regarded by the Times as "one more shred in an accumulating pile of evidence that there are networks of people lurking out there with alien values, and that anyone, any age, might stumble onto them with a mouseclick." *Id.* The Wall Street Journal's editor of online services, responsible for one of traditional media companies' few pay sites, claims that: "Search engines cull the equivalent of 18 months of junk mail." Jesse Freund, *Just Outta Beta: The Street Strikes Back*, WIRED, June 1997, at 157. Then again, maybe some people are simply not very good at using search engines.

403. Carol Rose, *The Several Uses of Property*, 83 MINN. L. REV. 129, 148 (1998).

its easements through the intellectual commons. In order to transcend the monolithic public sphere constituted by the New York Times, the Washington Post, Disney-GE-Westinghouse, and now AOL Time Warner, and to enshrine a new panoply of "counter-public" spheres, the Tom Paines of cyberspace must be able to ground their discourse in the copyrighted material of Big Media (which themselves enjoy at best an arbitrary association with reliable information<sup>404</sup>). Without the public domain, without the right to transform works new and old *sans* prior approval, independent Web publishing will have its vital economic and discursive conditions ripped out from under it.

Contemporary pushes toward the enclosure of the intellectual commons threaten to do just that. As I have argued, the most pressing threat in the short term is posed by ISP liability, of private profit-oriented copyright dispute resolution in cyberspace. Media companies will more frequently request that telecommunications and Internet companies, often owned by those same media companies and in any case frightened by the prospect of massive civil and criminal liability, delete the allegedly infringing content of a subscriber paying between zero and twenty dollars per month.<sup>405</sup> The post-DMCA Internet will feature even more of those damnable "404 - file not found" messages than it currently does. As media companies expand their demand-letter operations from commercial "piracy" to include negative commentary, transformative uses, and what they deem to be a little bit too much sampling or quotation, the ranks of the independent Internet publishers will be radically depopulated.<sup>406</sup>

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404. See, e.g., Jim Naureckas, *Legitimate Targets? How U.S. Media Supported War Crimes in Yugoslavia*, EXTRA!, July/Aug. 1999 (<http://www.fair.org/extra/9907/kosovocrimes.htm>); Jim Naureckas, *Rescued from the Memory Hole: The Forgotten Background of the Serb/Albanian Conflict*, EXTRA!, May/June 1999 (<http://www.fair.org/extra/9905/kosovo.html>); Seth Ackerman; *Withholding the News: The Washington Post and the UN-SCOM Spying Scandal*, EXTRA!, Mar./Apr. 1999 (<http://www.fair.org/extra/9903/unscom.html>); Jeff Cohen & Norman Solomon, *CNN's "Tailwind" and Selective Media Retractions*, EXTRA!, Aug. 1998 (<http://www.fair.org/extra/9808/tailwind.html>); Fairness and Accuracy in Reporting, *Gulf War Stories the Media Loved - Except They Aren't True*, EXTRA!, 1991 (<http://www.fair.org/extra/best-of-extra/gulf-war-not-true.html>); Jeff Cohen & Norman Solomon, *30-Year Anniversary: Tonkin Gulf Lie Launched Vietnam War*, MEDIA BEAT, July 27, 1994 (<http://www.fair.org/media-beat/940727.html>).

405. Various companies, including Prodigy Internet, have demonstrated their willingness to censor user content to increase profitability. See HOWARD RHEINGOLD, *THE VIRTUAL COMMUNITY: HOMESTEADING ON THE ELECTRONIC FRONTIER* 277 (1993) ("[T]here are actually banks of people sitting in front of monitors somewhere, reading postings from Prodigy subscribers, erasing the ones with offensive content.").

406. See *Zeran v. America Online Inc.*, 129 F.3d 327, 333 (4th Cir. 1997) ("Whenever one was displeased with the speech of another party conducted over an interactive

Even presidential candidates are taking advantage of copyright's unmooring from precisely delimited rights. George W. Bush's campaign sent a cease and desist letter to Zack Exley, the creator of (gwbush.com), a savage parody of Bush's own site, threatening legal action for Exley's infringing "graft" of "inappropriate" material "onto the words, look and feel of the Exploratory Committee's site."<sup>407</sup> Bush's own response to the site was that "[t]here ought to be limits to freedom."<sup>408</sup> In a clear case of overreaching, the letter demanded that Exley "remove immediately from [the] site all of the materials and arrangements you have taken from georgewebush.com, with the exception of such *pure facts*" as "may be shown by you as a permitted 'fair use.'"<sup>409</sup> The letter cited *Harper & Row* to clear up any "confusion" on Exley's part as to the "certain amount" of fair use available in "particular defined and reasonable circumstances."<sup>410</sup> Whether because of concern for the reaction for telecommunications companies or ignorance of legal remedies, no demand appears to have been made on Exley's ISPs, which might have threatened the site's existence.

Yet another piece of copyright litigation, crucial to the prospects for independent Web publishing, deals with a questionable expansion of copyright scope. The Los Angeles Times and the Washington Post are well on their way to securing an injunction and damages against Free Republic, a conservative web site, premised upon its practice of allowing users to post newspaper articles for discussion.<sup>411</sup> The owner of the site claims that

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computer service, the offended party could simply 'notify' the relevant service provider, claiming the information to be legally [infringing]. In light of the vast amount of speech communicated through interactive computer services, these notices could produce an impossible burden for service providers, who would be faced with ceaseless choices of suppressing controversial speech or sustaining prohibitive liability.").

407. Letter from Benjamin L. Ginsburg to Zack Exley of April 1999 *available at* <http://www.gwbush.com/litigiousbush.htm>. Incidentally, Exley's posting of the letter itself could even be argued to constitute infringement under *Harper & Row*, despite its public interest ramifications (the Bush campaign's threats received widespread national and international media coverage). Exley was subsequently referred to the FEC for violation of the campaign finance laws. *See* [www.gwbush.com](http://www.gwbush.com) for developments.

408. *See* George W. Bush (visited Apr. 24, 2000) (<http://www.georgewebush.com>).

409. Letter from Benjamin L. Ginsburg, *supra* note 407. Fair use is, of course, hardly limited to "pure facts" (even now). Furthermore, to require every political speaker to somehow demonstrate to the satisfaction of a politician's legal representatives that their quotation of his campaign materials is indisputably protected is virtually the definition of a prior restraint on speech.

410. *Id.*

411. *See* Greg Miller, *Web Copyright Suit Goes to Heart of Debate; Internet: L.A. Times, Washington Post Take Action against Free Republic, which Copies and Posts their Articles*, L.A. TIMES, Oct. 1, 1998, at D1.

“posting the whole article is necessary so readers can dissect them for liberal bias.”<sup>412</sup>

The site appears to have commercial elements, however, including advertisements for other conservative sites and its owner’s business,<sup>413</sup> and this could adversely affect a claim of fair use under the standard test. Nevertheless, the case could set a broad precedent regarding posting articles on the Internet.<sup>414</sup> Noncommercial sites routinely post articles for discussion, or to document claims made on a site, a practice not dissimilar to the reading of news articles into the Congressional Record.<sup>415</sup> The examples are far too numerous to paint a representative picture of, but they range from web pages about copyright<sup>416</sup> to Antiwar.com<sup>417</sup> and the Iraq Action Coalition discussed above.<sup>418</sup>

The Free Republic case represents a first step towards the depopulation of the independent Web publishing community, by revoking its “ancient and venerable rights” under the First Amendment and fair use doctrine.<sup>419</sup> But the matter will not end with Free Republic. Eventually the charmed convergence of rights and utility tends towards an absolute right of copy-

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412. Malcolm Maclachlan, *Conservative Site Named in Copyright Suit*, TECHWEB, Oct. 2, 1998 (<http://www.techweb.com/wire/story/TWB19981002S0017>).

413. *See id.*

414. *See Miller, supra* note 411, at D1 (“It’s a very important lawsuit because it’s a question that needs to be settled. . . . The Net is one giant copying machine, and producers, authors and content providers have been worried that the Net would threaten their basic economic incentives.” (quoting John Shepard Wiley, Jr.)).

415. The beginnings of a new democratic republic arose from the English coffee houses and Parisian salons of the eighteenth century, thanks to a “commercialization of cultural production” that allowed a mass public to emerge. Much as it does today, this mass public depended upon the widespread ability to participate in the new “market for cultural goods,” e.g., novels, journals, and other types of cultural production. *See* JURGEN HABERMAS, *THE STRUCTURAL TRANSFORMATION OF THE PUBLIC SPHERE: AN INQUIRY INTO A CATEGORY OF BOURGEOIS SOCIETY* 38 (Thomas Burger trans., 1989) (1962).

416. *See* Dennis Karjala, *Opposing Copyright Extension* (visited Apr. 24, 2000) (<http://www.public.asu.edu/~dkarjala/>).

417. *See* Antiwar.com (visited Apr. 24, 2000) (<http://www.antiwar.com>).

418. *See* Iraq Action Coalition, Iraq Action Coalition (visited Apr. 24, 2000) ([www.leb.net/~iac](http://www.leb.net/~iac)); *see also* Sudan Net, *Sudan Net Home Page* (visited Apr. 24, 2000) ([www.sudan.net](http://www.sudan.net)) (numerous news articles on southern Sudanese famine and American cruise missile attack on Khartoum pharmaceutical plant).

419. This fact may be obscured by the case’s unsympathetic defendant: after all, he allegedly used the site to promote his business and is listed by Yahoo! under Government: Politics: Political Opinion: Conspiracy: United States. In many respects, he is as well chosen for such a “groundbreaking” suit as are the various artistic and political sites used by the ACLU to challenge the Communications Decency Act and Child Online Protection Act (since, after all, hardcore commercial pornographic sites probably economically benefit even more than they do when such laws are struck down).

right holders will prevent even small uses of their works, as represented by the retraction of fair use in the *Nation* case and by the DMCA's incentive structure for ISPs to err on the side of overprotection. The right of the small Internet speaker to gain credibility for marginalized positions by appealing to mainstream sources will be revoked, and the class of modest but relevant Web publishers wiped out.

The extension of the copyright term will only exacerbate the threat that ISP liability poses, by expanding the realm of copyrighted material; any reference to this material will be subject to conclusory claims of infringement and subsequent deletion. A case brought by Eric Eldred and others challenges the recent retroactive 20-year extension of copyright.<sup>420</sup> Michael S. Hart, director of the Gutenberg Project, one of the largest free book sites, estimates that the new law "will essentially prevent about one million books from entering the public domain over the next 20 years."<sup>421</sup> Eric Eldred, who like Zack Exley runs his independent e-text site, Eldritch Press, out of his home, warns that "[i]f everything is private property forever, which is the way things are going, then there can't be a growing, global, free public library."<sup>422</sup> The independent web will be increasingly silenced as copyright industries reassert control over the "legal piracy" of public domain works through synergistic combination of legislation, licensing, and technology.

Charles Nesson makes a compelling case that such an expansion of copyright "impedes scholarship," with his story of an MIT Shakespeare database, intended to study the Bard and his context, that contains "all of the texts which precede Shakespeare."<sup>423</sup> The problem is that

as the MIT scholars move forward towards the present, they run into copyright, and they begin to omit texts . . . there is no feasible way to clear rights for a project this comprehensive. . . . The holes become larger and larger until they eventually merge, and the content of the database effectively evaporates.

This means a Faulkner scholar can't do what a Shakespeare scholar can. The electronic revolution in scholarship brings unequal benefits. How do authors benefit if their work is omitted

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420. See *Eldred v. Reno*, 74 F. Supp. 2d 1 (1999).

421. Carl S. Kaplan, *Free Book Sites Hurt by Copyright Law*, N.Y. TIMES ON THE WEB, Oct. 30, 1998 (<http://www.nytimes.com/library/tech/98/10/cyber/cyberlaw/30law.html>).

422. *Id.*

423. See Charles Nesson, *Fair Use* (visited Nov. 23, 1998) (<http://cyber.harvard.edu/fairuse/index.html>).

from an online database which may become the new virtual, global public library?<sup>424</sup>

The same story could be told about the Gutenberg Project and other "Great Books" pages, the plethora of web sites posting historical documents, and Web museums; even the Perseus Project at MIT, comprising ancient texts, is threatened with regard to its store of translations and commentary. Matters will only get worse as the "holes," and the point in time in which they merge, recede further into the past with the advance of copyright law and trusted systems into the commons.

In the longer term, however, the threat to independent Web publishing posed by ISP liability may be eclipsed by the unprecedented power of trusted systems to afford complete control over access to a work. The DMCA's legal protection of trusted systems, accompanied by UCITA's provisions for technological enforcement of mass market information licenses, will provide the legal framework for the transition to complete control. As Lawrence Lessig writes, "Far more efficiently and far more completely than law, this code will give copyright holders the power to control access and use, the power to disable fair uses, and the ability to keep control of their material for much longer than the statutory life."<sup>425</sup> To the extent that the one-sided rhetoric of rights-piracy and utility-waste continues to dominate the official discourse on copyright policy, the Net's version of the English yeomanry will have no means of resisting the theft of their monopoly-restraining rights, nor of preserving their valuable transformative works.

As the public's easements in the public domain are transformed into piracy, into trespass, independent Web publishing will be steadily displaced by intensive exploitation of established works. The Oversoul that is cyberspace will give way to the Celestial Jukebox, to the corporate synergies of the diminishing number of publishers, networks, and studios. The agenda hinted at by the *Harper & Row* opinion, and aggressively advocated by the White Paper and other documents, namely the capture by copyright holders of the full social value of their works and the expansion of copyright infringement to encompass interference with any new licensing scheme, leaves no room for the independent Internet publisher's necessary easement upon the intellectual commons.<sup>426</sup> Before this counter-

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424. *Id.*

425. Lawrence Lessig, *Opening Remarks, Atlantic Unbound Roundtable: Life, Liberty, and ... the Pursuit of Copyright?* (visited Dec. 17, 1998) (<http://www.theatlantic.com/unbound/forum/copyright/lessig1.htm>).

426. See, e.g., *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 590, 593 (1994) (remanding for determination of "whether unrestricted and widespread conduct of the

revolution in the nature and composition of cyberspace communication is permitted to occur, an inquiry into the historical and philosophical intersection between copyright and the First Amendment must be conducted in the courts. As was said in another context, “[t]he Nation’s future depends upon leaders trained through wide exposure to that robust exchange of ideas which discovers truth ‘out of a multitude of tongues, [rather] than through any kind of authoritative selection.’”<sup>427</sup>

## VI. CONCLUSION

In England, over time, the twin principles that it is the property owner’s right to do as he wills with his own and that freedom in a commons brings ruin to all<sup>428</sup> advanced hand in hand to subvert more and more of the yeomanry’s “ancient and venerable rights and privileges.” As Foucault wrote, the “transition to intensive agriculture exercised, over the rights to use common lands, over various tolerated practices, over small accepted illegalities, a more and more restrictive pressure.”<sup>429</sup> In the same way, the transition from the Industrial Age’s paradigm of the sale of literary works to the Information Age’s paradigm of intensive synergistic exploitation of cultural products is exercising an increasingly restrictive

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sort engaged in by the defendant . . . would result in a substantially adverse impact on the potential market for the original,” namely the “effect of 2 Live Crew’s parodic rap song” on the “potential licensing market” for a “derivative . . . non-parody, rap version of ‘Oh, Pretty Woman’”) (internal quotes omitted); *Harper & Row Publishers v. Nation Enterprises*, 471 U.S. 539, 568 (1985) (holding that the “fair use . . . inquiry must take account not only of harm to the original but also of harm to the market for derivative works”); *Princeton Univ. Press, Inc. v. Michigan Document Serv., Inc.*, 99 F.3d 1381 (6th Cir. 1996) (en banc) (mandating licensing scheme for photocopying of course materials); *American Geophysical Union v. Texaco, Inc.*, 60 F.3d 913 (2d Cir. 1994) (mandating licensing scheme for research photocopying); *WHITE PAPER*, *supra* note 278, at 79 (interpreting precedent to state that the economic effect of the use “weighs against a defendant not only when a current market exists for a particular use, but also when a potential market could be exploited by the copyright owner. Harm in either market, will, in most cases, render a use unfair.”) (citation omitted); *see also* Fisher, *supra* note 212, at 1669-71 (arguing that broad definition of harm to actual or potential markets “will almost always tilt in favor of the plaintiff”). *But see, e.g.*, *Sony v. Universal Studios, Inc.*, 464 U.S. 417, 431-32 (1984) (holding that, despite existence of plaintiff’s proposed licensing scheme for VCRs, existence of substantial noninfringing uses of them provided grounds for a finding of fair use); *Sega Enter. Ltd. v. Accolade, Inc.*, 977 F.2d 1510 (9th Cir. 1990) (holding that, despite existence of licensing system for video game cartridges, disassembly of object code for purposes of interoperability was fair use).

427. *Regents of Univ. of Cal. v. Bakke*, 438 U.S. 265, 312 (Powell, J., concurring) (quoting *Keyishian v. Board of Regents*, 385 U.S. 589, 603 (1967)).

428. Hardin, *supra* note 129, at 1244.

429. FOUCAULT, *supra* note 1, at 85.

pressure on the public's rights to articulate its world and to access a common store of knowledge and expression.

As the yeomanry in its "golden age" had "little occasion to purchase any of the means of subsistence"<sup>430</sup> so many users of the Internet have little need to depend on the captains of the content industries for "all the news that's fit to print." But those who feel liberated from a kind of intellectual serfdom by the Internet's advent may yet suffer the fate of the yeomanry after the enclosures and sweepings: "the peasant has again become a serf."<sup>431</sup> Relegated to the forums, chat rooms, and "letters to the editor" pages of the mega-sites of the content industries, made voiceless by revocations of rights in the public domain and "Fear, Uncertainty, and Doubt" campaigns against "untrustworthy information," the yeomanry of cyberspace will revert to Microserfs.<sup>432</sup>

As we know, the erstwhile English yeomanry, having been driven from its homes and into wage labor on capital farms or in the manufacturing towns, eventually rebelled against the Dickensian conditions and its return to serfdom, and extracted political concessions by concerted action. A new discourse of the "natural rights of man," and new forms of economics, provided the theoretical ammunition for their struggle.<sup>433</sup> Under such a banner, perhaps we will be able to preserve, or if necessary reclaim, the diverse and independent spirit of a world in which independent web publishing can thrive. Otherwise, the noncommercial and autonomous Internet speaker faces the prospect held out to the tenants of a Sussex landlord, that

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430. MARX, *supra* note 37, at 360.

431. *Id.* at 336.

432. "Fear, Uncertainty, and Doubt," or "FUD," is a marketing technique used when a competitor launches a product that is both better than yours and costs less, i.e. your product is no longer competitive." Roger Irwin, *What is FUD?* (<http://www.geocities.com/SiliconValley/Hills/9267/fuddef.html>) (providing a brief history of FUD tactics in the hardware and software industries).

433. See Thompson, *supra* note 92 (discussing the popularity of Thomas Paine's *The Rights of Man* and other rights-based political theories among advocates of workers and the poor in Britain); Herbert Hovenkamp, *The Political Economy of Substantive Due Process*, 40 STAN. L. REV. 379, 402, 437-46 (1988) (describing the theoretical "revolutions" in English political economy that helped enact the Factory Acts regulating the working hours of children and adults alike). Keynesian or demand-side economics, along with the theory of externalities, were influential in establishing that impoverishment and victimization by laissez-faire policies could be inefficient as well as unjust. See JOHN MAYNARD KEYNES, *THE GENERAL THEORY OF EMPLOYMENT, INTEREST AND MONEY* 372-84 (1964).

“nowe is the time come, that we gentilmen will pull downe the houses of such poor knaves as ye be.”<sup>434</sup>

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434. FELICITY HEAL & CLIVE HOLMES, *THE GENTRY IN ENGLAND AND WALES, 1500-1700* 111 (1995).